Supreme Court, U.S.
FILED

001346 FEB 26 2001

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No.

In The

Supreme Court of the United States

MOORE NORTH AMERICA, INC. (FORMERLY KNOWN AS MOORE U.S.A., INC.),

Petitioner,

vs.

STANDARD REGISTER COMPANY,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

ROBERT A. ROWAN
JAMES D. BERQUIST
Counsel of Record
NIXON & VANDERHYE PC
1100 North Glebe Road, 8th Flr.
Arlington, VA 22201
(703) 816-4000

Attorneys for Petitioner

QUESTIONS PRESENTED FOR REVIEW

1. WHETHER A FUNCTIONAL ANALYSIS UNDER THE DOCTRINE OF EQUIVALENTS CAN BE SUMMARILY BARRED AS A MATTER OF LAW, WHERE PROSECUTION HISTORY ESTOPPEL DOES NOT APPLY.

2. WHETHER THE FEDERAL CIRCUIT CAN DENY, AS A MATTER OF LAW, APPLICATION OF THE DOCTRINE OF EQUIVALENTS TO REARRANGED CLAIM ELEMENTS.

3. WHETHER THE FEDERAL CIRCUIT CAN CONCLUDE THAT 47.8% IS NOT EQUIVALENT TO "MAJORITY" AS A MATTER OF LAW WITHOUT ANY FUNCTIONAL ANALYSIS.

4. WHETHER THE FEDERAL CIRCUIT CAN DENY APPLICATION OF THE DOCTRINE OF EQUIVALENTS AS A MATTER OF LAW BY EMPLOYING ITS "DEDICATION" ESTOPPEL THEORY, AN APPROACH ALREADY REJECTED BY THIS COURT.

5. WHETHER THE FEDERAL CIRCUIT CAN AFFIRM SUMMARY JUDGEMENT THAT WAS BASED UPON AN ACKNOWLEDGED ERROR OF LAW WITHOUT PERMITTING "ADEQUATE TIME FOR DISCOVERY" DIRECTED TO THE PROPER RULE OF LAW AND DESPITE A TIMELY MOTION UNDER RULE 56(f).

LIST OF PARTIES AND CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rules 14.1(b) and 29.6, counsel for the Petitioner, MOORE NORTH AMERICA, INC., formerly known as MOORE U.S.A., INC., hereby certifies the following:

1. The full names of every party to the proceeding sought to be reviewed are: MOORE NORTH AMERICA, INC., formerly known as MOORE U.S.A., INC., and the STANDARD REGISTER COMPANY.

2. Petitioner's parent corporation is MOORE CORPORATION, LTD., whose stock is publicly traded on the New York Stock Exchange.

3. To the best of Petitioner's information and belief, Respondent's stock is traded on the New York Stock Exchange, and there is no publicly held company that owns 10% or more of its stock.

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OFFICIAL CITATION OF THE DECISION BELOW

The decision of the Federal Circuit sought to be reviewed is reported at 229 F.3d 1091 (Fed. Cir. 2000). The district court's April 17, 1998 decision is reported at 1998 U.S. Dist. LEXIS 22697. The remaining decisions of the district court are not reported.

STATEMENT OF JURISDICTION

This Court has jurisdiction to review the September 22, 2000 Decision of the Court of Appeals for the Federal Circuit on a writ of *certiorari* pursuant to 28 U.S.C. §§1254(1), 2101(c). Rehearing and Rehearing *en banc* were timely requested and were denied by the Court of Appeals on November 27, 2000. Appendix ("App.") F at 80a-81a.

STATUTES INVOLVED IN THIS CASE

This Petition involves 35 U.S.C. §271(a), which states:

> Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

This Petition also involves 35 U.S.C. §112 and Rule 56, Federal Rules of Civil Procedure, which are quoted in full in Petitioner's Appendix G at 82a-86a.

STATEMENT OF THE CASE

A. Proceedings Regarding the '464 Patent

Moore U.S.A., Inc. ("Moore")[1] sued the Standard Register Company ("SRC") on December 22, 1997 for infringement of four patents, including U.S. Patent No. 5,201,464 ("the '464 patent"). The '464 patent is directed to specific mailers comprising integrated return envelopes. At issue here are claim 1 and claims 9, 16, 17 and 19 (collectively referred to as "claim 9") of the '464 patent. The only controverted element of claim 1 – element [d] – relates to the lengths of the strips of adhesive located in the tear-off margins of the mailer:

> [F]irst and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, *extending the majority of the lengths of said longitudinal marginal portions*, and parallel to said first and second longitudinal edges[.] [App. P at 140a (emphasis added)].

SRC's accused form contains first and second longitudinal strips of adhesive disposed in the first and second longitudinal marginal portions, respectively, of the form's first face. However, those strips extend 47.8% of the lengths of the marginal portions, rather than a "majority." App. A at 25a-26a.

Claim 9 of the '464 patent contains several elements required to be placed in particular locations of the claimed form. App. P at 142a-48a. SRC's accused form contains elements corresponding to the claimed elements, albeit in

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[1] Now known as Moore North America, Inc.

locations different than those specified by the literal claim language.

SRC moved for summary judgment of non-infringement on March 20, 1998. App. S at 203a-04a. The United States District Court for the Eastern District of Virginia originally denied SRC's motion, but ultimately granted summary judgment of non-infringement after considering the Federal Circuit's decision in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997). App. C; App. D.

In affirming that summary judgement, the Court of Appeals for the Federal Circuit (Judge Newman, dissenting) adopted or expanded upon three new rules of patent law that effectively eliminate any consideration of "functionality" in patent infringement analysis under the doctrine of equivalents, a factual analysis this Court has consistently required for over 100 years.

The three new rules of law enunciated by the Federal Circuit majority are: (1) that, despite this Court's decision in *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929), the doctrine of equivalents does not extend to rearranged claim elements as a matter of law, *Moore U.S.A., Inc. v Standard Register Company*, 229 F.3d 1091, 1109 (Fed. Cir. 2000), App. A at 29a-33a; (2) that certain terms in patent claims, *e.g.*, "a majority of the lengths," have no scope of equivalents as a matter of law, regardless of their role or function in the claim, App. A at 26a-27a; and (3) that any "subject matter disclosed in the specification, but not claimed, is dedicated to the public," App. A at 28a, even when "[n]either prosecution history estoppel nor prior art was asserted as limiting equivalency." App. A at 56a.

With respect to these three rules, Judge Newman's dissent noted, respectively, that: (1) "precedent contravenes [the majority's] automatic bar" to equivalency of rearranged claim elements, App. A at 57a (citing this Court's decisions

in *Sanitary Refrigerator* ("equivalency may ensue when claimed elements are reciprocally rearranged") and *Warner-Jenkinson Co. v. Hilton Davis Chem Co.*, 520 U.S. 17 (1997) ("equivalency in fact must be determined")); (2) "[w]hether 47.8% is equivalent to a majority is a question of fact, and could not be decided adversely to the patentee as a matter of law," App. A at 55a; and (3) "[t]here is no support for [the majority's] statement" that Moore dedicated to the public all unclaimed embodiments. App. A at 56a.

The Federal Circuit's recent citation of the instant case in *Demarini Sports, Inc. v. Worth, Inc.*, Nos. 99-1561, 99-1583, 2001 U.S. App. LEXIS 2093, at **43-44 (Fed. Cir. Feb. 13, 2001), as authority for the proposition that the doctrine of equivalents does not reach to rearranged claim elements further confirms that the holdings of the instant case are not limited to their particular facts. Instead, the Federal Circuit appears to have adopted those holdings as rules of law intended for broad application, despite their direct variance with this Court's precedent, as well as the Federal Circuit's own precedent, *e.g.*, *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251 (Fed. Cir. 1989) (recognizing equivalency involving rearranged elements).

B. Proceedings Regarding the '798 Patent

As part of the same action, Moore also sued SRC for infringement of U.S. Patent No. 5,253,798 ("the '798 patent"). The '798 patent is directed to self-mailer forms having, *inter alia*, a line of adhesive spaced from one edge "a distance sufficient to insure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer." App. Q at 164a-65a.[2] As it

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[2] The "distance sufficient" is measured from the transverse edge of the mailer form to the first transverse line of adhesive. App. Q at 165a.

did with respect to the '464 patent, the district court quickly granted summary judgment of non-infringement of the '798 patent based upon its interpretation of the claim language "distance sufficient."

Barely three months after suit was filed, the district court ruled that the words "distance sufficient" must be construed, *as a matter of law*, to mean "more than ¼ inch" and that "[c]onstrued as such, it becomes clear that defendant's accused form does not read on Claim 1 of the '798 patent." App. E at 75a. The district court arrived at its claim construction by improperly imputing, as a matter of law, the dimensions of a specific printer which had been discussed in the patent's specification into the generic language of claim 1 of the '798 patent. App. A at 13a-14a; App. E at 74a-75a. No other basis for summary judgment was even addressed by the district court to justify its summary adjudication of non-infringement of the '798 patent or its simultaneous rejection of Moore's Rule 56(f) request for additional discovery. App. E at 72a-76a.

The Federal Circuit affirmed the district court's summary adjudication on the '798 patent notwithstanding: (a) its reversal of the district court's erroneous legal construction of the '798 patent claims, which formed the sole basis for the district court's decision to grant of summary judgment before completion of any meaningful discovery; and (b) affidavit evidence showing both a genuine, material issue of disputed fact, as well as the probability of confirming and expanding upon those evidentiary facts, pursuant to a timely request for additional discovery under Fed. R. Civ. P. 56(f).

It was undisputed that "the parties had not taken a single deposition, SRC had not provided Moore with a single copy of any document, and over four months of discovery remained." App. A at 46a. Nor was there any contention

that Moore had been less than diligent in pursuing discovery or in filing its Rule 56(f) request.[3]

The Federal Circuit rejected the district court's claim construction, App. A at 37a, but nevertheless found that the district court's error was "harmless" because: (a) Moore "failed to provide any evidence" of SRC's use of any printer other than the one mentioned in the patent - an issue that was totally irrelevant to the district court's claim construction[4]; and (b) Moore's declarations (submitted both substantively and to support Moore's Rule 56(f) request) were perceived as merely conclusory or insufficiently "quantitative." App. A at 38a-40a. However, one of those declarations, the "Combined Declaration of Robert A. Vanderhye Under Rule 56(f), And Evidentiary Declaration" explicitly stated:

> Specifically, as of yet [3/17/98—11 days *after* SRC's summary judgment motion] no document has been produced by SRC – let alone all the forms accused of infringing the '798 patent. Such forms are specifically called for by Moore's document production request . . . and until SRC produces such forms . . . Moore cannot even know what all of the form constructions are that need to be evaluated by

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[3] Moore promptly served discovery requests on SRC. Indeed, Moore was forced to file its first motion to compel within six weeks of filing the Complaint. App. S at 194a. Moore likewise filed its Rule 56(f) request within eleven days of the filing of SRC's motion for summary judgment. App. L at 97a-99a; App. S at 200a, 202a.

[4] Respondent's internal documents, which were obviously not available to Petitioner without formal discovery, were indisputably never copied in this case. Some of those documents were, however, subsequently produced to Petitioner by Respondent in another litigation and made a part of this record on appeal. Certain of those documents showed Respondent's "qualification" of over 30 other non-IBM printers for use with the pressure seal business forms at issue. *See* App. T.

> the Court when considering infringement of the '798 patent . . . . I also have not had the opportunity to take the deposition of Mr. Mudry, who filed a declaration on SRC's behalf . . . . Also I have specific information, from my own evaluation of SRC forms . . . that what is set forth in paragraph 4 of the Mudry declaration is incorrect and that there are SRC forms having a spacing . . . *even more than ¼ inch.*[5] I need to confirm that these forms are legitimate SRC forms during discovery. [App. L at 98a].

Despite this explicit Declaration, the Federal Circuit concluded that Moore's "Rule 56(f) declarations did not indicate how additional discovery would enable Moore to create a genuine issue of material fact regarding SRC's non-infringement . . . ." App. A at 46a-47a. To support this conclusion, the Federal Circuit observed that, "[g]iven that the roller impression area of the IBM 3800 printer is ¼ inch, forms with adhesive spaced 1/16 inch or 1/8 inch away from their transverse edges cannot literally infringe." App. A at 39a. Although factually correct, this statement obviously

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[5] Note that, when an IBM 3800 printer is actually employed, the "distance sufficient" to avoid that machine's ¼ inch rollers would logically only have to be at least ¼ inch and that Mr. Vanderhye's affidavit was quite specific and "quantitative" in documenting relevant forms with distances of "*more than* ¼ inch," which merely needed to be authenticated by discovery.

does not address Mr. Vanderhye's explicit identification of SRC forms with spacing of "more than 1/4 inch."[6]

The Federal Circuit's rejection of Moore's claim of infringement of the '798 patent under the doctrine of equivalents was similarly based solely on an unsubstantiated *factual* argument by SRC that its "adhesive avoids interference with the rollers of the IBM 3800 printer not as a result of its spacing from the transverse edge, but rather due to its superior composition." App. A at 40a. The Court of Appeals' assertion that "Moore offers nothing to rebut" this claim, *id.*, is particularly ironic since SRC successfully refused to produce its adhesive for chemical analysis despite Moore's Rule 34 Request and Motion to compel. App. S at 194a, 199a, 202a, 205a. Moreover, Moore proffered the Declaration of Robert LaBarge, who stated that at one of his customer's locations "SRC . . . modified its forms to be closer to Moore's forms, moving the transverse pattern of pressure sensitive cohesive further away from the transverse edge of the forms until the SRC form no longer had the sticking problem during printer pausing." App. M at 100a-01a. Despite its non-quantitative nature, this declaration clearly showed that SRC was solving the problem addressed by the '798 patent by following the teaching of that patent, rather than by way of any change in glue composition.

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[6] Perhaps realizing the insufficiency of this observation, the appellate court made the further *unexplained factual determination* that, when used with an IBM 3800, "the 'distance sufficient' limitation...*would have to be* at least 5/16 of an inch away from the transverse edges to avoid interference with the printer rollers." App. A at 38a (emphasis added). This factual conclusion was made without allowing any meaningful discovery addressed to this point, (*see supra* note 1 and accompanying text), or even the opportunity to argue against the Federal Circuit's implicit factual assumption that a material difference actually exists between the Federal Circuit's imputed requirement of "5/16 of an inch" and the documented spacing of "*more than* ¼ inch."

ARGUMENT

I. A Functional Analysis Under The Doctrine of Equivalents Cannot Be Summarily Barred As A Matter of Law Where No Prior Art or Prosecution History Estoppel Prevents Its Application

This Court recently confirmed that, absent prosecution history estoppel or prior art, the doctrine of equivalents requires an "analysis of the role played by each element in the context of the specific patent claim." *Warner-Jenkinson Co.*, 520 U.S. at 21, 40; *see also Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608-09 (1950) ("things for most purposes different may sometimes be equivalents" when considered in terms of function); *Sanitary Refrigerator Co.*, 280 U.S. at 41-43 (1929) (doctrine of equivalents applied to reciprocally changed claim elements); *Union Paper-Bag Mach. Co. v. Murphy*, 97 U.S. 120, 125 (1878) ("[I]n the sense of the patent law, . . . if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.").

No prosecution history estoppel or prior art precluded application of the doctrine of equivalents here. Yet, the Federal Circuit refused to undertake this Court's prescribed functional analysis, relying on an expansive application of its interpretation of the All Elements Rule and a new "dedication" theory of estoppel to affirm the district court's summary judgment finding of no infringement. App. A at 24a-33a.

Accordingly, the present case presents an ideal vehicle for the Court to examine the Federal Circuit's proper role in policing application of the doctrine of equivalents, a role that

Petitioner submits has been transformed from one of judicial vigilance to a single-minded attack on the doctrine itself. Petitioner further submits that the Federal Circuit's continuing effort to limit equivalency to the literal scope of the claims unabashedly conflicts with this Court's recent affirmation of the doctrine – and its underlying functional analysis – as a proper measure of infringement.

Justice Thomas remarked in *Warner-Jenkinson* that the accused infringer "invites us to speak the death of [the] doctrine [of equivalents]. We decline that invitation." *Warner-Jenkinson*, 520 U.S. at 21. The Federal Circuit, unfortunately, appears to have accepted the invitation.[7] Accordingly, the interests of judicial clarity and the preservation of a properly functioning patent system compel the Court to grant *certiorari* on the present Petition.

II. The Federal Circuit Cannot Deny, As A Matter Of Law, Application Of The Doctrine Of Equivalents To Rearranged Claim Elements Without Contravening The Established Precedent Of This Court.

Specifically, the Federal Circuit rejected this Court's precedent in favor of its own analysis in *Sage Products, Inc.*

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[7] The Federal Circuit also dramatically expanded the breadth of prosecution history estoppel in another recent decision, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000). There, the Federal Circuit overruled its own long-standing precedent and held *en banc* that *any* narrowing amendment to a claim – whether made in the face of prior art or simply for clarification purposes – results in prosecution history estoppel that precludes *any* range of equivalents. An even more restrictive rule was actually applied in this case, where the Federal Circuit did not even assert prosecution history estoppel.

v. Devon Industries, Inc., 126 F.3d 1420 (Fed. Cir. 1997), to hold that the rearranged elements of claim 9 of the '464 patent cannot, as a matter of law, infringe under the doctrine of equivalents. App. A at 29a-33a.[8] Judge Newman correctly noted in dissent that this Court's holdings in *Sanitary Refrigerator* and *Warner-Jenkinson* "contravene[] such an automatic bar" to the doctrine of equivalents. App. A at 57a. In particular, Judge Newman admonished the majority of the impropriety of foregoing the functional analysis prescribed in *Warner-Jenkinson*. *See id.* Judge Newman also directed the majority's attention to the Federal Circuit's own decision in *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1259 (Fed. Cir. 1989), where the court previously held an accused device's *negatively* doped *cladding* to be functionally equivalent to the claimed, *positively* doped *core*. In *Corning Glass Works*, the Federal Circuit further held that "[a]n equivalent must be found for every limitation of the claim somewhere in an accused device, *but not necessarily in a corresponding component*, although that is generally the case." *Id.* (emphasis added). The majority here rejected both this Court's precedent and its own, however, arguing that the Federal Circuit's decision in *Sage* permitted the preclusion of

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[8] Contrary to the conclusion expressed, but not relied upon, in footnote 2 of the Federal Circuit's decision, App. A at 33a n.2, Petitioner *does* argue that Respondent's accused form includes the other identified elements of claim 9. *See, e.g.*, App. H at 90a; App. O 105a-08a. (For example, the Respondent's mail forms at issue obviously receive the claimed "address indicia" or they cannot be used as mailers – their only commercial application.) Moreover, the district court did not grant summary judgment based on any of those elements.

the doctrine of equivalents where an asserted patent claim contains "clear structural limitations." App. A at 32a.[9]

The most obvious problem with the Federal Circuit's approach is that virtually every product claim must have "clear structural limitations" in order to comply with the requirements of the Patent Code. *See* 35 U.S.C. § 112 ¶ 2 ("The [patent] specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."). Thus, according to the Federal Circuit's approach, essentially every valid product claim must be limited to its literal language, leaving the owner of a product patent with no access to the doctrine of equivalents precisely because of his compliance with the Patent Code. Such a result clearly fails to comport with this Court's long-established and oft-repeated recognition of the vitality of the doctrine of equivalents. *See, e.g.*, *Warner-Jenkinson*, 520 U.S. at 21, 40; *Graver Tank*, 339 U.S. at 608-09; *Winans v. Denmead*, 56 U.S. 330 (15 How.) 330, 343 (1854). Indeed, in *Warner-Jenkinson*, this Court pointed to "mechanical devices," which necessarily contain "clear structural limitations," as being best suited for application of the "triple identity test" of "function, way and result" first articulated more than a century ago. *See Warner-Jenkinson*, 520 U.S. at 21, 40; *see also Union Paper-Bag Mach. Co.*, 97 U.S. at 125.

The Federal Circuit also reasoned that, to the extent this Court's decision in *Sanitary Refrigerator* permitted equivalency for rearranged elements, that decision failed to

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[9] Not only has the Federal Circuit's errors worked an injustice against Petitioner in this case, but it is clear that the Federal Circuit intends to elevate those errors to the level of established precedent in its increasingly restrictive application of the doctrine of equivalents. *See Demarini Sports, Inc. v. Worth, Inc.*, Nos. 99-1561, 99-1583, 2001 U.S. App. LEXIS 2093, at *43 (Fed. Cir. Feb. 13, 2001).

account for the All Elements Rule[10] more recently set forth in *Warner-Jenkinson*. App. A at 32a. However, *Sanitary Refrigerator* and the All Elements Rule can only conflict where, as here, the All Elements Rule is improperly used to limit the claimed element to its literal language without consideration of functionality.

III. In The Absence Of A Functional Analysis, The Federal Circuit Cannot Conclude That 47.8% Is Not Equivalent To "Majority" As A Matter Of Law.

The Federal Circuit took a similarly non-functional approach to the "majority" limitation of claim 1 under the rationale of the All Elements Rule. Here, however, SRC accused form clearly contains an element directly corresponding to each element of claim 1 without any rearrangement of elements. *See, e.g.*, App. A at 55a; App. O at 105a-08a.[11] The accused element admittedly does not meet the literal claim language, but that is a fact common to all doctrine of equivalents cases and cannot, itself, warrant denial of the doctrine as a matter of law. Instead, the factfinder must determine whether the claimed and accused elements play the same role in the context of the invention to ascertain whether they are functional equivalents. *See Warner-Jenkinson*, 520 U.S. at 40. The Federal Circuit

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[10] The All Elements Rule requires that an infringing product contain each claimed element, or its equivalent. *See Warner-Jenkinson*, 520 U.S. at 40.

[11] Although neither the district court nor the Federal Circuit relied on the "substantially less" limitation of claim 1, element [e], in reaching their decisions, the Federal Circuit's negative observations regarding element [e], App. A at 29a n.1, suffer from the same failure to consider the role of the claimed and accused elements that skewed its holding with respect to element [d] and the rearranged elements of claim 9. *See* App. O at 106a.

nevertheless refused to undertake that functional analysis. "That ruling, which negates equivalency as a matter of law as between substantially identical elements having slight numerical differences, is not in accordance with precedent." App. A at 55a (Newman, J., dissenting).[12]

Significantly, this Court confirmed in *Warner-Jenkinson* that a numerical limit such as "majority" does not foreordain the equivalency analysis. *See Warner-Jenkinson*, 520 U.S. at 40-41 (remanding for consideration of whether patentee's purpose for including numerical limitation in claim amendment permitted range of equivalence reaching to accused element). Indeed, on remand there, the Federal Circuit found that, without violating the All Elements Rule, the doctrine of equivalents *did* reach accused products falling outside the specific, numeric range, where the substituted element performed substantially the same function in substantially the same way to reach substantially the same result. *See Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 114 F.3d 1161, 1164 (Fed. Cir. 1997). The court's refusal to follow the same analysis here and its adoption instead of a bright line rule that would negate, as a matter of law, equivalency between strips of adhesive extending even

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[12] Judge Newman further noted the *procedural* impropriety of the majority's holding:

> Whether 47.8% is equivalent to a majority is a question of fact, and could not be decided adversely to the patentee as a matter of law. The evidence of identity of function, way, and result, and of insubstantial difference, was not disputed on summary judgment; the question requires findings of fact, not summary disposition.

App. A 55a. This Court also noted in *Warner-Jenkinson*, without actually deciding the issue, that the Federal Circuit's holding below in that case that equivalence is a jury question finds "ample support in [the Supreme Court's] prior cases." *Warner-Jenkinson*, 520 U.S. at 38.

49.99% of a form's length and strips extending 50.01% of that length, lack any logical or legal justification.

The effect of the Federal Circuit's new approach to equivalence has been to restrict asserted patent claims to their literal terms, even in the absence of any prosecution history estoppel or prior art. This result is contrary to the established precedent of this Court, as well as that of the Federal Circuit, including the insightful, but now ignored, observation that "any analysis of infringement under the doctrine of equivalents necessarily deals with subject matter that is 'beyond,' 'ignored' by, and not included in the literal scope of a claim." *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 149 F.3d 1309, 1317 (Fed. Cir. 1998). As the Federal Circuit's decision here demonstrates, strict application of the All Elements Rule without consideration of function allows that Rule to swallow the doctrine of equivalents and improperly reduces the equivalency analysis to nothing more than a second literal analysis. That result cannot stand in the face of this Court's controlling and long-standing precedent to the contrary.

IV. The Federal Circuit Cannot Employ Its "Dedication" Estoppel Theory, An Approach Already Rejected By This Court, To Deny Application Of The Doctrine Of Equivalents As A Matter Of Law.

The Federal Circuit bolstered its refusal to consider the role of element [d] by holding that Moore "dedicated to the public" the "about half" equivalent disclosed in the '464 patent specification. As support for its holding, the Federal Circuit laid down a broad statement of law that "'subject matter disclosed in the specification, but not claimed, is dedicated to the public' in determining infringement under

the doctrine of equivalents." App. A at 28a (quoting *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1107 (Fed. Cir. 1996)). Even the Federal Circuit, however, previously recognized that this notion of "dedication" estoppel contravenes controlling Supreme Court precedent. *See YBM Magnex, Inc. v. Int'l Trade Comm'n*, 145 F.3d 1317, 1321 (Fed. Cir. 1998) (citing *Graver Tank* and further noting that"[i]n recognizing that equivalents are not limited to what is disclosed in the patent, the Court [in *Warner-Jenkinson*] necessarily recognized that equivalents may indeed be disclosed in the patent").

In *Graver Tank*, the patent-in-suit disclosed – but did not claim – the manganese silicate accused of infringement. *See Graver Tank*, 339 U.S. at 618 (Douglas, J., dissenting). The Court found infringement under the doctrine of equivalents, despite the dissenters' urgings that "[w]hat is not specifically claimed is dedicated to the public." *Id.* at 612, 614, 618. Indeed, the Court noted that "[i]t is difficult to conceive of a case more appropriate for application of the doctrine of equivalents." *Id.* at 612. Thus, the clear message of *Graver Tank* is that "dedication estoppel" is not a proper device for precluding application of the doctrine of equivalents. Although the Federal Circuit previously acknowledged that message in *YBM Magnex, Inc.*,[13] it nevertheless relied on dedication estoppel theory in this case to preclude application of the doctrine of equivalents. App. A at 28a (citing, ironically, *YBM Magnex, Inc.*). The Federal Circuit's disregard for this Court's prior directives was clear legal error

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[13] The Federal Circuit further explained in *YBM Magnex* that the doctrine of equivalents was still available to a patentee where, as here, "the specification taught that the accused arrangement was interchangeable with the claimed arrangement." *YBM Magnex*, 145 F.3d at 1321. The undisputed relative length of Respondent's accused adhesive strips (47.8%) is certainly within the contemplation of the teaching of "about half."

that ultimately undermines the constitutionally based disclosure objective of the patent system by encouraging patentees to limit their disclosure to only the preferred embodiment for fear of losing access to the doctrine of equivalents.[14]

V. The Federal Circuit Cannot Affirm Summary Judgment Based On An Acknowledged Error Of Law, Without Permitting "Adequate Time For Discovery" Directed To The Proper Rule Of Law And Despite A Timely Motion Under Rule 56(f).

In *Farmer v. Brennan*, 511 U.S. 825, 848 (1994), the petitioner, like Moore here, responded to a motion for summary judgment with an opposing affidavit and a Rule 56(f) request asking the court to delay ruling until respondents had complied with petitioner's pending request for production of documents. The district court denied the petitioner's Rule 56(f) motion and granted summary judgment against him, finding that a notification element of petitioner's case, which the district erroneously perceived to be essential, was not established by the petitioner's response. *Farmer*, 511 U.S. at 831. The Seventh Circuit summarily

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[14] In addition, the Federal Circuit's preclusion of equivalence based upon the fact that the '464 patent disclosed, but did not claim, the "about half" embodiment is directly at odds with its parallel conclusion that "majority" and 47.8% could *never* be equivalents. The Federal Circuit cannot suggest that a disclosed embodiment is an equivalent and concurrently hold that the disclosed embodiment is "the very antithesis" of what has been claimed literally. App. A at 27a. Moreover, precedent makes clear that even semantically "antithetical" elements can be functional equivalents. *See Graver Tank*, 339 U.S. at 608 ("things for most purposes different may sometimes be equivalents"); *Corning Glass Works*, 868 F.2d at 1259.

affirmed without opinion. This Court, like the Federal Circuit here, determined that, although the district court had erred in its analysis of the law, the petitioner's evidence and arguments were still insufficient. This Court nevertheless determined that "the appropriate course is to remand," *id.* at 848, because "[w]e cannot . . . be certain that additional evidence is unavailable to petitioner because in denying petitioner's Rule 56(f) motion for additional discovery the District Court may have acted on a mistaken belief that petitioner's failure to notify was dispositive." *Id.* at 849.

Here, as in *Farmer*, the district court denied Moore's Rule 56(f) request concurrently with its grant of SRC's summary judgment motion on the basis of an error of law, i.e., an overly restrictive claim construction. Accordingly, the logic of this Court's decision in *Farmer* would indicate that the district court probably used the same erroneous claim construction in dismissing Moore's then pending and proposed discovery requests as "fishing expeditions." App. at 79a. As shown by the evidence later discovered in a subsequent litigation between the same parties, there were "fish" to be caught, i.e., evidence that SRC had "qualified" over thirty different non-IBM printers for use with its accused business forms, *see supra* note 4, precisely the evidence that the Federal Circuit found to be fatally lacking on appeal. "Moore bears the burden of proof on infringement, but has failed to provide any evidence demonstrating or even suggesting SRC's use of any printer other than the IBM 3800 . . . ." App. A at 38a.

In light of the fact that the documents later discovered were in SRC's hands and not publicly available to Moore, Moore can hardly be faulted for not having such documents to oppose SRC's summary judgment motion, especially since

absolutely no documents had changed hands in discovery.[15] Numerous cases place significant weight on the fact that needed discovery is in the possession of the summary judgment movant. *See, e.g., Vivid Tech., Inc. v. American Science & Eng'g, Inc.*, 200 F.3d 795, 809 (Fed. Cir. 1999) (quoting *Reid v. New Hampshire*, 56 F.3d 332, 342 (1st Cir. 1995), for the proposition that, "[w]hen a party who opposes a Rule 56(f) motion has control of the requested information, this factor 'weighs heavily in favor of relief under Rule 56(f)'").

This Court's later decision in *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986), is most often cited for the proposition that "when a properly supported motion for summary judgment is made, the adverse party 'must set forth specific facts showing there is a genuine issue for trial.'" However, this Court further noted that:

> This requirement in turn is qualified by Rule 56(f)'s provision that summary judgment be refused where the nonmoving party has not had the opportunity to discover information that is essential to his opposition. In our analysis here, we assume that both parties have had ample opportunity for discovery.[16]

Id. at n.5.

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[15] SRC will argue that one of Moore's attorneys was allowed to inspect and tag certain SRC documents on SRC's premises. However, it is undisputed that SRC never copied and produced the tagged documents, which were of little use to Moore in SRC's Ohio offices with the court proceeding in Virginia. *See* App. A at 46a.

[16] This Court also made the key point in *Anderson* that the "evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor." *Anderson*, 477 U.S. at 255.

This point was also made concurrently in *Celotex Corporation v. Catrett*, 477 U.S. 317, 322 (1986), where this Court stated that Rule 56(c) only becomes operative "after adequate time for discovery." This Court further observed that, totally unlike the present case, the *Celotex* action had been on file for a year prior to the motion for summary judgment and that "[t]he parties had conducted discovery, and no serious claim can be made that respondent was in any sense 'railroaded' by a premature motion for summary judgment." *Celotex*, 477 U.S. at 326.

The Eleventh Circuit Court of Appeals, analyzing *Celotex*, *Anderson* and their companion case, *Matsushita Electric Industrial Co. v. Zenith Radio*, 475 U.S. 574, 578 (1988) (where there had been "several years of detailed discovery"), succinctly concluded:

> This court previously has reviewed the Supreme Court's direction for ruling on summary judgment motions found in *Celotex, Anderson* and *Matsushita* and concluded that the *common denominator of those cases is* "that summary judgment may only be decided upon an adequate record." . . . "Generally summary judgment is inappropriate when the party opposing the motion has been unable to obtain responses to his discovery requests."

Fernandez v. Bankers Nat'l Life Ins. Co., 906 F.2d 559, 570 (11th Cir. 1990) (emphasis added) (internal citations omitted).

Most, if not all, other circuits have gleaned similar mandates from this Court's summary judgment trilogy, including the Fourth Circuit, whose precedent governs the Federal Court in this case when addressing "procedural issues not unique to the areas of law that are exclusively

assigned to the Federal Circuit." *Vivid Tech., Inc.*, 200 F.3d at 807 (holding that "[d]iscovery under Rule 56(f) is of such a nature"). In this regard the Fourth Circuit has stated: "The Supreme Court has noted that once a plaintiff "has named a witness to support her claim, summary judgment should not be granted without . . . somehow showing that the named witness' possible testimony raises no genuine issue of material fact." *Temkin v. Frederick County Commissioners*, 945 F.2d 716, 724-725 (1991) (citing *Celotex Corp.*); *see also Mitlier v. Beorn*, 896 F.2d 848, 852-53 (4th Cir. 1990) (citing *Anderson* for the proposition that reasonable *inferences* drawn from a witness' deposition created genuine issue of material fact, rendering summary judgment improper).

Because the tenor of Fourth Circuit law is substantially identical to that of the First Circuit, the Federal Circuit's reliance on First Circuit precedent in *Vivid Technologies* is instructive as to how it should have gauged Moore's Rule 56(f) request in the instant case, particularly in light of the facts that SRC's summary judgment motion was brought after the case was on file for only three months and before a single document had been exchanged or a single witness deposed. In *Vivid Technologies*, like here, a formal request for discovery had been made, "but copies of the listed documents were not provided to [the non-movant]." *Vivid Tech.*, 200 F.3d at 807. On those facts, the *Vivid Technologies* court, per Judge Newman (the dissenter here), held that "the denial of all discovery at this stage exceeded the scope of the court's discretion," [17] further explaining that:

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[17] "The denial of a Rule 56(f) motion is reviewed under an abuse of discretion standard." *Nguyen v. CAN Corp.*, 44 F.3d 234, 242 (4th Cir. 1995) (citing *Visa Int'l Serv. Ass'n. v. Bankcard Holders of Am.*, 784 F.2d 1472 (9th Cir. 1986)).

> The grant of summary judgment of non-infringement, with respect to accused devices whose components or methods are not readily observable and are in dispute, requires sufficient discovery to assure that the issue has been fully and fairly resolved.
>
> * * *
>
> "Evaluating the potential significance of unknown facts in regard to unadjudicated issues is something of a metaphysical exercise. Consequently, the threshold of materiality at this stage of a case is necessarily low."[18]

Vivid Tech., 200 F.3d at 809-810 (citation omitted).

Based on the teachings of this Court in *Farmer* and *Celotex*, and in light of the very early stage of proceedings in the district court and the fact that the key evidence was in the hands of SRC, it was clearly an abuse of discretion for the district court to deny Moore's Rule 56(f) motion on the facts before it and it was error for the Federal Circuit to affirm this short-circuiting of the judicial process. Nearly fifteen years

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[18] The *Vivid Technologies* panel further added that: "Rule 56(f) serves the dual purpose of safeguarding against too hasty a grant of summary judgment, while requiring that parties who seek time for additional discovery have not been dilatory; such parties must (i) make an authoritative and timely proffer, (ii) show good cause for the failure to have discovered these essential facts sooner, (iii) present a plausible basis for the belief that there are discoverable facts sufficient to raise a genuine and material issue, and (iv) show that the facts are discoverable within a reasonable amount of time. . . . When a movant satisfies these requirements 'a strong presumption arises in favor of relief.'" *Vivid Tech.*, 200 F.3d at 809-810. Mr. Vanderhye's affidavit *readily* satisfied these criteria, especially in light of the low "threshold of materiality at this [*very* early] stage" of the case. App. L.

have passed since this Court's decisions in *Anderson*, *Celotex* and *Matsushita*, and the time is ripe to again clarify the procedural boundaries of a Rule 56 motion, this time with emphasis on the importance of Rule 56(f).

CONCLUSION

The Federal Circuit refused to acknowledge the pivotal role of functionality in its equivalency analysis of multiple claims of the '464 patent, despite the explicit teachings of *Graver Tank* and *Warner-Jenkinson* in this regard. It further refused to recognize the continued vitality of the Supreme Court's cogent analysis in *Sanitary Refrigerator* regarding infringement by the mere rearrangement of claimed elements, instead elevating its own decision in *Sage* over this Court's controlling precedent in *Sanitary Refrigerator*.

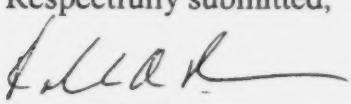
The Federal Circuit's failure to adhere to controlling Supreme Court precedent and even its own precedent in *Corning Glass Works*, *YBM Magnex* and *Ethicon* on each of these issues creates serious inroads into a patentee's ability to enforce its constitutionally mandated rights under the patent laws and significantly erodes the continued viability of the patent system functioning as it ought under Article I, Section 8, Clause 8 of the United States Constitution. The patent system cannot "promote the useful Arts" if patentees are judicially discouraged from making full disclosure of their inventions in the patent specification for fear of "dedicating" that invention to the public under the Federal Circuit's otherwise unsupported expansion of its *Maxwell v. J. Baker* decision into a broad new rule of law precluding application of the doctrine of equivalents without reference to either prior art or prosecution history estoppel. Thus, the Federal Circuit's decision not only significantly erodes the Supreme Court's recent re-affirmation of the doctrine of equivalents in *Warner-Jenkinson*, but also encourages minimal disclosures

in patent specifications, discovery gamesmanship and premature summary judgment.

In summarily adjudicating non-infringement of the '798 patent, both of the lower courts disregarded the teachings of this Court in *Celotex* and *Farmer* that summary judgment is inappropriate where the trial court did not allow "adequate time for discovery" or did not properly consider a timely Rule 56(f) request under the appropriate substantive legal standard.

In order to avoid the multiple ill effects inevitably resulting from the conflict of authority created by the Federal Circuit's decision below, the instant Petition for *Certiorari* should be granted.

Respectfully submitted,



Robert A. Rowan
James D. Berquist
NIXON & VANDERHYE P.C.
1100 N. Glebe Road, 8th Floor
Arlington, Virginia 22201
(703) 816-4000

APPENDIX

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

98-1386, -1387

MOORE U.S.A., INC.,
Plaintiff-Appellant,

v.

STANDARD REGISTER COMPANY,
Defendant-Cross Appellant.

DECIDED: September 22, 2000
As Amended September 26, 2000.

Appealed from: United States District Court for the Eastern District of Virginia
Senior Judge Albert V. Bryan, Jr.

Before NEWMAN, MICHEL, and CLEVENGER, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* MICHEL. Opinion concurring-in-part and dissenting-in-part filed by *Circuit Judge* NEWMAN.

MICHEL, Circuit Judge.

On December 22, 1997, Moore U.S.A., Inc. ("Moore") filed suit against Standard Register Company ("SRC") in the United States District Court for the Eastern District of Virginia for infringement of U.S. Patent Nos. 5,201,464

("the '464 patent"), 5,253,798 ("the '798 patent"), and 5,314,110 ("the '110 patent").[1] On March 4, 1998, SRC counterclaimed for non-infringement and invalidity of the three patents. In three separate orders, the district court granted SRC's motions for summary judgment of non-infringement of the '464, '798, and '110 patents and dismissed the action with prejudice. *Moore U.S.A., Inc. v. Standard Register Co.*, No. 97-2054-A (E.D. Va. Mar. 20, 1998) ("*Moore I*") (granting summary judgment of non-infringement of the '798 and '110 patents); *id.* (Apr. 3, 1998) ("*Moore II*") (granting summary judgment of no literal infringement of the '464 patent); *id.* (Apr. 17, 1998) ("*Moore III*") (granting summary judgment of no infringement by equivalents of the '464 patent, and dismissing the action with prejudice).

Moore appeals the district court's grant of summary judgment of no infringement by equivalents with respect to the '464 patent and its grant of summary judgment of non-infringement with respect to the '798 and '110 patents. SRC conditionally cross-appeals the district court's dismissal of its counterclaims as moot. Because the district court correctly held that Moore had failed to raise a genuine issue of material fact as to whether SRC infringed the '464, '798, and '110 patents, we affirm the district court's grant of summary judgment of non-infringement of the '464, '798, and '110 patents and dismiss SRC's cross-appeal.

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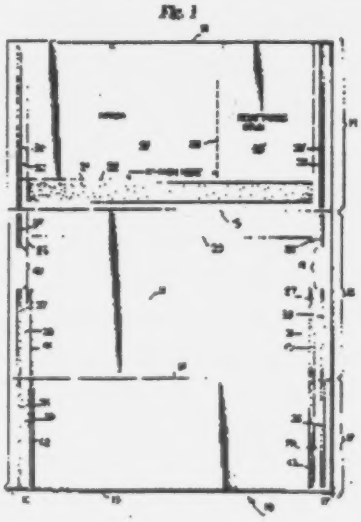
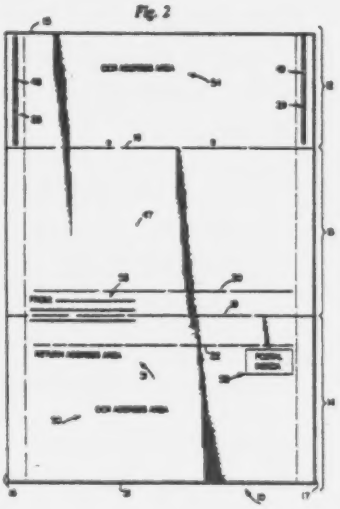
[1] Moore originally asserted infringement of a fourth patent, U.S. Patent No. 4,918,128 ("the '128 patent"). On SRC's motion for partial summary judgment, the district court dismissed the '128 patent from the case in view of Moore's inability to establish standing as the exclusive licensee. *See Moore U.S.A., Inc. v. Standard Register Co.*, No. 97-2054-A, slip op. at 13-14 (E.D. Va. Mar. 6, 1998). Moore does not appeal from this dismissal

BACKGROUND

A. The '464 Patent

The '464 patent, entitled "PRESSURE SEAL C-FOLD TWO-WAY MAILER," discloses a C-fold[2] mailer-type business form with an integral return envelope. *See* '464 patent, col. 1, ll. 2, 23-25. The integral return envelope is created as part of the mailer during the folding and sealing process. *See id.*, col. 1, ll. 26-31. The recipient opens the mailer by removing stubs on the left and right edges. *See id.*, col. 1, ll. 58-60. After reading the information printed on the mailer, the user can remove a remittance stub from the top panel, insert the stub into the integral return envelope, detach the envelope from the rest of the mailer, and then seal and mail the envelope. *See id.*, col. 1, ll. 61-64. Figures 1 and 2 of the '464 patent are illustrative:





[2] A "C-fold" mailer is a paper form that is divided into three sections by transverse fold lines. The C-fold mailer is so named because, upon folding, one of the two end sections becomes the middle of the mailer, while the other end section and the middle section form the top and bottom of the mailer. By contrast, in a "Z-fold" mailer, the middle section becomes the middle of the mailer, and the two end sections form the top and bottom of the mailer.

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The '464 patent has five independent claims. Independent claim 1 recites:

> A mailer type business form intermediate, comprising:
>
> a sheet of paper having a first face, adapted to provide the majority of the interior of the mailer when constructed, and a second face, adapted to provide the majority of the exterior of the mailer when constructed;
>
> said sheet having first and second opposite, parallel longitudinal edges extending the entire length thereof, and opposite ends;
>
> first and second longitudinal lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;
>
> *first and second longitudinal strips of adhesive* disposed in said first and second longitudinal marginal portions, respectively, of said first face, *extending the majority of the lengths of said longitudinal marginal portions*, and parallel to said first and second longitudinal edges;
>
> third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips disposed closer to one end of said ends than the other, and extending a distance substantially less than the extent of said first and second strips;

fifth and sixth longitudinal strips of adhesive parallel to said first and second longitudinal edges and disposed in said first and second marginal portions, respectively, on said second face, said fifth and sixth strips located adjacent the same end of said sheet as said third and fourth strips, and having a longitudinal extent at the most equal to said and fourth strips;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips, longitudinally spaced from said third and fourth strips; and

means defining a line of weakness adjacent said transverse strip, on the opposite side thereof from said third and fourth strips, to allow ready separation of the paper at that line.

Id., col. 10, l. 40 - col. 11, l. 18 (emphasis added). Independent claim 9 recites:

A mailer type business form, with integral return envelope, comprising:

a C-fold paper sheet having first and second faces, first and second opposite longitudinal edges extending the entire length thereof, and first and second transverse fold lines defining first, second and third sections of said sheet;

said second and third sections being larger than said first section;

first and second lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;

first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, and parallel to said first and second longitudinal edges; *said first and second longitudinal strips connecting at least said first and second sections, and said third and first sections, together at said longitudinal marginal portions*;

third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips connecting said first section to a part of said second section to form the sides of a return envelope;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips, *in said third section*;

means defining a transverse line of weakness adjacent said transverse strip in said third section, on the opposite side thereof from said second section, to allow ready separation of the form at that line;

outgoing address, and outgoing return address, indicia visible from said second face of said third section;

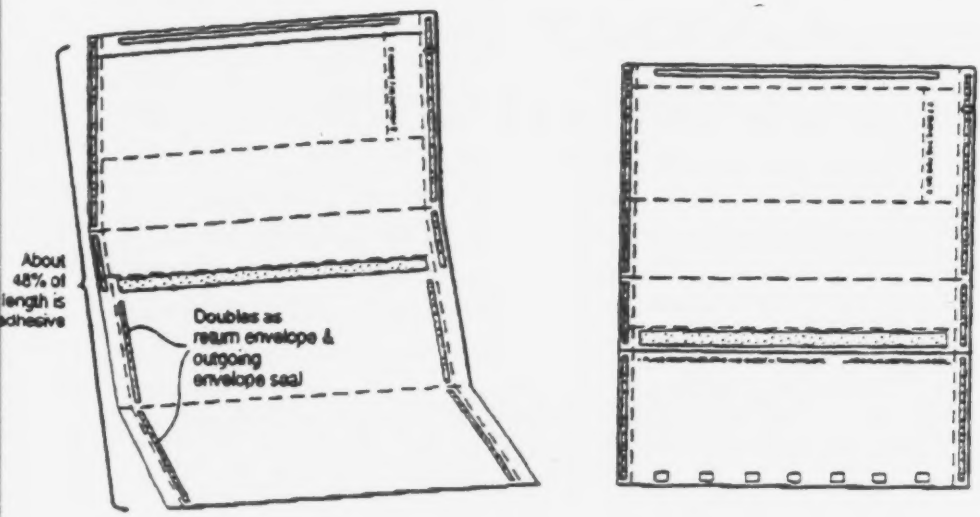
return envelope address indicia printed on said second face in said first section; and

indicia facilitating and suggesting the insertion of return address information on said return envelope, said facilitating and suggesting indicia printed on

said second face in both said second and third sections.

Id., col. 11, l. 51 - col. 12, l. 29 (emphasis added). Independent claims 16, 17, and 19 require many of the same limitations as claim 9, including those underlined above. *See id.*, col. 13, ll. 2-6, 15-19, 43-47, 56-58; col. 14, ll. 1-2, 30-34, 43-47. Like claim 9, claims 16, 17, and 19 require "outgoing address indicia" (or "outgoing addressee address indicia"), *id*, col. 13, ll. 22-23; col. 14, ll. 5, 50-51, and claims 16 and 19 require "outgoing return address indicia," *id.*, col. 13, ll. 22-23; col. 14, ll. 50-51. Claim 12 requires "means defining a die cut window in said third section allowing viewing of said outgoing addressee address information therethrough." *Id.*, col. 14, ll. 6-9

The accused SRC mailer, Form 8140C04, is a C-fold mailer with an integral return envelope, as depicted below (unfolded and with its lower panel folded up):



The accused SRC form has first, second, third, and fourth strips of adhesive on its front face, two longitudinal strips of adhesive in the margin portion of its back face, and a transverse adhesive strip and an associated line of weakness in the second (*i.e.*, middle) section of its front face. The first and second (*i.e.*, outermost) longitudinal strips of adhesive extend approximately 6-11/16th inches along the longitudinal margin of the accused SRC form, or 47.8% of the total margin length. The first and second strips cover portions of the longitudinal margins of the second and third (*i.e.*, top) sections, but do not cover any of the margin of the first (*i.e.*, bottom) section. The third and fourth (*i.e.*, innermost) longitudinal strips are inward of the longitudinal perforation lines and extend approximately 6-5/8 inches, or just over 99% of the length of the first and second longitudinal strips. The third and fourth strips, which cover portions of only the first and second sections, seal the sides of the integral return envelope by connecting the two sections.

Although the accused SRC form is somewhat similar to the patented mailer of claims 1, 9, 16, 17, and 19, Moore does not dispute that the accused SRC mailer cannot literally satisfy claim 1's requirement that the "first and second longitudinal strips of adhesive . . . extend[ ] the majority of the lengths of said longitudinal marginal portions." *Id.*, col. 10, ll. 56-60. Additionally, Moore does not dispute that the accused SRC mailer cannot literally satisfy the following three limitations of claims 9, 16, 17, and 19:

(1) "first and second longitudinal strips connecting at least said first and second sections . . . together at said longitudinal marginal portions";

(2) "means defining a transverse adhesive strip on said first face . . . in said third section"; and

(3) "means defining a transverse line of weakness adjacent said transverse strip in said third section, on the opposite side thereof from said second section."

Id., col. 11, l. 68 - col. 12, l. 4; col. 12, ll. 13-17; col. 13, ll. 2-6, 15-19, 43-47, 56-58; col. 14, ll. 1-2, 30-34, 43-47.

On April 3, 1998, the district court granted-in-part and denied-in-part SRC's motion for summary judgment that its Form 8140C04 does not infringe the '464 patent. *See Moore II*, slip op. at 2. Given that Moore did not dispute the absence of the aforementioned claim limitations from the accused SRC form, the district court held that the accused SRC form could not literally infringe the '464 patent. *See id.* at 5. The district court concluded, however, that there was a genuine issue of material fact as to whether the accused SRC product had elements which "function like the patented mailer, in the same way, to get the same result" and thus denied summary judgment of no infringement under the doctrine of equivalents. *Id.* at 6. The district court did not view the prosecution history as undisputedly precluding Moore from asserting infringement under the doctrine of equivalents. *See id.* at 5.

On SRC's motion for reconsideration, the district court granted summary judgment of no infringement of the '464 patent under the doctrine of equivalents. *See Moore III*, slip op. at 4. With respect to claim 1, the district court held that, because the first and second longitudinal strips of adhesive on the accused form extend less than the majority of the lengths of the longitudinal marginal portions, the accused form could not infringe claim 1 under the doctrine of equivalents in view of our decision in *Sage Products, Inc. v. Devon Industrial, Inc.*, 126 F.3d 1420, 44 USPQ2d 1103 (Fed. Cir. 1997). *See Moore III*, slip op. at 5. Applying the doctrine of equivalents to the accused SRC form, the district

court reasoned, would "remove entirely the 'majority of the lengths' limitation of Claim 1." *Id.*

Similarly, the district court held that the accused form could not infringe claims 9, 16, 17, and 19 under the doctrine of equivalents. The district court explained:

> Under *Sage*, there can be no infringement under the doctrine of equivalents if the accused infringer "achieves the same result . . . but does so by a *different arrangement of the elements*." 126 F.3d at 1425 (emphasis added). Each of [the three missing limitations of claims 9, 16, 17, and 19] is a clear structural limitation precluding expansion of these independent claims under the doctrine of equivalents. . . . [E]xtending the doctrine of equivalents to cover the accused form would entirely eliminate these structural limitations of the '464 patent . . . .

Id. at 6-7. The district court rejected Moore's contention that the Supreme Court's decision in *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929), condoned the rearrangement of claim limitations in an accused device, stating, "The Federal Circuit's language [in *Sage*] is unequivocal in rejecting such rearrangement, and this court at this stage is bound by the Federal Circuit's clear language." *Moore III*, slip op. at 7.

B. The '798 Patent

Mailer forms for printing on an IBM 3800 printer are supplied to the printer in a continuous web, with perforation lines separating each form from the next to allow their separation after printing. *See* '798 patent, col. 1, ll. 28-31. Conventional forms had adhesive located only 1/16 inch away from the leading and trailing edges of each form. *See id.*, col. 1, ll. 42-43. When the IBM 3800 printer pauses, the movement of the continuous-feed forms stops such that the

printer rollers are in constant contact with the forms, and a perforation line is located between two rollers. *Cf. id.*, Fig. 4. Because the rollers of the IBM 3800 printer create an impression 1/4 inch away from each side of the perforation line separating the forms, the adhesive on conventional forms, which fell within this impression region, frequently stuck to the rollers during such pauses. *See id.*, col. 1, ll. 28-35.

The '798 patent, entitled "PRESSURE SEAL ADHESIVE PATTERN FOR IBM 3800 PRINTERS," offers a solution to the problem of adhesive interfering with the printer rollers. Through the strategic placement of the pressure-sensitive adhesive away from the leading and trailing edges of each form, the patented form completely avoids interference with the printer rollers during printing pauses. *See id.*, col. 1, ll. 38-46. Figure 4 is illustrative:

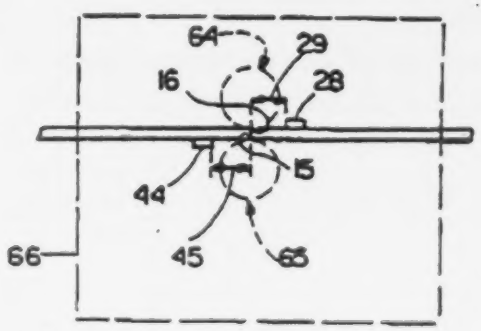


Fig. 4

Independent claim 1 recites:

> A mailer type business form processed by a printer having rollers, and operated to occasionally pause, the mailer comprising:
>
> a folded paper sheet having first and second faces, first and second opposite longitudinal edges, and first and second transverse fold lines defining first, second and third sections of said sheet;
>
> first and second longitudinal lines of weakness forming with said longitudinal edges first and second longitudinal marginal portions;
>
> a first transverse edge and a second transverse edge, both parallel to said first and second fold lines;
>
> longitudinal patterns of adhesive disposed in said longitudinal marginal portions for holding said marginal portions of said first through third sections together;
>
> a first transverse pattern of adhesive disposed adjacent said first transverse edge on said first face and first section; and
>
> *said first transverse pattern of adhesive being spaced from its associated transverse edge a distance sufficient to insure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer.*

Id., col. 6, l. 50 - col. 7, l. 5 (emphasis added). Claims 2, 4, and 10, which depend upon claim 1, do not specify a numerical limitation for the spacing of the adhesive pattern away from its associated transverse edge. *See id.*, col. 7, ll. 6-14, 18-20; col. 7, l. 54 - col. 8, l. 2. By contrast, all other claims of the patent (including claim 13, the only other independent claim), require that the relevant adhesive pattern

be located 5/16 inch away from its associated transverse edge. *See id.*, col. 7, ll. 15-17, 21-53; col. 8, ll. 3-59.

During the prosecution of the '798 patent, the Patent and Trademark Office ("PTO") examiner rejected the "distance sufficient" limitation as indefinite under 35 U.S.C. § 112, ¶ 2 (1994) because "it is impossible to determine the distance claimed." The examiner further explained that "[i]n this invention, the exact spacing is critical because adhesive which is too close to its transverse edge will cause the printer problems noted on page 1 of the specification." In response, the applicant characterized the "distance sufficient" limitation as a "functional description, providing a complete, definite and accurate statement of what the spacing should be." The applicant continued, "The fact that the spacing is not in numerical terms is irrelevant since a functional term such as this, so long as it is itself definite, is entirely appropriate." The examiner subsequently allowed the claims to issue.

The accused SRC form is a continuous web, Z-fold mailer with three panels separated by fold lines. Adhesive strips along the margins of the side panels allow the mailer to be sealed after it has it has been printed, torn from the continuous web, and folded. According to SRC, adhesive is located approximately 1/16 inch from the leading and trailing edges of the accused SRC form, but does not interfere with the printer rollers during printer pauses due to its superior composition.

On March 20, 1998, the district court granted SRC's motion for partial summary judgment of non-infringement of the '798 patent. *See Moore I*, slip op. at 2. The court began by rejecting Moore's argument that the "distance sufficient" limitation of claim 1 depended upon the type of printer used and was not limited to the IBM 3800 printer. *See id.* at 7-8. The court emphasized the fact that, in response to the PTO

examiner's rejection of claim 1 because "distance sufficient" was indefinite, the applicant had argued that the limitation was a "'functional description' that provides a complete, definite and accurate statement of what the spacing should be." *Id.* at 7. In view of this prosecution history, the frequent reference to the IBM 3800 printer in the written description, and the reference to the IBM 3800 in the title of the '798 patent, the court concluded that "the 'distance sufficient' limitation in Claim 1 is in reference to the IBM 3800 printer." *Id.* at 8. The court reasoned that "[o]nly such a construction could explain the acceptance by the PTO examiner of plaintiff's response to the examiner's indefiniteness concerns." *Id.* Accordingly, because the IBM 3800 makes a 1/4 inch-wide impression on each side of the perforation line during printing pauses, the court construed the "distance sufficient" limitation as "more than 1/4 inch." *Id.*

In view of its claim construction, the court concluded that there was no genuine issue of material fact as to whether the accused SRC form infringed the claims of the '798 patent. *See id.* at 8-9. The court rejected the declarations by Moore's counsel that the adhesive on SRC's forms is spaced greater than 1/16 or 1/8 inch from the transverse edge, since these declarations nowhere stated that the relevant distances are "about 5/16 inch." *Id.* at 8.

C. The '110 Patent

The '110 patent, entitled "DOUBLE FOLD MAILER," discloses yet another mailer-type business form. The claimed mailer is double-folded to provide four panels of substantially the same size and thereby allow a great deal of information to be printed on the mailer. *See* '110 patent, col. 1, ll. 18-25. Figures 1 and 2 of the '110 patent are illustrative:

FIG. 1

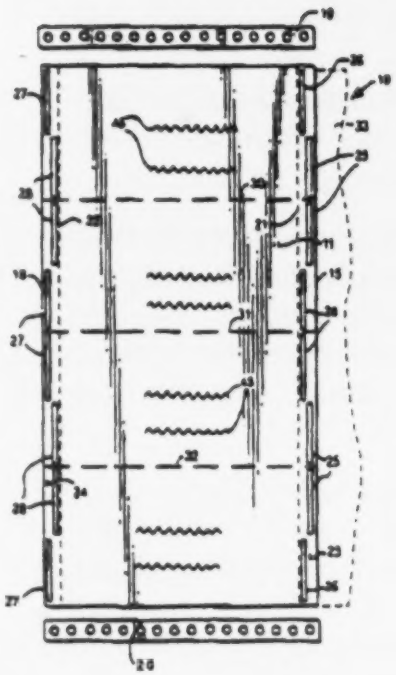
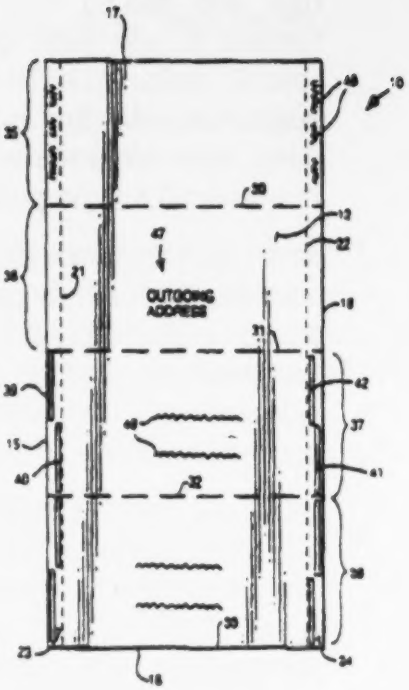


FIG. 2



Independent claim 1 recites:

An intermediate comprising:

a sheet of paper having a first face adapted to provide the majority of the interior of the mailer when constructed, and a second face adapted to provide the exterior of the mailer when constructed;

said sheet having first and second opposite parallel longitudinal edges, and opposite end edges;

first and second longitudinal lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, first and second longitudinal margin portions;

first and second longitudinal elongated patterns of adhesive disposed in said first longitudinal marginal portion of said first face, parallel to said longitudinal edges, and collectively covering substantially the entire distance between said opposite ends of said sheet;

third and fourth longitudinal elongated patterns of adhesive disposed in said second longitudinal marginal portion of said first face, parallel to said longitudinal edges, and collectively covering substantially the entire distance between said opposite ends of said sheet;

first, second and third fold lines formed in said sheet each perpendicular to said longitudinal edges, and dividing said sheet into, in sequence, first, second, third, and fourth panels of substantially equal size;

fifth and sixth elongated patterns of adhesive disposed in said first longitudinal marginal portion of said second face, parallel to said longitudinal edges, and collectively covering substantially the entire distance in the dimension of said longitudinal edges in said third and fourth panels;

seventh and eighth elongated patterns of adhesive disposed in said second longitudinal marginal

> portion of said second face, parallel to said longitudinal edges, and collectively covering substantially the entire distance in the dimension of said longitudinal edges in said third and fourth panels; and
>
> *wherein said sheet is devoid of adhesive extending along said end edges of said sheet between said longitudinal lines of weakness.*

Id., col. 5, ll. 14-58 (emphasis added). Independent claim 11, the only other independent claim of the '110 patent, also requires that its sheet be "devoid of adhesive extending along said end edges of said sheet between said longitudinal lines of weakness." *Id.*, col. 7, ll. 1-3.

Claims 1 and 11, as originally filed, required that the sheet be "devoid of adhesive extending along said end edges of said sheet, or parallel to said end edges of said sheet." The examiner rejected both claims as unpatentable over U.S. Patent No. 4,575,121 ("the Conti patent"), Figures 1 and 2 of which are shown below.

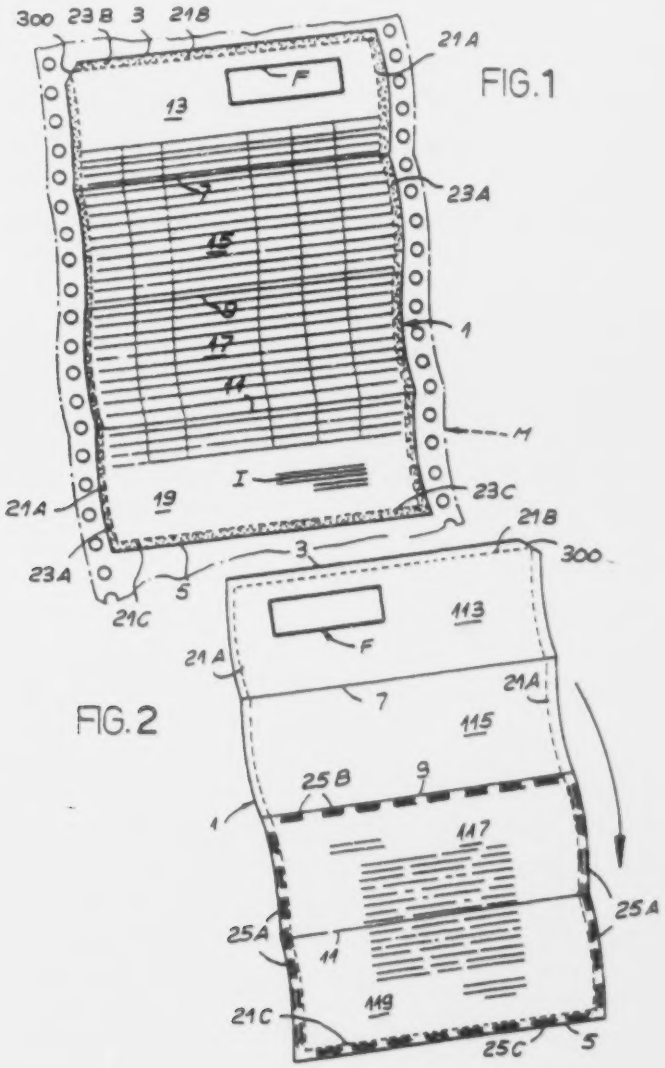


FIG. 1

FIG. 2

The Conti patent discloses a double-fold form with a continuous perimeter of adhesive on its front face and perforation lines located slightly inward of this adhesive strip. *See* Conti patent, Figs. 1-6. The Conti form also has two intermittent or continuous transverse strips of non-permanent adhesive adjacent to the center fold line and along an end edge of the back face to secure the mailer after folding. *See id.*, col. 3, ll. 26-43 (describing the gummed areas as "non-permanent"). In the embodiment employing intermittent strips of non-permanent adhesive, the rectangles of adhesive cover roughly 75% of the area between the longitudinal perforation lines. The recipient opens the Conti mailer by separating the strips of non-permanent adhesive and then tearing along the perforation line bordering three sides of the mailer. *See id.*, col. 4, ll. 22-36. The examiner explained, "It would have been obvious to one of ordinary skill in the art to omit adhesive in the end edges of the sheet of Conti when its function was not desired."

In response, the applicant deleted the phrase "and parallel to said end edges of said sheet" and stated:

> With respect to claims [1 and 11], the provision of said end edges being devoid of adhesive decreases costs as well as processing time, and makes the end envelope easier to open. With Conti, three margins have to be removed to open the mailer, whereas according to the invention only two margins have to be removed. This also decreases the amount of waste generated by the consumer. Yet the structure according to the invention holds sufficiently during handling to form an entirely appropriate mailer.

The examiner then rejected claims 1 and 11 as indefinite under 35 U.S.C. § 112, ¶ 2. The examiner explained:

> Claims [1 and 11] are inaccurate. The sheet is not "devoid of adhesive extending along said end edges

> of said sheet" because the first through eighth adhesive patterns, as claimed, substantially cover "the entire distance between the ends of said sheet."

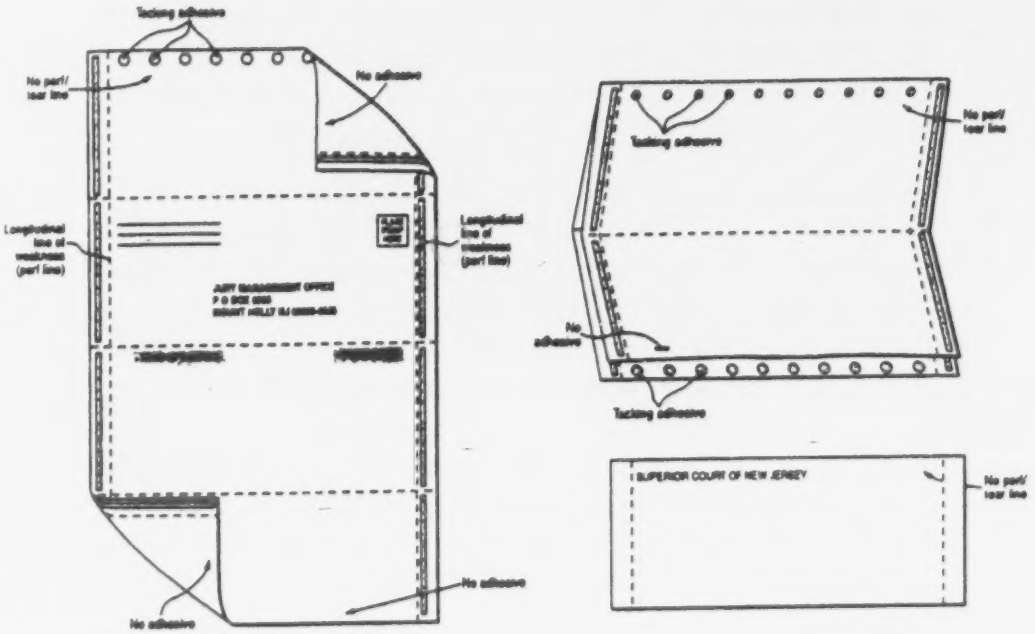
More simply stated, because the longitudinal elongated patterns of adhesive collectively extend the entire longitudinal length of the sheet, the end edges are not "devoid of adhesive" at their intersection with the longitudinal margins. The examiner also rejected claims 1 and 11 as unpatentable over the Conti patent in view of U.S. Patent No. 5,174,493 ("the File patent").

In response, the applicant amended claims 1 and 11 to add the phrase "between said longitudinal lines of weakness." The applicant remarked:

> Neither Conti nor File provide any teaching at all of the sheets being devoid of adhesive extending along the end edges thereof between longitudinal lines of weakness. As a matter of fact the teachings of both File and Conti are to the contrary. Therefore if File is combined with Conti it does not teach the invention, and reaffirms Conti's contrary teaching.
>
> . . .
>
> If one were to remove the adhesive from the end edges of Conti, the remaining elements of Conti would not perform the same function as before. Removing the sealing of the end edges which are required in Conti would defeat the purpose of Conti. In its preferred embodiment, Conti discloses a correspondence unit suitable for sending bank statements and multiple enclosures such as cancelled [sic] checks (see column 1, lines 25 through 37). If the end edges of Conti were not sealed the likelihood is that the inserts or cancelled checks would fall out.

The examiner subsequently withdrew his objections and allowed claims 1 and 11 as amended.

The accused SRC form has a row of ten widely-spaced circular patches of adhesive with a diameter of 3/16 inch extending along the transverse end edge of the sheet between the longitudinal lines of weakness, as shown below:



The patches cover no more than 25% of the linear distance between the two longitudinal lines of weakness, and are spaced more than a 1/2 inch away from each other. After the form has been double-folded along its three fold lines, the row of adhesive patches cooperates with a second row of adhesive patches adjacent to the form's center fold line to tack the mailer closed along its end edge. No perforation or tear line abuts the first row of adhesive patches. A recipient of the accused SRC mailer opens the mailer by tearing along the longitudinal perforation lines and then separating the adhesive patches from one another.

On March 20, 1998, the district court granted SRC's motion for summary judgment of non-infringement of the '110 patent. *See Moore I*, slip op. at 2. The court noted that the term "devoid" is commonly defined to mean "[c]ompletely lacking; destitute; empty; without," citing *The American Heritage Dictionary* 361 (New College Ed. 1976). In view of this definition, the court held that "the undisputed existence of circular patches of adhesive in defendant's accused form necessitates the finding that there is no literal infringement of the '110 patent claims." *Moore I*, slip op. at 11.

The court further held that SRC's form could not infringe by equivalents under the doctrine of prosecution history estoppel. The court focused on the fact the applicant had amended his claims to specify that the sheet was "devoid of adhesive extending along said edges of said sheet" to distinguish the Conti patent, as discussed above. *See id.* at 13-14. In view of the clear claim language and the prosecution history, the district court concluded that the accused SRC form could not satisfy the "devoid of adhesive" limitation under the doctrine of equivalents. *See id.* at 14-15. The district court rejected Moore's contention that summary judgment was premature because discovery had not yet been completed, stating that Moore had failed to offer "any

specific expected disclosures that would alter the [c]ourt's conclusions and findings." *Id.* at 15.

DISCUSSION

Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). In deciding whether a genuine issue of material fact exists, the court must believe the evidence of the nonmovant and draw all justifiable inferences in the nonmovant's favor. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). We review a district court's grant of summary judgment *de novo*. *See Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1353, 47 USPQ2d 1705, 1713 (Fed. Cir. 1998).

"An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly construed claims to the device accused of infringing." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976, 34 USPQ2d 1321, 1326 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, (1996) (citations omitted). While claim construction is a question of law, *see Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1451, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc), infringement, whether literal or under the doctrine of equivalents, is a question of fact, *see Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353, 48 USPQ2d 1674, 1676 (Fed. Cir. 1998).

A. The '464 Patent

With respect to the '464 patent, Moore appeals only the district court's grant of summary judgment of no infringement under the doctrine of equivalents; it does not seek to disturb the district court's grant of summary judgment of no literal infringement.

1. Infringement of Claim 1

Moore contends that the longitudinal strips of the accused SRC form, which extend but a minority of the length of its longitudinal margins, are equivalent to the claimed strips, which extend a "majority of the lengths" of the longitudinal margins of the patented form. Moore argues that the district court misinterpreted our decision in *Sage* as barring the application of the doctrine of equivalents to the "majority of the lengths" limitation. Moore emphasizes that *Sage* involved structural limitations, *i.e.*, "an elongated slot at the top of the container body" and "a first constriction extending over said slot." *Sage*, 126 F.3d at 1422, 44 USPQ2d at 1105. Moore argues that the "majority of the lengths" limitation of claim 1, by contrast, simply involves a matter of degree, not structure. Moore analogizes the "majority of the lengths" limitation of claim 1 to the "pH from approximately 6.0 to 9.0" limitation at issue in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997), for which a scope of equivalents is allowed unless barred by the prosecution history, *see Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 114 F.3d 1161, 1164, 43 USPQ2d 1152, 1155 (Fed. Cir. 1997) (en banc) (order remanding the case to the district court to determine whether prosecution history estoppel applies). *See also Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 858-60, 9 USPQ2d 1289, 1293-95 (Fed. Cir. 1988) (holding that a claim limitation reciting "link ends being dimensioned and spaced apart by a distance slightly greater than said width"

was satisfied under the doctrine of equivalents by an element with more than "slightly greater" spacing).

Moore argues that the "majority of the lengths" limitation is entitled to a scope of equivalents covering a minority of the lengths for two reasons. First, Moore alleges that SRC knew of and copied the '464 patent in developing its accused form. Moore suggests that SRC's knowledge and copying of the '464 patent act to expand the scope of equivalents, citing the Supreme Court's decision *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 85 USPQ 328 (1950), in support. Second, Moore contends that the hypothetical claim analysis of *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 14 USPQ2d 1942 (Fed. Cir. 1990), demonstrates that the "majority of the lengths" limitation can encompass first and second longitudinal strips that extend only a minority of the lengths of the longitudinal margins. Moore posits a hypothetical claim in which the phrase "about half of the length of the first face, or essentially the entire length" replaces the phrase "the majority of the lengths of said longitudinal marginal portions" from claim 1. According to Moore, such a hypothetical claim would not embrace the prior art, yet would still read on the accused SRC form.

Moore further contends that its desired scope of equivalents for claim 1 would not vitiate the "majority of the lengths" limitation. Moore characterizes the critical issue as whether first and second longitudinal strips of adhesive that extend "about 48%" of the length of the longitudinal margins are insubstantially different from strips that extend "50.001%" of the length of such margins. Moore argues that there is a genuine issue of material fact as to whether "about 48%" is equivalent to "50.001%" (*e.g.*, by performing substantially the same function, in substantially the same way, to achieve substantially the same result), which precludes summary judgment of non-infringement.

According to Moore, the written description unequivocally teaches such equivalence, because it states:

> While the longitudinal adhesive strip sections 35 through 39' are illustrated in FIG. 1 as extending essentially the entire length of the face 11, depending on the particular type of adhesive utilized and the end requirements, it may only be necessary for the adhesive to extend about half of the length 11.

'464 patent, col. 6, ll. 11-16.

We cannot agree with any of Moore's theories on infringement by equivalents. If our case law on the doctrine of equivalents makes anything clear, it is that all claim limitations are not entitled to an equal scope of equivalents. Whether the result of the All Limitations Rule, *see Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934-35, 4 USPQ2d 1737, 1739-40 (Fed. Cir. 1987) (en banc), prosecution history estoppel, *see Warner-Jenkinson*, 520 U.S. at 33-34, or the inherent narrowness of the claim language, *see Sage*, 126 F.3d at 1425, 44 USPQ2d at 11, many limitations warrant little, if any, range of equivalents.

In this case, we hold that the applicant's use of the term "majority" is not entitled to a scope of equivalents covering a minority for at least two reasons. First, to allow what is undisputedly a minority (*i.e.*, 47.8%) to be equivalent to a majority would vitiate the requirement that the "first and second longitudinal strips of adhesive . . . extend the majority of the lengths of said longitudinal marginal portions." '464 patent, col. 10, ll. 56-60. If a minority could be equivalent to a majority, this limitation would hardly be necessary, since the immediately preceding requirement of a "first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face" would suffice. Second, it

would defy logic to conclude that a minority – the very antithesis of a majority – could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise.

Moore's hypothetical claim analysis under *Wilson Sporting Goods* does not alter this conclusion. A hypothetical claim analysis is not an unbounded inquiry into the relevant scope of equivalents. *See Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d 974, 983, 50 USPQ2d 1515, 1521 (Fed. Cir. 2000) ("A hypothetical claim analysis is not an opportunity to freely redraft claims."). Such an analysis is not divorced from the claim language, but rather must be anchored in the limitation for which a range of equivalents is sought. *Cf. Warner-Jenkinson*, 520 U.S. at 29 ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole."). A hypothetical claim analysis cannot operate to the exclusion of the doctrine of prosecution history estoppel or the All Limitations Rule. *See id.* at 29, 34 (noting that prosecution history estoppel and the All Limitations Rule act to constrain the doctrine of equivalents). Given our holding that the All Limitations Rule bars Moore's desired scope of equivalents, Moore's poorly-articulated hypothetical claim analysis must also fail.

While Moore alleges that *Graver Tank* holds that an alleged infringer's knowledge and copying of a patent act allows a broader scope of equivalents, we discern nothing in the Supreme Court's opinion to support such a view. In fact, the Supreme Court's more recent opinion in *Warner-Jenkinson* implies the exact opposite by rejecting the relevance of the alleged infringer's intent upon the doctrine of equivalents. *See Warner-Jenkinson*, 520 U.S. at 35 ("Application of the doctrine of equivalents, therefore, is

akin to determining literal infringement, and neither requires proof of intent"). While the Supreme Court briefly touches upon the question of an alleged infringer's knowledge in *Warner-Jenkinson*, the Court mentions such knowledge only in the context of known interchangeability of substitutes for a claim limitation. *See id.* at 36; *see also Graver Tank*, 339 U.S. at 609 (recognizing the importance of known interchangeability).

Likewise, while Moore argues that the written description's teaching that the length of the first and second strips may be about "half of the length" of the longitudinal marginal portions gives rise to a scope of equivalents that would cover a "minority," our case law reveals that Moore is mistaken. In *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996), we explained the contrary principle that "subject matter disclosed in the specification, but not claimed, is dedicated to the public" in determining infringement under the doctrine of equivalents. *Id.* at 1107, 39 USPQ2d at 1007. Having fully disclosed two distinct embodiments, one in which the first and second longitudinal strips extend a majority of the length of the longitudinal marginal portions, and one in which they do not, Moore is not entitled to "enforce the unclaimed embodiment as an equivalent of the one that was claimed." *YBM Magnex, Inc. v. International Trade Comm'n*, 145 F.3d 1317, 1320, 46 USPQ2d 1843, 1845 (Fed. Cir. 1998).

Accordingly, we hold that the district court appropriately granted summary judgment of no infringement by equivalents of claim 1 of the '464 patent.[1]

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[1] We note that Moore does not contest SRC's claims that the accused SRC form cannot satisfy claim 1's requirement that the "third and fourth longitudinal strips of adhesive . . . extend[ ] a distance substantially less than the extent of said first and second strips," '464 patent, col. 10, ll. 62-65, since the corresponding third and fourth adhesive strips in the accused SRC are 99% of the lengths of the corresponding first and second

2. Infringement of Claims 9, 12, 16, and 17

Moore argues that the accused SRC form infringes claims 9, 12, 16, and 17 under the doctrine of equivalents, notwithstanding its inability to literally satisfy the following three elements:

> (1) "first and second longitudinal strips connecting at least said first and second sections . . . together at said longitudinal marginal portions";
>
> (2) "means defining a transverse adhesive strip on said first face . . . in said third section"; and
>
> (3) "means defining a transverse line of weakness adjacent said transverse strip in said third section, on the opposite side thereof from said second section."

Moore contends that the accused SRC form is merely a rearrangement of the claim limitations. According to Moore, the accused SRC form is functionally identical to the patented forms of claims 9, 12, 16, and 17, because it also yields an integral, detachable envelope.

Moore argues that the district court erred by rejecting the Supreme Court's 1929 decision in *Sanitary Refrigerator Co. v. Winters*, 280 U.S. at 30, and instead relying upon our decision in *Sage*, 126 F.3d at 1420, 44 USPQ2d at 1103, as barring the application of the doctrine of equivalents to SRC's rearrangement of the claim limitations. Emphasizing the Court's references in *Sanitary Refrigerator* to "form and position" and "reciprocal changes," 280 U.S. at 42, Moore

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adhesive strips. While we do not rely on the absence of this element from the accused SRC form to support our holding of non-infringement of claim 1, we note that its absence would provide yet another ground for affirming the district court's grant of summary judgment with respect to this claim.

contends that *Sanitary Refrigerator* expressly condones the application of the doctrine of equivalents to mere rearrangements of claim limitations. To the extent that *Sage* and *Sanitary Refrigerator* conflict, Moore argues, *Sanitary Refrigerator* must prevail.

Moore again advances a hypothetical claim under *Wilson Sporting Goods* to support its theory of equivalence. According to Moore, if two of the missing limitations were redrafted as:

> (1) "first and second longitudinal strips connecting at least said [first] third and second sections . . . together at said longitudinal marginal portions"; and
>
> (2) "means defining a transverse adhesive strip on said first face . . . in said second or third section,"

(bracketed material deleted and underlined material added), the redrafted claims would literally read on the accused SRC form. Moore argues that such claims would be clearly allowable over the prior art.

We reject Moore's overreaching attempt to apply the doctrine of equivalents to the accused SRC form under either a "functional" approach or by a hypothetical claim analysis under *Wilson Sporting Goods*. Both approaches would necessarily vitiate the requirement of claims 9, 12, 16, and 17 that the "means defining a transverse line of weakness [be] adjacent said transverse strip in said third section, on the opposite side thereof from said second section." The accused SRC form undisputedly has a transverse line of weakness adjacent the transverse strip in its *second* section on the *same* side as the *third* section. Given the location of this transverse line of weakness in the second section, the line cannot possibly be on the "opposite side thereof from said second

section." Notably, Moore's hypothetical claim analysis is entirely devoid of *any* explanation as to how its desired scope of equivalents would accommodate this limitation.

Moore's appeal to the Supreme Court's decision in *Sanitary Refrigerator* also founders. While *Sanitary Refrigerator* undisputedly refers to "reciprocal changes," it nowhere authorizes the rearrangement of claim limitations. *Sanitary Refrigerator* involved an automatic latching device with "two reciprocal changes" to the form of a patented structure: "one by the insertion of the lug on the keeper head, and the other in the shortened upper arm of the latch." *Sanitary Refrigerator*, 280 U.S. at 42-43. The Supreme Court explained the operation of accused device:

> The coaction of this shortened arm with the lug operates, however, on the cam principle, just as the coaction of the longer upper arm with the curved upper surface of the keeper head in the Winters and Crampton structure [*i.e.*, the patented device], to trip or kick the lower arm of the latch lever into the wedged position under the keeper head.
>
> . . .
>
> [T]he surface of the lug forms in effect the upper side of the keeper head as a substitute for the upper side in the Winters and Crampton structure, which, while left in place, performs no function whatever, just as if it were cut away.

Id. at 41. The Court declared, "A close copy which seeks to use the substance of the invention, and although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement." *Id.* at 42. Because "one alone of these [two reciprocal] changes cannot be substituted in the Winters and Crampton structure without the other, so as to make it operative," the Court concluded

that the changes were "plainly insufficient to avoid the infringement." *Id.* at 42-43.

As the preceding discussion clearly demonstrates, *Sanitary Refrigerator* concerned the typical doctrine of equivalents scenario in which the alleged infringer substitutes insubstantially different elements for the claim limitations; the lug substituted for the upper side of the keeper head, and the upper arm was necessarily shortened to accommodate this lug. Given its factual predicate, *Sanitary Refrigerator* cannot properly be viewed as a case sanctioning the rearrangement of claim limitations. Thus, contrary to Moore's belief, *Sanitary Refrigerator* does not conflict with our holding in *Sage* that where an "issued patent contains clear structural limitations, the public has a right to rely on those limits in conducting its business activities," and the doctrine of equivalents does not apply. *Sage*, 126 F.3d at 1425, 44 USPQ2d at 1108.

We further note that *Sanitary Refrigerator* lacks any discussion of the All Limitations Rule, the vitality of which the Supreme Court has more recently confirmed. *See Warner-Jenkinson*, 520 U.S. at 29-30. As previously discussed, allowing the allegedly "reciprocal changes" in this case to give rise to infringement by equivalents would vitiate the limitations of claims 9, 16, 17, and 19 that the "means defining a transverse line of weakness [be] adjacent said transverse strip in said third section, on the opposite side thereof from said second section." Even assuming, as Moore argues, that *Sanitary Refrigerator* does allow the rearrangement of claim limitations, such rearrangement must not "effectively vitiate [an] element in its entirety." *Warner-Jenkinson*, 520 U.S. at 29.

Accordingly, we hold that the district court appropriately granted summary judgment of no infringement by equivalents of claims 9, 12, 16, and 17 of the '464 patent.[2]

B. The '798 Patent

1. Construction of the "Distance Sufficient" Limitation

Moore contends that the district court erroneously construed the "distance sufficient" limitation of claim 1 of the '798 patent as constrained by the particular specifications of the IBM 3800 printer. Moore emphasizes that claim 1 recites "a printer used to process the mailer during pausing of the printer," and not "an IBM 3800 printer." Moore argues that the district court, by requiring that the "distance sufficient" be "more than one quarter inch," improperly imported a limitation from the written description into the claim in contravention of multiple decisions of this court, including *SRI International v. Matsushita Electric Corp.*, 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985) (en banc). The district court's reliance on the title of the '798 patent, "Pressure Seal Adhesive Pattern for IBM 3800 Printers," Moore maintains, was also unjustified, because there is no case in which the title of a patent was used to read a term into the claims.

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[2] We note that Moore does not contest SRC's claims that the accused SRC form lacks "outgoing address indicia" (as required by claims 9, 16, 17, and 19), "outgoing return address indicia" (as required by claims 9, 16, and 19), "return envelope address indicia" (as required by claim 9), "facilitating and suggesting" indicia (as required by claim 9), or a "die cut window" (as required by claim 12). While we do not rely on the absence of these elements from the accused SRC form to support our holding of non-infringement of claims 9, 16, 17, and 19 of the '464 patent, we note that their absence would provide yet another ground for affirming the district court's grant of summary judgment with respect to these claims.

Moore argues that, contrary to the district court's belief, nothing in the prosecution history requires reading the particular specifications of the IBM 3800 printer into the claims. According to Moore, the prosecution history in fact overwhelmingly militates against such a construction. During the prosecution of the '798 patent, the applicant responded to the examiner's indefiniteness rejection with respect to the "distance sufficient" limitation by declaring:

> It is respectfully pointed out that regardless of the fact that different printers have different spacings, *the invention is entitled to a scope that covers all printers*. The fact that a claim is broad does not mean that it is vague or incomplete.

(emphasis added). In response to the examiner's continued rejection that claim 1 was indefinite "because it is impossible to determine the distance claimed in the last paragraph," the applicant again responded:

> [The "distance sufficient" limitation] is a functional description, providing a complete, definite and accurate statement of what the spacing should be. The fact that the spacing is not in numerical terms is irrelevant since a functional term such as this, so long as it is itself definite, is entirely appropriate. This is exactly what *In re Halleck* [166 USPQ 204 (C.C.P.A. 1970)] holds. *In Halleck*, the exact numerical amount of chemical added to the animal feed was not critical or specified, but rather the functional term "an effective amount for growth stimulation". That is the same situation here. The exact numerical spacing is not critical, and will vary from printer to printer, just as the effective amount of growth hormone in *Halleck* varied from animal to animal. . . .
>
> . . .

> It is impossible for the applicant to anticipate printers with pauses that come out on the market in the future, and measure the exact distance that is necessary for such printers with pauses in the future, but that does not mean that applicant should be denied the rights to his invention. Anyone can determine whether or not they infringe by comparing their product with the functional recitation of claim 1, which is *entirely definite*. . . .
>
> . . .
>
> Claim 1 is not indefinite, merely broad enough to protect the applicant's real invention.

Moore maintains that these excerpts from the prosecution history, coupled with the examiner's subsequent allowance of the claims, clearly reveal the applicant's intent and the examiner's understanding that "distance sufficient" is not limited to the particular specifications of the IBM 3800 printer.

Notably, SRC does not dispute that the "distance sufficient" limitation is not limited to the IBM 3800 printer for claim construction purposes (though it contends otherwise for infringement purposes). In fact, SRC goes so far as to suggest that the district court did not "assume that the only printer that the limitations of the claims could relate to is an IBM 3800 printer," as Moore maintains. SRC concedes that:

> [i]t is obviously possible that, in the future, some other company will put out a printer that functions in the same way as the IBM 3800 printer or that IBM will put out another printer that functions in that same way. If that occurs, and if SRC were to put out a form designed for use with that printer in

the fashion specified by the claims in the '798 patent, then those forms would infringe.

We agree with the parties that the "distance sufficient" limitation is not limited to the particular specifications of the IBM 3800 printer. We first note that the plain language of claim 1 recites a "printer" generally, and nowhere mentions the IBM 3800 printer. The preamble, for example, refers to "a printer having rollers, and operated to occasionally pause." '798 patent, col. 6, ll. 50-51.

While the written description refers repeatedly to the IBM 3800 printer, it clarifies that a form for use on an IBM 3800 printer is only the preferred embodiment. *See* '798 patent, col. 1, ll. 40-41 (discussing the "present invention" and referring generally to a "printer used to process the mailers"); *id.*, col. 1, ll. 52-56 (discussing "one aspect of the present invention" and referring to the use of an "IBM 3800 printer having fuser and backup rollers"). Such "[r]eferences to [the] preferred embodiment . . . are not claim limitations." *See Laitram*, 863 F.2d at 865, 9 USPQ2d at 1299. That the title also refers to an IBM 3800 printer does not change our analysis, since the bar on importing limitations from the written description into the claims applies no less forcefully to a title. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1312, 51 USPQ2d 1161, 1171 (Fed. Cir. 1999) ("If we do not read limitations into the claims from the specification that are not found in the claims themselves, then we certainly will not read limitations into the claims from the patent title.").

The prosecution history further informs our analysis. The examiner's indefiniteness rejection with respect to the "distance sufficient" limitation reveals the examiner's belief that the limitation was not restricted to any particular printer. The applicant's responses to these rejections clearly demonstrate a similar understanding on his part. That the

examiner yielded to the applicant's arguments by allowing the claims does not, as the district court suggested, establish that the "distance sufficient" limitation must be limited to the particular specifications of the IBM 3800 printer. On the contrary, the examiner's acquiescence indicates his acceptance of the "distance sufficient" limitation as functionally claimed and as properly definite under 35 U.S.C. § 112, ¶ 2. We note that there is nothing wrong with defining the dimensions of a device in terms of the environment in which it is to be used. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575-76, 1 USPQ2d 1081, 1087-88 (Fed. Cir. 1986) (holding that the limitation that the claimed wheelchair have a "front leg portion . . . so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof" was not indefinite).

While SRC implies that the district court's claim construction is consistent with the preceding discussion, we cannot agree. The district court plainly concluded that "the 'distance sufficient' limitation in claim 1 is in reference to the IBM 3800 printer." *Moore I*, slip op. at 8; *see also id.* at 6 ("In other words, the 'distance sufficient' limitation, according to plaintiff, would be a variable that depends on the type of printer used. The court disagrees."). Despite SRC's attempt to disavow this statement, we agree with Moore that the district court must have meant what it said, and consequently erred. As we explain below, however, this error was entirely harmless.

2. Infringement

Moore contends that, because the district court erred in its construction of the "distance sufficient" limitation, we must vacate the grant of summary judgment of non-infringement of the '798 patent. Moore emphasizes that, by SRC's own admission, the adhesive on the accused SRC

form does not cause problems with respect to the rollers of any printer. From this fact, Moore deduces that SRC must have solved the problem of the adhesive interfering with printer rollers by spacing the adhesive away from the transverse end edges of the forms, and consequently must literally infringe.

Even in the absence of literal infringement, Moore argues that the accused SRC forms still infringe under the doctrine of equivalents by performing "substantially the same function in substantially the same way to get substantially the same result." At the very least, Moore urges us to vacate the district court's grant of summary judgment of non-infringement since its declarations in opposition to summary judgment raised a genuine issue of material fact.

Moore bears the burden of proof on infringement, but has failed to provide any evidence demonstrating or even suggesting SRC's use of any printer other than the IBM 3800, for which the "distance sufficient" limitation of claim 1 would have to be at least 5/16 of an inch away from the transverse edges to avoid interference with the printer rollers. This is greater than the distance of the adhesive from the transverse edges of the SRC products in evidence. Moreover, Moore does not dispute that the adhesive, spaced as it is from the transverse edges of the SRC products, engages the rollers of an IBM 3800 printer and, thus, does not and cannot avoid interference with such rollers. Therefore, we hold that SRC cannot infringe claims 1, 2, 4, and 10 as a matter of law. *See Celotex Corp. v. Caltrett*, 477 U.S. 317, 323 (1986) ("The moving party is 'entitled to a judgment as a matter of law' because the nonmoving party has failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof.") (internal citation omitted).

Moore's proffered declarations are insufficient to alter this result. A party may not overcome a grant of summary judgment by merely offering conclusory statements. *See Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 836, 221 USPQ 561, 564 (Fed. Cir. 1984). Moore's declarations allege that the accused SRC forms avoid interference with the printer rollers by being spaced at such distance as to avoid contact with the IBM 3800 printer rollers, which undisputedly impact the form at 1/4 inch from its transverse edge. Yet these allegations are entirely lacking in factual support. For example, the declaration of Moore's counsel, Robert Vanderhye, states:

> [W]hat is set forth in the Mudry declaration is incorrect and that there are SRC forms having a spacing of much greater than 1/16 of an inch, in fact even more than 1/4 inch. In particular, I have measured the spacing . . . for a number of different SRC forms. Four different forms have spacing . . . of well more than 1/16 inch, and two still different forms have spacings of more than 1/8 inch.

Given that the roller impression area of the IBM 3800 printer is 1/4 inch, forms with adhesive spaced 1/16 inch or 1/8 inch away from their transverse edges cannot literally infringe. Moore's other alleged evidence of literal infringement, two declarations from an account executive and a senior research engineer employed by Moore, generally claim that SRC has modified the spacing of its adhesive on its forms to reduce printing problems; these declarations lack any quantitative description of the increase in the relevant spacing dimension, however.

We also hold that SRC cannot literally infringe claims 3, 5-9, and 11-16. Each of these claims expressly requires that the adhesive strip be located 5/16 inch away from the transverse edge. As previously discussed, Moore's

declarations opposing summary judgment do not create a genuine issue of material fact as to whether the adhesive on the accused SRC form is 5/16 inch away from the transverse edge. *See Vivid Techs., Inc. v. American Science & Eng'g, Inc.*, 200 F.3d 795, 806-07, 53 USPQ2d 1289, 1297 (Fed. Cir. 1999) (holding that party opposing summary judgment must show either that movant has not established its entitlement to judgment on the undisputed facts or that material issues of fact require resolution by trial).

We reject Moore's bald claim that the doctrine of equivalents applies to the claims of the '798 patent. The mere recital of the *Graver Tank* mantra that the accused device performs "the same function, in the same way, to achieve the same result," without more, does not create a genuine issue of material fact as to whether an accused device infringes by equivalents. Moore offers nothing to rebut SRC's claim that its adhesive avoids interference with the rollers of the IBM 3800 printer not as a result of its spacing from the transverse edge, but rather due to its superior composition.

C. The '110 Patent

1. Claim Construction

Moore argues that the district court erred in granting summary judgment of non-infringement of the '110 patent due to the accused SRC form's inability to literally satisfy the "devoid of adhesive" limitation of claims 1 and 11 and in view of the prosecution history. According to Moore, the district court failed to evaluate the "devoid of adhesive" limitation in view of the prior art and the prosecution history, as Moore alleges is required by *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1566, 24 USPQ2d 1321, 1327 (Fed. Cir. 1992).

Moore emphasizes that the Conti patent depicts a form with adhesive strips that extend the entire distance between the longitudinal lines of weakness at both end edges. Given this teaching of the Conti patent, Moore theorizes that "devoid of adhesive" must be construed as encompassing a form with "no adhesive extending *substantially completely* along *both the end edges* between the lines of weakness as in Conti." (Emphasis added.) Alternatively stated, Moore believes that the "devoid of adhesive" limitation extends to forms with adhesive absent from all but one end edge, along which intermittent adhesive extends. Moore further suggests that the phrase "along said end edges" requires that the adhesive not merely be *near* the end edges, but that the adhesive actually *abut* the end edges, as depicted in the Conti patent.

We reject each of Moore's claim construction arguments seriatim. With respect to Moore's belief that the sheet need only be devoid of adhesive that extends "substantially completely" between the longitudinal lines of weakness, we note that the Conti patent discloses an intermittent strip of non-permanent adhesive along the transverse end edge on one face, *see* Conti patent, col. 3, ll. 33-38; Moore even offered a declaration by David Wagner highlighting this teaching. Because, by Moore's own evidentiary submissions, the adhesive strip in the Conti patent need not be "substantially complete," but can in fact be intermittent, we are perplexed by Moore's reliance on the prior art as somehow supporting a construction of "adhesive" as limited to a substantially complete strip. We further note the applicant's statement during the prosecution of the '110 patent that "if one were to remove the adhesive from the end edges of Conti, the remaining elements of Conti would not perform the same function as before." The applicant was plainly speaking of the removal of *all* the adhesive, not merely portions.

While Moore contends that a form that is devoid of adhesive between the longitudinal lines of weakness along all but one end edge would still infringe, the plain language of the claim does not limit the "devoid of adhesive" limitation to only one face or only one edge. Both claims 1 and 11 refer to the sheet as having "opposite end edges" (plural) and first and second faces, and we discern nothing in the plain language of the claims or the written description that would limit the reference to "said end edges" in the "devoid of adhesive" limitation to only some, but not all, of the end edges. In fact, the written description suggests the contrary, since all of its figures depict a form with no adhesive along *any* of the four end edges between the longitudinal lines of weakness. *See* '110 patent, Figs. 1-3.

Finally, with respect to Moore's bare contention that "along" requires that the strip abut the end edge and not merely be "near" the end edge, we emphasize that the plain meaning of "along" does not so require. According to *Webster's II New Riverside University Dictionary*, "along" means "1. Over, through, or by the length of <roses growing *along* the fence>." *Webster's II New Riverside University Dictionary* 95 (1984) (emphasis added). The definition of "by," in turn, is "1. Next to: close to <the light *by* the window>. *Id.* at 214 (emphasis added). These definitions clearly demonstrate that "along" does not require that a first item *abut* a second item, but rather can be "near" the second item.

2. Infringement

Moore argues that summary judgment of non-infringement was improper since the widely-spaced adhesive patches on the accused SRC form (1) are near, but not "along," the end edge, (2) do not extend "substantially completely" between the longitudinal lines of weakness, and (3) are absent from at least three of the four end edges. In view of our rejection of Moore's arguments with respect to "substantially completely," "end edges," and "along," we hold that the accused SRC form cannot literally satisfy the "devoid of adhesive" limitation of claims 1 and 11. Claims 1 and 11 positively recite the absence of a feature undisputedly present in the accused form, *i.e.*, adhesive extending along an end edge between the longitudinal lines of weakness. Consequently, the district court appropriately granted summary judgment of no literal infringement of the '110 patent.

With respect to the doctrine of equivalents, Moore argues that the accused SRC form is insubstantially different from the claimed form. Moore emphasizes that, like the claimed form, the accused SRC form does not require a tear strip along its transverse edge to open the mailer; rather, after tearing along the form's longitudinal perforation lines, the recipient can untack the mailer by running his or her finger between the adhesive patches. Moore deduces that the adhesive patches in the accused SRC form, by minimizing the amount of adhesive, waste, and costs, essentially function like *no* adhesive at all. While conceding that the accused SRC form "will open just as easily [as the patented mailer], just with slightly more difficulty," Moore contends that the accused SRC form "functions like the Moore form, in the same way, to get the same results."

Yet again, Moore advances the hypothetical claim analysis of *Wilson Sporting Goods* to support its theory of

equivalents. According to Moore, a hypothetical claim adding the phrase "that requires a tear strip" after "devoid of adhesive" would avoid the Conti patent, but encompass the accused SRC form.

Moore contends that the district court erroneously viewed the doctrine of prosecution history estoppel as barring its entitlement to any scope of equivalents for the "devoid of adhesive" limitation. Moore cites *Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 46 USPQ2d 1285 (Fed. Cir. 1998), and *Litton Sys. v. Honeywell, Inc.*, 145 F.3d 1472, 47 USPQ2d 1106 (Fed. Cir. 1998), as support for the proposition that limiting a claim during prosecution does not necessarily preclude all applicability of the doctrine of equivalents. Moore argues that the applicant amended the "devoid of adhesive" limitation of claims only to comply with the definiteness requirement of 35 U.S.C. § 112, ¶ 2, and that he added no limitations that would preclude interpretation of the claims from covering the accused SRC form.

We hold that the accused SRC form cannot infringe the '110 patent under the doctrine of equivalents. The doctrine of prosecution history estoppel limits the scope of equivalents by excluding subject matter surrendered by the applicant while prosecuting the patent. *See Warner-Jenkinson*, 520 U.S. at 33. In prosecuting the '110 patent, Moore argued that it was advantageous not to secure the edge with adhesive. The prosecution history makes clear that the absence of *any* adhesive, not some adhesive, was necessary to secure allowance of the claims. Consequently, Moore is not entitled to a scope of equivalents that would cover a form possessing adhesive along one of its end edges between the longitudinal marginal portions, and SRC cannot infringe under the doctrine of equivalents. As discussed above, Moore's hypothetical claim under *Wilson Sporting Goods* must also

fail, given that prosecution history estoppel trumps such an analysis where both are applicable.[3]

D. Evidentiary Matters

Moore complains that the district court's grant of summary judgment was premature in view of Moore's declarations under Federal Rule of Civil Procedure 56(f),[4] submitted in response to each of SRC's motions for summary judgment. Moore contends that these declarations sufficed to successfully oppose summary judgment. In its declarations, Moore claimed that it was critical for it to obtain certain allegedly infringing forms from SRC in order to successfully oppose summary judgment. Moore argues that the district court improperly rejected its Rule 56(f) submissions in granting summary judgment of non-infringement of the '798 and '110 patents and ignored its Rule 56(f) submission in granting summary judgment of non-infringement of the '464 patent.

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[3] We note that, even were we to assume that the doctrine of prosecution history estoppel was inapplicable, we would still affirm. The presence of a feature in an accused device (here, adhesive) cannot possibly be equivalent to the claimed absence of that feature, and no reasonable factfinder could conclude otherwise. Particularly damning to Moore's theory of equivalents are its prosecution statements regarding the particular advantages arising from the absence of adhesive and its concession that the accused SRC mailer opens with "slightly more difficulty" than the patented forms.

[4] Rule 56(f) states:

> **When Affidavits are Unavailable.** Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

Moore further complains that the district court erred by granting summary judgment before the parties had conducted any significant factual discovery. Moore emphasizes that the parties had not taken a single deposition, SRC had not provided Moore with a single copy of any document, and over four months of discovery remained at the time of the district court's final grant of summary judgment. Moore also contends that SRC had not fully responded to Moore's interrogatories. Moore analogizes this case to *Burnside-Ott Aviation Training Ctr., Inc. v. United States*, 985 F.2d 1574 (Fed. Cir. 1993), a contract dispute in which we vacated a grant of summary judgment because, *inter alia*, the plaintiff had been given inadequate time (*i.e.*, two months) for discovery to oppose summary judgment and the government had failed to respond to all of the plaintiff's discovery requests. *See id.* at 1582.

Finally, Moore seeks to supplement the current record on appeal with evidence concerning another SRC form, which it alleges infringes the '464 patent. Moore contends that it only recently uncovered information that SRC had been commercializing this form and that it had not previously conducted discovery regarding this form in reliance on SRC's contrary representations regarding commercialization. Moore argues that this evidence demonstrates the prematureness of the district court's grant of summary judgment.

Intrusions into a district court's trial management are rarely appropriate on appeal. *See National Presto Indus., Inc. v. West Bend Co.*, 76 F.3d 1185, 1197, 37 USPQ2d 1685, 1694 (Fed. Cir. 1996). We have reviewed Moore's declarations under Rule 56(f) and conclude that the district court correctly refused to allow Moore to conduct "'fishing expeditions' in hopes of finding products that might be infringing" to oppose summary judgment. *Moore I*, slip op. at 15. Contrary to Moore's contentions, its Rule 56(f)

declarations did not indicate how additional discovery would enable Moore to create a genuine issue of material fact regarding SRC's non-infringement of the three patents. Moore does not contest SRC's claim that Moore's counsel had been allowed to inspect all the accused SRC forms at SRC's headquarters and that the accused SRC forms were publicly available. Consequently, we cannot agree that the district court abused its discretion in refusing to allow additional discovery.

We likewise reject Moore's attempt to analogize the facts of this case to those in *Burnside-Ott*. In *Burnside-Ott*, we noted that the trial judge had "exercised commendable trial management in trying to eliminate unnecessary discovery . . . based on his view of the law." 985 F.2d at 1582. Since we determined that the trial judge had erred in barring the plaintiff's equitable estoppel and mutual mistake claims as a matter of law, we remanded the case for additional discovery. *See id.* at 1582-83. Like the trial judge in *Burnside-Ott*, the district court here should be applauded for his expedient handling of this case. But for its harmlessly erroneous claim construction of the '798 patent's "distance sufficient" limitation, the district court's application of patent law was entirely correct. Thus, we need not vacate any of its orders granting summary judgment in order to allow additional discovery.

Finally, with respect to Moore's request to supplement the record with evidence concerning an allegedly infringing form that was not before the district court, we note that the record on appeal is generally limited to that which was before the district court. *See* Fed. R. App. P. 10(a). We are especially reluctant to expand the record on appeal where, as here, the party seeking expansion of the record offers no reasonable basis for its failure to produce the proffered evidence at an earlier time. *Cf. Dakota Indus., Inc. v. Dakota Sportswear, Inc.*, 988 F.2d 61, 63 (8th Cir. 1993). Moore

concedes that its allegedly new evidence of infringement had been made available to it for inspection while litigation was ongoing before the district court. Additionally, Moore does not deny that this allegedly new evidence of infringement was within its possession even before it initiated this lawsuit against SRC. While Moore complains that SRC deceived Moore into not seeking discovery regarding this form by claiming that SRC had not commercialized the form, we note that SRC's commercialization of the newly discovered form was not a prerequisite for an infringement claim under the '464 patent; 35 U.S.C. § 271 (1994) also authorizes a finding of infringement by one's manufacture or use of a patented invention. Consequently, we deny Moore's request that we expand the record on appeal.

E. Cross-Appeal of Invalidity

Given our affirmance of the summary judgment of non-infringement of all asserted claims, we dismiss SRC's conditional cross-appeal of invalidity as moot.

CONCLUSION

Accordingly, we

AFFIRM.

NEWMAN, *Circuit Judge*, concurring-in-part and dissenting-in-part.

I concur in the judgment of non-infringement with respect to the '798 patent, the '110 patent, and claim 1 of the '464 patent,[1] although I do not share the court's reasoning with respect to either the '798 or the '464 patents. For claim 9 and related claims of the '464 patent, I would reverse the summary judgment and remand for determination of infringement on the correct law.

The '798 Patent

The '798 patent is directed to a conventional Z-fold business form whose adhesive structure has been adjusted to avoid sticking to the IBM 3800 printer, which is designed for printing such forms. The '798 patent explains that when forms bearing pressure-sealable adhesive in the "conventional" position at the edge of the form were printed with the IBM 3800 printer, the adhesive would stick to the printer rollers. The '798 patent analyzed this problem as follows:

> The IBM 3800 printer operates in such a way that it pauses at regular intervals. When the printer pauses, it has been found that an impression is created 1/4 inch on either side of the fold perforations between forms in the continuous web. Since there is adhesive in that impression area, the forms are caused to stick to the fuser roll and/or the backup roller. This then results in the forms jumping out of time, warping the fuser rolls, etc., as described above.

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[1] United States Patent No. 5,253,798, United States Patent No. 5,314,110, and United States Patent No. 5,201,464.

The patentee solved this problem "in a simple yet effective manner," by repositioning the adhesive to about 5/16 inch from the edge, thereby avoiding the IBM 3800 roller impression area at 1/4 inch and preventing adhesion to the roller.

Patent claim 1 is representative, with emphasis added to show the claim elements relevant to infringement by the accused SRC forms:

> 1. A mailer type business form processed by ***a printer having rollers, and operated to occasionally pause***, the mailer comprising:
>
> a folded paper sheet having first and second faces, first and second opposite longitudinal edges, and first and second transverse fold lines defining first, second and third sections of said sheet;
>
> first and second longitudinal lines of weakness forming with said longitudinal edges first and second longitudinal marginal portions;
>
> a first transverse edge and a second transverse edge, both parallel to said first and second fold lines;
>
> longitudinal patterns of adhesive disposed in said longitudinal marginal portions for holding said marginal portions of said first through third sections together;
>
> a first transverse pattern of adhesive disposed adjacent said first transverse edge on said first face and first section; and
>
> said first transverse pattern of adhesive being spaced from its associated transverse edge ***a distance sufficient to insure that the adhesive does***

not interfere with rollers of a printer used to process the mailer during pausing of the printer.

The district court ruled, as a matter of claim construction, that the claims were limited to the IBM printer and the distances described for that printer. The IBM 3800 is the only printer mentioned in the patent, which is entitled "Pressure Seal Adhesive Pattern for IBM 3800 Printers." The court relied on the frequent references to the IBM 3800 in the specification "and indeed in the title of the patent itself," and construed "distance sufficient" in the final clause to mean "more than 1/4 inch," the only distance described in the patent.

Moore argues that the claims are not limited to the IBM printer or the placing of the adhesive, and that any forms whose adhesive does not stick to the rollers are covered by the claims, correctly construed. The panel majority agrees with Moore that the claims are not limited to the IBM 3800 printer and the adhesive distances described in the specification, and rules that the district court erred in its claim construction. I do not agree with my colleagues' claim construction. However, their ruling raises a larger concern.

Despite their rejection of the district court's claim construction, my colleagues then mysteriously interpret the claims in the identical way as did the district court, that is, limited to the IBM 3800 printer and the adhesive distances described in the specification. Having explicitly construed the claims as not limited to forms for use with the IBM 3800 printer, the panel majority nonetheless rules that since the SRC forms are not limited to use with the IBM 3800 printer, there can not be infringement as a matter of claim construction. Further, it is undisputed on the record that the SRC forms are fully usable with the IBM 3800 printer. Since the claims as construed by the majority read on the SRC forms, it is, simply, confusing to rule that there can not be

infringement as a matter of law. Extensive precedent requires that claims be construed the same way for all purposes. I must, respectfully, dissent from this novel ruling.

The '464 Patent

The '464 patent is directed to a C-fold mailer-type business form having an integral return envelope. The patented invention is designed to facilitate manufacture of the mailer as well as its use by the consumer. At issue with respect to the accused SRC mailer are the length and placement of various adhesive strips. Claims 1 and 9 are representative, with emphases added to highlight the terms relevant to the issues of infringement:

> 1. A mailer type business form intermediate, comprising:
>
> [a] a sheet of paper having a first face, adapted to provide the majority of the interior of the mailer when constructed, and a second face, adapted to provide the majority of the exterior of the mailer when constructed;
>
> [b] said sheet having first and second opposite, parallel longitudinal edges extending the entire length thereof, and opposite ends;
>
> [c] first and second longitudinal lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;
>
> [d] ***first and second longitudinal strips of adhesive*** disposed in said first and second longitudinal marginal portions, respectively, of said first face, ***extending the majority of the lengths of***

said longitudinal marginal portions, and parallel to said first and second longitudinal edges;

[e] ***third and fourth longitudinal strips of adhesive*** disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips disposed closer to one end of said ends than the other, and ***extending a distance substantially less than the extent of said first and second strips***;

[f] fifth and sixth longitudinal strips of adhesive parallel to said first and second longitudinal edges and disposed in said first and second marginal portions, respectively, on said second face, said fifth and sixth strips located adjacent the same end of said sheet as said third and fourth strips, and having a longitudinal extent at the most equal to said and fourth strips;

[g] ***means defining a transverse adhesive strip on said first face***, perpendicular to said third and fourth strips, longitudinally spaced from said third and fourth strips; and

[h] ***means defining a line of weakness adjacent said transverse strip***, on the opposite side thereof from said third and fourth strips to allow ready separation of the paper at that line.

9. A mailer type business form, with integral return envelope, comprising:

[a] a C-fold paper sheet having first and second faces, first and second opposite longitudinal edges extending the entire length thereof, and first and

second transverse fold lines defining first, second and third sections of said sheet;

[b] said second and third sections being larger than said first section;

[c] first and second lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining with said longitudinal edges, longitudinal marginal portions;

[d] first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, and parallel to said first and second longitudinal edges; ***said first and second longitudinal strips connecting at least said first and second sections, and said third and first sections***, together at said longitudinal marginal portions;

[e] third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips connecting said first section to a part of said second section to form the sides of a return envelope;

[f] ***means defining a transverse adhesive strip on said first face***, perpendicular to said third and fourth strips, ***in said third section;***

[g] ***means defining a transverse line of weakness adjacent said transverse strip in said third section***, on the opposite side thereof from said second

section, to allow ready separation of the form at that line;

[h] outgoing address, and outgoing return address, indicia visible from said second face of said third section;

[i] return envelope address indicia printed on said second face in said first section; and

[j] indicia facilitating and suggesting the insertion of return address information on said return envelope, said facilitating and suggesting indicia printed on said second face in both said second and third sections.

Moore appeals the summary judgment of non-infringement under the doctrine of equivalents, stating, correctly, that there are material issues of disputed fact which could not be decided adversely on summary judgment.

Claim 1, Clause [d] - The Length of the First and Second Longitudinal Adhesive Strips

For claim 1, the panel majority decides that there can not be equivalency of the elements of claim clause [d]. That ruling, which negates equivalency as a matter of law as between substantially identical elements having slight numerical differences, is not in accordance with precedent.

The panel majority holds that a strip length of 47.8% can not be equivalent to a strip length of 50+%, claimed as the "majority of the lengths" of the form. Whether 47.8% is equivalent to a majority is a question of fact, and could not be decided adversely to the patentee as a matter of law. The evidence of identity of function, way, and result, and of insubstantial difference, was not disputed on summary judgment; the question requires findings of fact, not summary disposition.

The panel majority also states that Moore dedicated to the public all embodiments less than the majority of the length. There is no support for such statement. Neither prosecution history estoppel nor prior art was asserted as limiting equivalency to over 50% of the length. Further, Moore points out that "none of the limitations at issue were added or argued to gain allowance of the claims asserted," citing *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997).

Moore raised a genuine issue of material fact as to whether the 47.8% length of the first and second longitudinal strips in the accused device is equivalent to the "majority of the lengths" of those strips in the patented device. Summary judgment of non-equivalency could not have been based on the evidence before the court.

In addition, claim 9, which requires only "first and second longitudinal strips connecting at least said first and second sections, and said third and first sections, together at said longitudinal marginal portions," does not limit the length of the first and second longitudinal strips to a "majority." Thus summary judgment on this ground can not apply to claim 9.

Claim 1, Clause [e] - The Third and Fourth Adhesive Strips

As to the third and fourth longitudinal strips, I agree with the district court that no reasonable jury could find equivalency between 98% and "substantially less than the [47.8%] extent of the said first and second strips." On this ground, I concur in the judgment as to claim 1.

Claim 9 - The Rearranged Claim Elements

For claim 9 and the claims grouped with claim 9, the district court ruled that there could be no infringement under the doctrine of equivalents if the accused infringer

rearranged any elements from their location described in the claim. Moore argues that SRC has merely rearranged the transverse adhesive strip, which required moving the tear strip for separating the return envelope and the accompanying adhesive, and that the elements "function in exactly the same way to get exactly the same results, i.e. allowing ready detachment of the reply envelope and ready use thereof as a return envelope."

The panel majority rules that the doctrine of equivalents can not be invoked to reach rearranged claim elements, as a matter of law. However, precedent contravenes such an automatic bar; equivalency in fact must be determined. In *Warner-Jenkinson Co.*, 520 U.S. at 40, 41 USPQ2d at 1875 the Court required "analysis of the role played by each element in the context of the specific patent claim." In *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929), the Court recognized that infringement based on equivalency may ensue when claimed elements are reciprocally rearranged. The Federal Circuit in *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989) recognized equivalency involving rearranged elements.

On this question of fact, summary judgment could not have been granted adversely to Moore. The case as to claim 9 should be remanded for finding of the facts of equivalency.

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

98-1386, -1387

MOORE U.S.A., INC.,
Plaintiff-Appellant,

v.

STANDARD REGISTER COMPANY,
Defendant-Cross Appellant.

JUDGMENT

ON APPEAL from the U.S. District Court for the Eastern District of Virginia *in CASE NO(S).* 97-CV-2054

This CAUSE having been heard and considered, it is

ORDERED AND ADJUDGED:

AFFIRMED.

ENTERED BY ORDER OF THE COURT

DATED Sep. 22, 2000 s/ Jan Horbaly/bg
Jan Horbaly, Clerk

ISSUED AS A MANDATE: DECEMBER 4, 2000

Costs Against the Appellant:
Total: $111.42

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	CIVIL ACTION NO.
v.	)	97-2054-A
	)	
STANDARD REGISTER COMPANY,	)	
	)	
	)	
Defendant.	)	

ORDER

This action comes before the court on defendant's motion for reconsideration of this court's April 3, 1998 Order, denying defendant's motion for summary judgment as to its defense of noninfringement under the doctrine of equivalents. Upon consideration of the parties' submissions and for the reasons set forth in the Memorandum Opinion filed herewith, it is hereby

ORDERED that defendant's motion is granted, and this action is hereby dismissed with prejudice.

s/ Albert V. Bryan, Jr.
Albert V. Bryan, Jr.,
United States District Judge

Alexandria, Virginia
April 17th, 1998

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	CIVIL ACTION NO.
v.	)	97-2054-A
	)	
STANDARD REGISTER COMPANY,	)	
	)	
Defendant.	)	

MEMORANDUM OPINION

On April 3, 1998, this court denied in part defendant's motion for summary judgment of noninfringement of the only patent remaining in this case, U.S. Patent No. 5,201,464 (the "'464 patent"). The motion was denied with regard to noninfringement under the doctrine of equivalents. The court had found that a genuine issue of material fact remains concerning whether the accused products function like the patented mailer, in the same way, to get the same result. Defendant now moves the court to reconsider its earlier ruling, and brings to the court's attention binding authority not cited before and new theories of noninfringement not advanced in its earlier motion. Finding defendant's motion to be well taken, the court will grant it, and this action will therefore be dismissed with prejudice.

Standard for Summary Judgment

Summary judgment is appropriate only when "there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P 56(c). In considering a motion for summary judgment, the court is not to weigh the evidence, but rather must determine whether there is a genuine issue for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). In so doing, the court must view the underlying facts in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

The party seeking summary judgment bears the initial responsibility of informing the district court of the basis for its motion, and of establishing – based on the relevant portions of the pleadings, depositions, affidavits, if any, answers to interrogatories, and admissions on file – that there is no genuine issue of material facts. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The nonmoving party must go beyond the pleadings and must, by its own affidavits and by the depositions, answers to interrogatories, and admissions on file, designate specific facts showing that there is a genuine issue for trial. *Id.* at 324.

There is no genuine issue for trial where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party. *Matsushita*, 475 U.S. at 587. The nonmoving party must do more than simply show that there is some metaphysical doubt as to the material facts. *Id.* At 586. Material facts are those whose determination will affect the outcome of the lawsuit, and an issue of material fact is genuine if the evidence is such that a reasonable jury could find for the nonmoving party. *Anderson*, 477 U.S. at 248.

Discussion

The '464 patent (Pressure Seal C-Ford Two-Way Mailer) is directed to a C-fold simple mailer with an integral return envelope. The mailer is a single sheet of paper that is capable of being folded, sealed and mailed. The patent contains nineteen (19) separate claims, of which Claims 1, 9, 16, 17 and 19 are independent. Defendant Standard Register Company ("SRC") argued, and the court found, that none of the independent claims of the '464 patent is infringed literally by its accused products.

Defendants now renews its argument that no infringement under the doctrine of equivalents could be found either, citing principally the Federal Circuit opinions in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1424 (Fed. Cir. 1997) (an additional limitation on the application of the doctrine of equivalents is the patentee's own choice of claim language); and *Dolly, Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 400 (Fed. Cir. 1994) (the concept of equivalency cannot embrace a structure that is specifically excluded from the scope of the claims).

Specifically, defendant argues that the accused SRC form cannot infringe Claim 1 of the '464 patent under the doctrine of equivalents based on Moore's own choice of claim language that the patented mailer contains:

> first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, *extending the majority of the lengths of said longitudinal marginal portions,* and parallel to said first and second longitudinal edges. (Emphasis added).

Defendant's accused form contains longitudinal strips of adhesive that admittedly extend slightly less than a majority of the lengths of the longitudinal marginal portions. Defendant argues that under *Sage*, the doctrine of equivalents cannot be extended to cover defendant's form because that would effectively eliminate from Claim 1 the entire element of "the majority of the lengths" – language chosen by the patentee himself. The court agrees.

In *Sage*, the patent-in-suit disclosed a disposal container that allows a user to deposit hazardous medical waste without touching waste already in the container. 126 F.3d at 1422. The container included a container body with an elongated slot at its top. *Id.* A barrier, having a first constriction and a second constriction restricted access to the interior of the container body. *Id.* The Federal Circuit upheld the District Court's grant of summary judgment of noninfringement under the doctrine of equivalents finding that the claim elements of "an elongated slot at the *top of the container* body" and "a first constriction extending *over said slot*" were absent from the accused product. *Id.* at 1424. The court held that "the doctrine of equivalents does not grant Sage license to remove entirely the 'top of the container' and 'over said slot' limitations from the claim." *Id.*

Similarly here, extending the doctrine of equivalents to cover defendant SRC's accused form, whose first and second longitudinal strips of adhesive admittedly extend slightly less than a majority of the lengths of the longitudinal marginal portions would remove entirely the "majority of the lengths" limitation from Claim 1 of the '464 patent. This court, therefore, finds that defendant's form cannot infringe Claim 1 of the patent under the doctrine of equivalents.

Defendant makes a similar argument with regard to the remaining independent claims in the '464 patent, namely,

Claims 9, 16, 17 and 19. Defendant points out that each of those claims contains at least three distinct limitations which admittedly do not exist in defendant SRC's accused form. These limitations are:

(1) "means defining a transverse adhesive strip ... in said *third* section";

(2) "means defining a transverse line of weakness adjacent said transverse strip in said *third* section, on the opposite side thereof from said second section"; and

(3) "first and second longitudinal strips [of adhesive] connecting ... said *first and second* sections." (Emphasis added).

Under *Sage,* there can be no infringement under the doctrine of equivalents if the accused infringer "achieves a similar result ... but it does so by *a different arrangement of elements.*" 126 F.3d at 1425 (emphasis added). Each of these limitations is a clear structural limitation precluding expansion of these independent claims under the doctrine of equivalents.

Again, extending the doctrine of equivalents to cover the accused form would entirely eliminates these structural limitations from the claims of the '464 patent, an outcome made clearly inadmissible by the Federal Circuit's opinion in *Sage.*

There is some merit to plaintiff's argument that construing *Sage* as controlling here would make serious inroads on the doctrine of equivalents. Nonetheless, the clear language of the opinion in *Sage,* though applicable to easier facts there, precludes this court from holding otherwise. Plaintiff has chosen in the description of the patent claims to use the elements of "majority of the lengths," "in said third section," etc., and to allow the rearranging of these elements now would violate the language in *Sage.*

Although plaintiff points to a 1929 Supreme Court opinion that has to some extent condoned the rearrangement of elements in a patent claim, the Federal Circuit's language is unequivocal in rejecting such rearrangement, and this court at this stage is bound by the Federal Circuit's clear language.

Finally, plaintiff's argument that the motion for reconsideration is improper under *United States v. Dickerson*, 971 F. Supp. 1023 (E.D. Va. 1997), is unconvincing. The court had not been made aware of the *Sage* case in defendant's earlier motion, and thus did not consider its effect on this case. Although concerns of judicial economy should have motivated defendant to make all of its current arguments earlier, defendant is not precluded from advancing new theories of noninfringement now because the court's denial of defendant's earlier motion was not dispositive of the case.

Accordingly, the court finds that defendant's accused form cannot infringe Claims 9, 16, 17 or 19 of the '464 patent under the doctrine of equivalents.

Defendant's motion for reconsideration, therefore, is well taken, and summary judgment of noninfringement of the '464 patent is granted. As this is the only remaining patent in this case, this action is hereby dismissed with prejudice.

s/ Albert V. Bryan, Jr.
Albert V. Bryan, Jr.,
United States District Judge

Alexandria, Virginia
April 17th, 1998

APPENDIX D

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	CIVIL ACTION NO.
v.	)	97-2054-A
	)	
STANDARD REGISTER COMPANY,	)	
	)	
	)	
Defendant.	)	

ORDER

This action comes before the court on defendant's motion for summary judgment of patent noninfringement, pursuant to Fed. R. Civ. P. 56 and Local Rule 7, with regard to the only remaining patent in this case, U.S. Patent No. 5,201,464 (the "'464 patent"). Upon consideration of the parties' submissions, it is hereby

ORDERED that defendant's motion is granted in part and denied in part.

Background

Plaintiff Moore U.S.A., Inc. ("Moore") brought this patent infringement action against defendant Standard Register Company ("SRC") alleging infringement of four separate patents, including U.S. Patent No. 4,918,128 (the "'128 patent"), U.S. Patent No. 5,253,798 (the "'798 patent"), and

U.S. Patent No. 5,314,110 (the "'110 patent"), and the '464 patent. This court entered summary judgment of patent noninfringement with regard to the '128 patent on March 6, 1998, and with regard to the '798 patent and the '110 patent on March 20, 1998.

Defendant SRC now moves for summary judgment of patent noninfringement with regard to the '464 patent. Because the court finds that defendant's motion is only partially well taken, the motion will be granted with regard to the claim for literal infringement, but denied with regard to the claim for patent infringement under the doctrine of equivalents.

Standard for Summary Judgment

Summary judgment is appropriate only when "there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). In considering a motion for summary judgment, the court is not to weigh the evidence, but rather must determine whether there is a genuine issue for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). In so doing, the court must view the underlying facts in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

The party seeking summary judgment bears the initial responsibility of informing the district court of the basis for its motion, and of establishing – based on the relevant portions of the pleadings, depositions, affidavits, if any, answers to interrogatories, and admissions on file – that there is no genuine issue of material facts. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The nonmoving party must go beyond the pleadings and must, by its own affidavits and by the depositions, answers to interrogatories, and admissions on file, designate specific facts showing that there is a genuine issue for trial. *Id.* at 324.

There is no genuine issue for trial where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party. *Matsushita*, 475 U.S. at 587. The nonmoving party must do more than simply show that there is some metaphysical doubt as to the material facts. *Id.* at 586. Material facts are those facts whose determination will affect the outcome of the lawsuit, and an issue of material fact is genuine if the evidence is such that a reasonable jury could find for the nonmoving party. *Anderson*, 477 U.S. at 248.

Discussion

The '464 patent (Pressure Seal C-Fold Two-Way Mailer) is directed to a C-fold simple mailer with an integral return envelope. The mailer is a single sheet of paper that is capable of being folded, sealed and mailed. The patent contains nineteen (19) separate claims, five of which are independent claims -- namely, Claims 1, 9, 16, 17 and 19. Defendant SRC argues that none of the independent claims of the '464 patent is infringed, either literally or under the doctrine of equivalents, by its accused products.

In support of its motion, defendant recites several limitations in the claims of the '464 patent, arguing that because these limitations are absent from its accused products, summary judgment is appropriate in this case. The court does not agree entirely.

To be sure, although the significance of the differences highlighted by defendant between its accused products and the claims of the '464 patent – such as the fact that the first and second longitudinal strips of adhesive in the accused mailer do not extend along *the majority* of the length of the mailer – is questionable, these differences nonetheless exist. Indeed, plaintiff does not seriously dispute the existence of these differences. Rather, it argues that the differences are immaterial under the doctrine of equivalents. Thus, the court finds that

there is no issue of material fact with respect to the proposition that the terms of the independent claims of the '464 patent do not read literally on the accused products.

Accordingly, defendant motion for summary judgment is grated with regard to any claim of literal infringement of the '464 patent by defendant's accused products.

The finding of no literal infringement, however, does not end the analysis. Again, plaintiff argues that whatever differences may exist between the accused products and the patent's claims, they are immaterial under the doctrine of equivalents. Defendant, however, argues that the prosecution history of the '464 patent precludes any finding of equivalent elements in the accused products. The court disagrees.

Unlike the prosecution history of the '798 patent and the '110 patent – on which defendant relied to argue against infringement of those patents under the doctrine of equivalents, the prosecution history of the '464 patent does not indisputably establish that the differences highlighted by defendant were insisted on by the Patent and Trademark Office as a condition to the issuance of the '464 patent.

The court, therefore, finds that there remains an issue of material fact concerning whether the accused products function like the patented mailer, in the same way, to get the same result; i.e., whether defendant's products infringe the '464 patent under the doctrine of equivalents. Accordingly, defendant's motion for summary judgment is denied with regard to plaintiff's claims for infringement under the doctrine of equivalents.

s/ Albert V. Bryan, Jr.
Albert V. Bryan, Jr.,
United States District Judge

Alexandria, Virginia
April 3rd, 1998

APPENDIX E

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	CIVIL ACTION NO.
v.	)	97-2054-A
	)	
STANDARD REGISTER COMPANY,	)	
	)	
	)	
Defendant.	)	

ORDER

This action comes before the court on defendant's two motions for partial summary judgment of patent noninfringement, pursuant to Fed. R. Civ. P. 56 and Local Rule 7. Upon consideration of the parties' submissions, it is hereby

ORDERED that

1. defendant's motion for partial summary judgment of noninfringement of U.S. Patent No. 5,253,798 is granted; and

2. defendant's motion for partial summary judgment of noninfringement of U.S. Patent No. 5,314,110 is granted.

I. *Background*

Plaintiff Moore U.S.A., Inc. ("Moore") brought this patent infringement action against defendant Standard Register Company ("SRC") alleging infringement of four separate

patents, including U.S. Patent No. 4,918,128 (the "'128 patent"), U.S. Patent No. 5,253,798 (the "'798 patent"), and U.S. Patent No. 5,314,110 (the "'110 patent"). This court entered summary judgment with regard to the '128 patent on March 6, 1998. Defendant SRC now moves for summary judgment of noninfringement with regard to the ' 798 patent and the '110 patent. Because the court finds that defendant's motions are well taken, they will be granted.

II. *Standard for Summary Judgment*

Summary judgment is appropriate only when "there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). In considering a motion for summary judgment, the court is not to weigh the evidence, but rather must determine whether there is a genuine issue for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). In so doing, the court must view the underlying facts in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

The party seeking summary judgment bears the initial responsibility of informing the district court of the basis for its motion, and of establishing – based on the relevant portions of the pleadings, depositions, affidavits, if any, answers to interrogatories, and admissions on file – that there is no genuine issue of material facts. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The nonmoving party must go beyond the pleadings and must, by its own affidavits and by the depositions, answers to interrogatories, and admissions on file, designate specific facts showing that there is a genuine issue for trial. *Id.* at 324.

There is no genuine issue for trial where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party. *Matsushita*, 475 U.S. at 587. The nonmoving

party must do more than simply show that there is some metaphysical doubt as to the material facts. *Id.* at 586. Material facts are those facts whose determination will affect the outcome of the lawsuit, and an issue of material fact is genuine if the evidence is such that a reasonable jury could find for the nonmoving party. *Anderson*, 477 U.S. at 248.

III. *Defendant's Motion on the '798 Patent*

The '798 patent (Pressure Seal Adhesive Pattern for IBM 3800 printers) discloses a Z-folded mailer type business form constructed so that it can be printed using an IBM 3800 printer. The key to the invention of the '798 patent was apparently solving the problem of the mailer sticking to the printer rollers while pausing during the printing of a form.

During operation of the IBM 3800 printer, the mailers are continuously fed into the printer, which pauses at regular intervals. During pauses, a 1/4 inch impression (caused by the roller) is created on either side of the form. Because conventional forms had pressure seal adhesive patterns located 1/16 inch from the leading and trailing edges of the individual forms in the continuous web (i.e. within the 1/4 inch impression area), the forms were sticking to the fuser roll and/or backup roller during pauses.

Apparently, plaintiff's invention was to simply apply the adhesive far enough away from the edge of the mailer such that it avoided the printer's rollers and thus the problem of sticking. Specifically, Claim 1 of the '798 patent contains the limitation that the adhesive pattern be "spaced from its associated transverse edge a distance sufficient to insure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer." Claim 13, the other independent claim in the patent, contains the limitation that the transverse pattern of the adhesive be spaced from its associated transverse edge a distance of about 5/16 inches.

Defendant's accused form is a continuous-web, Z-fold mailer, having three panels separated by fold lines. Strips of pressure-sensitive adhesive are positioned appropriately along the margins of the side panels to permit the mailer to be sealed after it is printed, torn from the continuous web, and folded.

Measurements of defendant's accused form indicate that the transverse strips of adhesive are spaced from their respective transverse edges by approximately 1/16 inch. The adhesive is within the 1/4 inch overlap of the IBM 3800 printer rollers onto defendant's form during the pause in its production, though apparently with no resulting interference with the rollers. Defendant asserts that it is unaware of the problem of adhesive on the accused form interfering with the printer rollers.

A. ***Analysis of the Claim 1 Noninfringement:***

Defendant argues that the accused form does not read on the '798 patent because the relevant distance in the accused form (1/16 inch) is less than the "more than 1/4 inch" distance constituting the "distance sufficient" limitation contained in Claim 1 of the patent. Indeed, defendant argues that 1/16 inch is precisely the distance acknowledged by plaintiff as existing in the prior art. Therefore, there can be no infringement of the '798 patent. Furthermore, because the accused form is constructed in accordance with admitted prior art, if Claim 1 of the '798 patent were to encompass the accused form, then Claim 1 itself would necessarily be invalid.

Plaintiff contends that the "distance sufficient" limitation contained in Claim 1 cannot be translated into a fixed dimension because the 1/4 inch distance cited by defendant is specific only to the IBM 3800 printer, while the limitation itself makes no mention of a specific printer. In other words, the "distance sufficient" limitation, according to plaintiff, would be

a variable that depends on the type of printer used. The court disagrees.

Infringement analysis must begin with construction of the patent's claims, which, of course, is a question of law for the court. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996). Construction of the claim should be based on the intrinsic evidence of the claim language itself, the patent's specification, the prior art, and the prosecution history. *Id.; Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1582-83 (Fed. Cir. 1996).

As defendant points out, during the prosecution of the '798 patent, the primary issue was the indefiniteness of the claims under 35 U.S.C. § 112, ¶2. The Patent and Trademark Office ("PTO") examiner stated that the claims' limitation of "a distance sufficient to insure that the adhesive does not interfere with rollers of a printer" was indefinite because "the exact spacing *is* critical because adhesive which is too close to its transverse edge will cause the printer problems noted on page 1 of the specification." In response, plaintiff had argued that the limitation was a "functional description" that provides complete, definite and accurate statement of what the spacing should be.

In light of the PTO prosecution history of the '798 patent, and the frequent reference to the IBM 3800 printer in the specification, and indeed in the title of the patent itself, the court concludes that the "distance sufficient" limitation in Claim 1 is in reference to the IBM 3800 printer. Only such conclusion could explain the acceptance by the PTO examiner of plaintiff's response to the examiner's indefiniteness concerns. By linking the "distance sufficient" limitation to the IBM 3800 printer, the distance does indeed become, in the words of plaintiff, "complete, definite and accurate statement

of what the spacing should be." In other words, because the IBM 3800 printer makes a 1/4"-wide impression during pauses, the "distance sufficient" must be construed to mean "more than 1/4 inch." Construed as such, it becomes clear that defendant's accused form does not read on Claim 1 of the '798 patent.

The other forms produced by defendant and cited by plaintiff as supportive of its argument that this motion is premature for lack of discovery do not read on Claim 1 either. Contrary to plaintiff's characterization as a fact in dispute, it is undisputed that these forms do not have a relevant distance of "about 5/16 inch." The declaration of plaintiff's counsel proffers that four of these forms have a relevant distance of more than 1/16 inch, and two have a relevant distance of more than 1/8 inch. None of the relevant distances in these forms has been declared under oath to be "about 5/16 inch," and merely characterizing these distances as such does not create a fact in dispute. Although the differences in these dimensions might appear insignificant to the casual observer, they were sufficiently different in the context of the '798 patent to warrant the issuance of the '798 patent itself over the prior art.

B. ***Analysis of Claim 13 Noninfringement:***

Similarly, the other independent claim, Claim 13, contains the limitation that the adhesive is spaced no closer than 5/16 inch from the edge. The accused form, with adhesive patterns spaced 1/16 inch from its transverse end edge, is well outside that limitation. Therefore, there is no infringement of Claim 13 either. Again, the forms cited by plaintiff's counsel in his declaration, containing distances of "more than 1/16 inch" and "more than 1/8 inch" are insufficient to create a genuine issue of a material fact precluding the grant of summary judgment.

Because none of defendant's accused forms cited by plaintiff reads on either of the only two independent claims of

the '798 patent, defendant's motion for summary judgment of noninfringement of the '798 patent is hereby granted.

IV. *Defendant's Motion on the '110 Patent*

The '110 patent (Double Fold Mailer) is directed to a mailer-type business form, as well as the intermediate sheet from which the form is constructed. The '110 patent has two independent claims, Claim 1 and Claim 11, both of which contain the limitation that "said sheet is devoid of adhesive extending along said end edges of said sheet between said longitudinal lines of weakness."

Defendant's accused form contains a row of circular patches of adhesive extending along the transverse end edge of the sheet between the longitudinal lines of weakness. Defendant argues that the existence of these circular patches of adhesive in its accused form precludes a claim of infringement of the '110 patent, neither literally nor under the doctrine of equivalents.

Plaintiff, however, contends that its patent claims, even containing the limiting language quoted above, encompass forms such as defendant's where the function of the adhesive along the transverse end edges is not to tightly hold together those transverse edges, but rather to "merely tack" the form to allow ready separation by the form's recipient.

More boldly, plaintiff makes the argument that under the doctrine of equivalents, a form such as defendant's – with "mere dots" of adhesive covering no more than 25% of the linear distance between the two longitudinal lines of weakness – is within the coverage of the '110 patent claims because such scant application of the adhesive along the transverse end edges of the form is equivalent to having no adhesive at all. The court is again unconvinced by plaintiff's arguments.

First, the court finds that plaintiff has failed to put forth a prima facie case of literal infringement of the '110 patent. The limitation language in the patent claims is clear and unambiguous. The words "devoid of adhesive extending along said end edges of said sheet between said longitudinal lines of weakness" allow no room for a meaning other than the total absence of adhesive from the described area. The term "devoid" is commonly defined to mean "[c]ompletely lacking; destitute; empty; without." *The American Heritage Dictionary* 361 (New College Ed. 1976). Clearly, the undisputed existence of circular patches of adhesive in defendant's accused form necessitates the finding that there is no literal infringement of the '110 patent claims.

Nor does this court find a prima facie case of infringement under the doctrine of equivalents. First, the subject limitation in the patent claims contains no reference whatsoever to the function of the adhesive. Plaintiff attempts to use prior art – namely, U.S. Patent No. 4,575,121 (the "Conti patent") – to argue essentially that because defendant's accused product is clearly distinguishable from the Conti patent, it must be within the coverage of the '110 patent. Such argument is not only unconvincing, but is also in contravention of the methodology the court must use in evaluating claims of patent infringement under *Markman, supra.* The relevant inquiry under the second prong of *Markman's* methodology requires the court to compare the accused product to the patent claims – construed properly under the first prong of *Markman* – not to the patent's prior art.

The construction of the claims, as outlined above in the analysis of the '798 patent, must be in light of the language of the claim itself, the patent specification, the prior art, and the patent's prosecution history. The court has already found that the language of the claim is sufficiently clear and unambiguous to preclude a claim of literal infringement. The prosecution

history of the '110 patent makes amply clear that no cause of action for infringement under the doctrine of equivalents may lie either.

The original claims in the application that matured into the '110 patent did not contain the limitation that the sheet be devoid of adhesive extending along the end edges of the sheet between the longitudinal lines of weakness. The PTO examiner rejected the original claims in part because of prior art under the Conti patent. The form of the Conti patent had had adhesive both on its longitudinal marginal portions as well as on its transverse end edges on both sides of the form.

Plaintiff then amended the claims to specify that the "sheet is devoid of adhesive extending along said edges of said sheet." Plaintiff stated at the time that the claims were amended "in order to clearly distinguish [the claimed invention] from Conti." Plaintiff argued further that the claimed invention is patentable over the prior art because the sheet is devoid of adhesive extending along the end edges of the sheet, thus making the mailer easier to open and reducing waste as a result of having to remove only two margins, rather than three in the Conti patent.

The PTO, however, again rejected the claims, this time as being indefinite for failing to particularly point out the subject matter which the applicant regarded as the invention. The PTO examiner stated that the sheet is not devoid of adhesive extending along said end edges of said sheet "because the first through eighth patterns, as claimed, substantially cover 'the entire distance between the ends of said sheet'."

Plaintiff again amended the claims to emphasize the "devoid" limitation by including in some claims the current subject limitation that "the sheet is devoid of adhesive extending along the end edges of the sheet between the longitudinal lines of weakness." Thus, the adhesive that exists

in plaintiff's own form along the transverse end edges but outside the longitudinal lines of weakness was excluded from the claimed invention of the '110 patent. It is clear to this court that it was that exclusion that finally permitted the issuance of the '110 patent over the prior art in the Conti patent, not any differences in the functioning of the adhesives in the two patents. Plaintiff's attempt to inject function into the claims of the '110 patent, therefore, does not, in this court's view, create any genuine issue of material fact precluding summary judgment.

The court concludes, therefore, that, in light of the clear language of the subject limitation in the patent claims, and given the prosecution history of the '110 patent before the PTO, the subject limitation must be construed to limit the coverage of the patent claims to those forms that are devoid of *any* adhesive within the area described in the claims, regardless of the purported function of such adhesive. Construed as such, the court finds that plaintiff has failed to put forth a prima facie case of infringement under the doctrine of equivalents.

Finally, as far as plaintiff's argument that the motion for summary judgment is premature because discovery has not yet been completed, plaintiff does not offer any specific expected disclosures that could alter the court's conclusions and findings here. The court is unwilling to allow plaintiff to conduct "fishing expeditions" in the hope of finding products that might be infringing when it cannot offer any evidence that such products exist. Accordingly, defendant's motion for summary judgment of noninfringement of the '110 patent is hereby granted.

s/ Albert V. Bryan, Jr.
Albert V. Bryan, Jr.,
United States District Judge

Alexandria, Virginia
March 20th, 1998

APPENDIX F

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

98-1386, -1387

MOORE U.S.A., INC.,
Plaintiff-Appellant,

v.

STANDARD REGISTER COMPANY,
Defendant-Cross Appellant.

FILED
U.S. COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
NOV 27 2000
JAN HORBALY
CLERK

O R D E R

A combined petition for rehearing and suggestion rehearing en banc having been filed by the APPELLANT, and a response thereto having been invited by the court and filed by the CROSS-APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on December 4, 2000.

FOR THE COURT,

s/ Jan Horbaly/ak
Jan Horbaly, Clerk

Dated: November 27, 2000

cc: Robert A. Rowan
William T. Enos

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

APPENDIX G

Statutes and Rules

35 U.S.C. § 112 Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the

corresponding structure, material, or acts described in the specification and equivalents thereof.

(July 19, 1952, ch. 950, §1, 66 Stat. 798; July 24, 1965, Pub. L. 89-83, §9, 79 Stat. 261; Nov. 14, 1975, Pub. L. 94-131, §7, 89 Stat. 691.)

FEDERAL RULES OF CIVIL PROCEDURE

RULE 56

SUMMARY JUDGMENT

(a) For Claimant. A party seeking to recover upon a claim, counterclaim, or cross-claim or to obtain a declaratory judgment may, at any time after the expiration of 20 days from the commencement of the action or after service of a motion for summary judgment by the adverse party, move with or without supporting affidavits for a summary judgment in the party's favor upon all or any part thereof.

(b) For Defending Party. A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in the party's favor as to all or any part thereof.

(c) Motion and Proceedings Thereon. The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages.

(d) Case Not Fully Adjudicated on Motion. If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court at the hearing of the motion, by examining the

pleadings and the evidence before it and by interrogating counsel, shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, including the extent to which the amount of damages or other relief is not in controversy, and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

(e) Form of Affidavits; Further Testimony; Defense Required. Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment if appropriate, shall be entered against the adverse party.

(f) When Affidavits Are Unavailable. Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may

refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

(g) **Affidavits Made in Bad Faith.** Should it appear to the satisfaction of the court at any time that any of the affidavits presented pursuant to this rule are presented in bad faith or solely for the purpose of delay, the court shall forthwith order the party employing them to pay to the other party the amount of the reasonable expenses which the filing of the affidavits caused the other party to incur, including reasonable attorney's fees, and any offending party or attorney may be adjudged guilty of contempt.

(As amended Dec. 27, 1946, eff. Mar. 19, 1948; Jan. 21, 1963, eff. July 1, 1963; Mar. 2, 1987, eff. Aug. 1, 1987.)

APPENDIX H

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 97-2054-A
v.	)	
	)	
STANDARD REGISTER CORPORATION	)	
	)	
	)	
Defendant.	)	
	)	

DECLARATION OF ROBERT A. VANDERHYE UNDER RULE 56(f)

I, Robert A. Vanderhye, hereby say and declare:

1. I am lead counsel for the plaintiff Moore U.S.A., Inc. ("Moore") in the above-identified litigation.

2. There is discovery that must be pursued in this action before all possible material facts with respect to infringement of the 5,201,464 patent ("'464 patent") by various Standard Register Corporation ("SRC") forms can be fully evaluated. While I sincerely believe that there are material facts in dispute at the present time so that summary judgment is inappropriate even on the present record, there are other facts that will certainly be located during discovery – or have the reasonable probability of being located during discovery – that bear on the

motion for summary judgment, and therefore the motion is premature.

3. Specifically, as of yet not one document has been produced by SRC – let alone all the forms accused of infringing the '464 patent. Such forms are specifically called for by Moore's document production requests, and until SRC produces such forms of course Moore cannot even know what all of the form constructions are that are to be evaluated by the Court when considering infringement of the '464 patent. SRC has other infringing forms aside from the single form set forth in its motion, including the forms of Exhibits 2 and 3 to the Exhibit B declaration, and the form of Exhibit 4 hereto. These forms are discussed in more detail in paragraphs 8 and 9 below, and in Exhibit B.

4. Further, on information and belief, and as set forth in paragraph 11 of Exhibit B, one or more persons at Standard Register specifically copied the commercial Moore form sold under the '464 patent, and sold it or attempted to sell it to Moore accounts using the form of the '464 patent. SRC has yet to identify or produce for deposition any persons who did such copying or selling. Copying is very relevant to the issue of infringement under the doctrine of equivalents, as made clear by *Warner Jenkinson v Hilton Davis,* 117 S.Ct. 1040, 41 USPQ2d 1865, 1874 (1997), and *Graver Tank & Mfg. Co. v Linde Air Products Co.,* 339 U.S. 605, 608, 85 USPQ 328, 331 (1950), as well as to the function of the SRC forms.

5. In a filing made with the Court on March 18, 1998, SRC has represented to the Court in opposition to Moore's second motion to compel discovery that the SRC pressure-sensitive adhesive used in the forms charged with infringement of the '464 patent is "superior" to the adhesive that Moore uses. If this representation is true – which can only be determined by subsequent discovery – then it will have a bearing on the issue

of the doctrine of equivalents and its application to the forms infringing the '464 patent. By the use of "superior adhesive," SRC may be able to make minor changes to the placement of the adhesive on the forms and still get the results obtained by the Moore forms and claimed in the Moore patent.

6. That is, SRC's position regarding infringement is that there are slight differences in the length of the pressure sensitive adhesive strips on SRC's forms compared to what are recited in the claims of the '464 patent. In one case, SRC maintains that it uses less adhesive, that is rather than adhesive extending the majority (i.e. at least 50.01%) of the length of a form, it extends about 48%. If, as alleged in SRC's opposition to the second motion to compel, SRC's pressure sensitive adhesive is superior to the pressure sensitive adhesive Moore uses, this could indicate that less adhesive is necessary on the SRC forms to get the same results, in substantially the same way, as Moore gets by using its "inferior" adhesive on its forms. This substitution of adhesive would be a classic situation for the possible applicability of the doctrine of equivalents' substantially the same function, in substantially the same way, to get substantially the same results, test, *Warner-Jenkinson v. Hilton Davis,* 41 USPQ2d 1875; *Hughes Aircraft Co. v U.S.,* 717 F.2d 1363.

7. Because of the highly relevant possible nature of the SRC adhesive to the doctrine of equivalents, Moore is entitled to discovery about the adhesive. Only by knowing the chemical composition, tests indicating its performance, and a sample thereof (one cannot properly determine all of these without a sample of the liquid adhesive itself), can Moore fully analyze the doctrine of equivalents with respect to the '464 patent and the SRC forms. Therefore responses to Moore's interrogatories 10 and 11, and the associated document production requests, and depositions related thereto, need to be provided and/or

taken if Moore is to be able to fully and completely respond to the Motion for Summary Judgment on the '464 patent.

8. I have inspected an SRC commercial form (a photocopy of which is Exhibit 4 hereto) that has essentially the same construction as the form of Exhibit 3 to SRC's motion except that it has what appears to be two die cut windows in the third section thereof (I have written "die cut windows" on the first page of Exhibit 4). The windows are slightly different than normal die cut windows, but appear to function in the same way as the die cut window recited in claim 17 of the '464 patent. This form also has address and instruction indicia printed thereon. I represent that in order to be sure that the form of Exhibit 4 is an infringement of claim 17 I need to take the deposition of an SRC representative knowledgeable about its final commercial form and function, and/or to see actual commercially printed forms like the form of Exhibit 4, and which SRC has yet to produce.

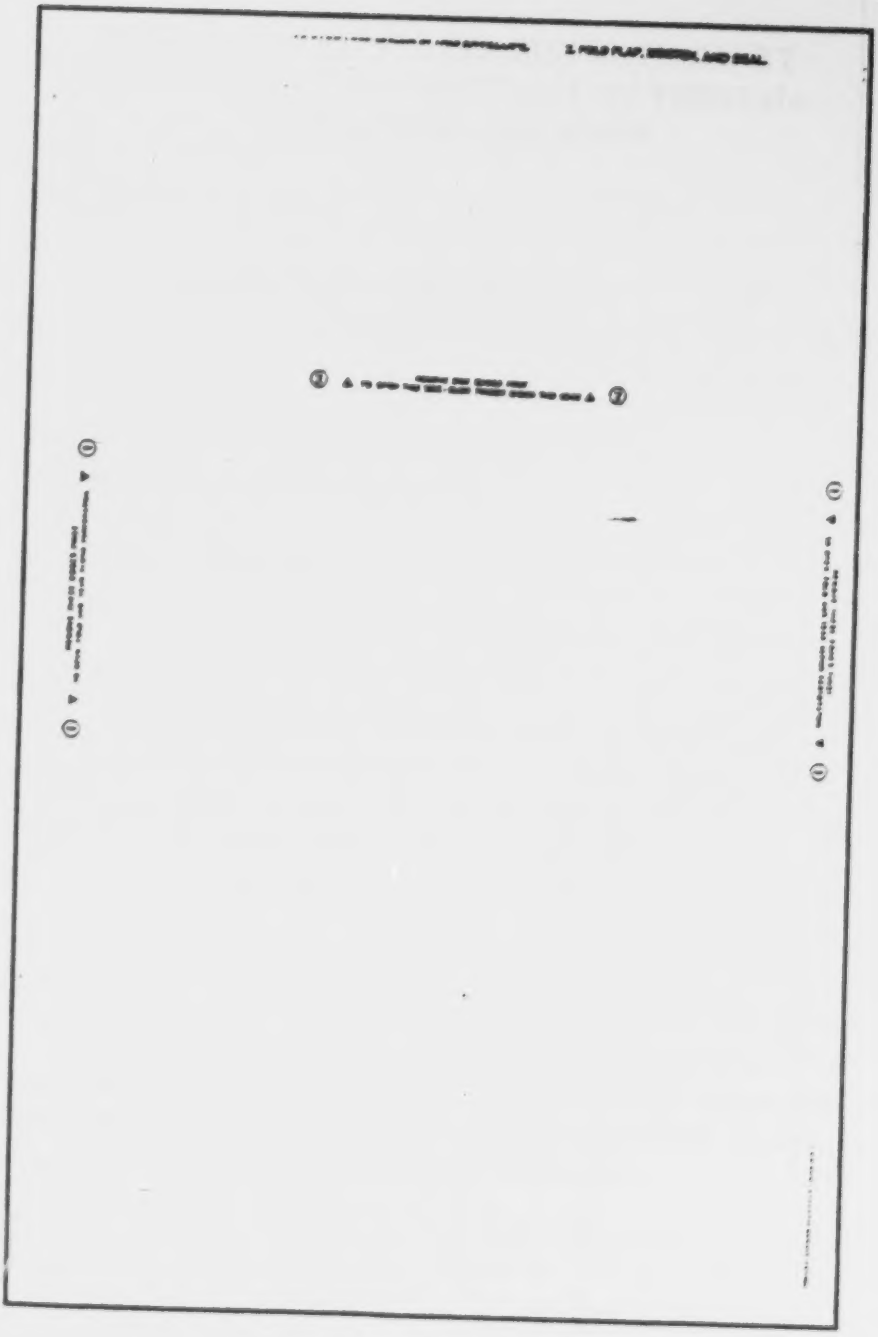
9. In view of the failure of SRC to identify in its motion, or to provide Moore copies of, the forms of Exhibits 2-4 of this declaration and that of Exhibit B, I expect there to be other types of infringing forms. These can be located only through further discovery.

10. I declare under penalty of perjury that the foregoing is true and correct to the best of my information, knowledge, and belief.

s/ Robert A. Vanderhye
Robert A. Vanderhye

Date: 3/31/98

APPENDIX I



▼ REMOVE THIS PORTION ▼

APPENDIX J

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

Moore U.S.A. Inc.,	)	
	)	
Plaintiff/Counterclaim Defendant.	)	Civil
	)	Action No.
	)	97-2054-A
v.	)	
	)	
The Standard Register Company,	)	
	)	
Defendant/Counterclaimant.	)	

Hearing Date: Friday, March 20, 1998
Hearing Time: 10:00 a.m.

DECLARATION OF OLEH B. MUDRY
IN SUPPORT OF SRC'S MOTION
FOR SUMMARY JUDGMENT OF
NON-INFRINGEMENT OF
U.S. PATENT NO. 5,253,798

Oleh B. Mudry hereby declares and states under penalty of perjury that

1. I am the Corporate Industrial Engineer for the Document Management and Systems Division (formerly Document Management Division) of The Standard Register Company. I have held this position since 1993.

2. The Chase mailer, which I understand has been accused of infringing U.S. Patent No. 5,253,798, is a continuous web Z-fold mailer having three panels, separated by

fold lines. The panels are spaced along the continuous web, and the fold lines are perpendicular to the direction of web movement through a printer. Tractor holes are provided along both of the lateral margin edges.

3. Strips of pressure-sensitive adhesive are positioned appropriately along the margins of the panels to permit the mailer to be sealed after it is printed, burst from the continuous web, and folded.

4. I have measured the sample Chase mailer – the accused SRC form which was submitted to Standard Register by Moore – and I find that the transverse strips of adhesive are spaced from their respective transverse edges by approximately 1/16 inch.

5. I am unaware of any problems related to the location of adhesive on the accused SRC form with respect to the rollers of any printer, customers have not faced the problem of the adhesive interfering with the rollers.

6. Since there is no problem with the adhesive on the accused SRC form interfering with the printer rollers, the adhesive on the accused SRC form is within 1/4 inch of the edge of the form (i.e., the adhesive will be under the rollers of an IBM 3800 printer during the pause in printing)

7. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

March 6, 1998

s/ Oleh B. Mudry
Oleh B. Mudry

APPENDIX K

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 97-2054-A
v.	)	
	)	
STANDARD REGISTER CORPORATION	)	
	)	
	)	
Defendant.	)	
	)	

DECLARATION OF ROBERT A. VANDERHYE
UNDER RULE 56(f)

I, Robert A. Vanderhye, hereby say and declare:

1. I am lead counsel for the plaintiff Moore U.S.A., Inc. ("Moore") in the above-identified litigation.

2. There is discovery that must be pursued in this action before all possible material facts with respect to infringement of the 5,314,110 patent ("'110 patent") by various Standard Register Corporation ("SRC") forms can be fleshed out. While I sincerely believe that there are material facts in dispute at the present time so that summary judgment is inappropriate even on the present record, there are other facts that will entirely be located during discovery – or have the reasonable probability of being located during discovery – that bear on the motion for summary judgment, and therefore the motion is premature.

3. Specifically, as of yet no document has been produced by SRC – let alone all the forms accused of infringing the '110 patent. Such forms are specifically called for by Moore's document production request 5, and until SRC produces such forms of course Moore cannot even know what all of the form constructions are that are to be evaluated by the Court when considering infringement of the '110 patent.

4. Further, on information and belief one or more persons at Standard Register specifically copied the commercial Moore form sold under the '110 patent, and sold it or attempted to sell it to Moore accounts using the form of the '110 patent. SRC has yet to identify or produce for deposition any persons who did such copying or selling. Copying is very relevant to the issue of infringement under the doctrine of equivalents, as made clear by *Warner Jenkinson v Hilton Davis,* 117 S.Ct. 1040, 41 USPQ2d 1865, 1874 (1997), and *Graver Tank & Mfg. Co. v Linde Air Products Co.,* 339 U.S. 605, 608, 85 USPQ 328, 331 (1950), as well as to the function of the SRC forms.

5. I declare under penalty of perjury that the foregoing is true and correct to the best of my information, knowledge and belief.

s/ Robert A. Vanderhye
Robert A. Vanderhye

Date: March 17, 1998

APPENDIX L

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 97-2054-A
v.	)	
	)	
STANDARD REGISTER CORPORATION	)	
	)	
	)	
Defendant.	)	
	)	

COMBINED DECLARATION OF ROBERT A. VANDERHYE UNDER RULE 56(f), AND EVIDENTIARY DECLARATION

I, Robert A. Vanderhye, hereby say and declare:

1. I am lead counsel for the plaintiff Moore U.S.A., Inc. ("Moore") in the above-identified litigation.

2. There is discovery that must be pursued in this action before all possible material facts with respect to infringement of the 5,253,798 patent ("'798 patent") by various Standard Register Corporation ("SRC") forms can be fleshed out. While I sincerely believe that there are material facts in dispute at the present time so that summary judgment is inappropriate even on the present record, there are other facts that will entirely be located during discovery – or have the reasonable probability of being located during discovery – that bear on the motion for summary judgment, and therefore the motion is premature.

3. Specifically, as of yet no document has been produced by SRC – let alone all the forms accused of infringing the '798 patent. Such forms are specifically called for by Moore's document production request 3, and until SRC produces such forms of course Moore cannot even know what all of the form constructions are that need to be evaluated by the Court when considering infringement of the '798 patent.

4. Further, on information and belief, one or more persons employed by Standard Register specifically copied the Moore form, and sold it or attempted to sell it to Moore accounts that were having the very problem that the form of the '798 patent solves. SRC has yet to identify or produce for deposition any persons who did such copying or selling. Of course copying is very relevant to the issue of infringement under the doctrine of equivalents, as made clear by *Warner Jenkinson v Hilton Davis,* 117 S.Ct. 1040, 41 USPQ2d 1865, 1874 (1997), and *Graver Tank & Mfg. Co. v Linde Air Products Co.,* 339 U.S. 605, 608, 85 USPQ 328, 331 (1950), as well as to the function of the accused SRC forms.

5. I also have not had the opportunity to take the deposition of Mr. Mudry, who filed a declaration on SRC's behalf in this case. While I believe that the Mudry declaration in fact supports infringement in paragraphs 5 and 6 thereof, as does the LaBarge declaration, the allegations in paragraph 4, as well as those in paragraphs 5 and 6, need to be tested by a deposition, and no other way would be effective. Also I have specific information, from my own evaluation of SRC forms, although it contradicts the Mudry declaration in some ways, that what is set forth in paragraph 4 of the Mudry declaration is incorrect and that there are SRC forms having a spacing of much greater than 1/16 of an inch, in fact even more than 1/4 inch. I need to confirm that these forms are legitimate SRC forms during discovery.

6. In particular I have measured the spacing of the transverse pattern of adhesive from the transverse edge of the form for a number of different SRC forms. Four different forms have spacing – compared to the spacing 29 illustrated in FIG. 2 of the '798 patent – of well more than 1/16 of an inch, and two still different forms have spacings of more than 1/8 inch. I notice no substantial difference between the SRC forms and what is illustrated in the Moore '110 patent, or forms sold by Moore under the patent.

7. I declare under penalty of perjury that the foregoing is true and correct to the best of my information, knowledge, and belief.

s/ Robert A. Vanderhye
Robert A. Vanderhye

Date: March 17, 1998

APPENDIX M

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 97-2054-A
v.	)	
	)	
STANDARD REGISTER COMPANY	)	
	)	
	)	
Defendant.	)	
	)	

EVIDENTIARY DECLARATION OF ROBERT E. LaBARGE

I, Robert E. LaBarge, hereby say and declare:

1. I am an account executive for Moore U.S.A. Inc. ("Moore") stationed in Denver, Colorado. I have worked for Moore since 1968 in the sale of business forms, and am familiar with business forms with pressure sensitive cohesive for sealing the forms -- such as illustrated in Figures 1 and 2 of U.S. Patent 5,253,798 ("the '798 patent") and am familiar with forms sold by Moore under the '798 patent, and forms sold by Standard Register Company ("SRC") in competition with Moore's forms.

2. At one of the accounts I am responsible for, the Moore forms sold under the '798 patent were used successfully without sticking to the rollers of the account's high speed printer. SRC forms were brought in and tested, but did not operate properly

because the forms had a tendency to stick to the rollers of the printer when the printer paused. SRC then modified its forms to be closer to the Moore forms, moving the transverse pattern of pressure sensitive cohesive further away from the transverse edge of the form until the SRC forms no longer had the sticking problem during printer pausing.

3. I declare that the foregoing is true and correct to the best of my information, knowledge, and belief.

s/ Robert E. LaBarge
Robert E. LaBarge

Date: March 16, 1998

APPENDIX N

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 97-2054-A
v.	)	
	)	
STANDARD REGISTER CORPORATION	)	
	)	
	)	
Defendant.	)	
	)	

EVIDENTIARY DECLARATION OF
DALE C. BELAND

I, Dale C. Beland, hereby say and declare:

1. I am a senior research service engineer for Moore U.S.A., Inc. ("Moore") stationed in Grand Island, New York. I have worked for Moore since 1978 and am very familiar with business forms sold by Moore and others with pressure sensitive cohesive for sealing the forms. I am particularly aware of forms sold by Moore as illustrated in Figures 1 and 2 of U.S. Patent 5,253,798 (the '798 patent").

2. One of Moore's competitors in the sale of business forms with pressure sensitive cohesive is Standard Register Corporation ("SRC"). SRC sells forms in direct competition with Moore's forms. In particular, SRC has sold forms like those in the '798 patent directly to accounts where Moore forms under the '798 patent were first sold, and the SRC forms have

replaced the Moore forms. That is, in some accounts of which I am aware, the SRC forms have functioned – as far as ability of the printer or processing equipment to handle them without hang-up – in essentially the same way with essentially the same results as the Moore forms under the '798 patent that were sold to the account earlier.

3. At some accounts where the SRC forms did not initially work well, they were modified to be closer to the Moore forms under the '798 patent, and therefore worked better.

4. I declare that the foregoing is true and correct to the best of my information, knowledge, and belief.

s/ Dale C. Beland
Dale C. Beland

Date: 03/17/98

APPENDIX O

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MOORE, U.S.A., INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 97-2054-A
v.	)	
	)	
STANDARD REGISTER CORPORATION	)	
	)	
	)	
Defendant.	)	
	)	

EVIDENTIARY DECLARATION OF
DAVID G. WAGNER RE THE '464 PATENT

I, David G. Wagner, hereby say and declare:

1. I am a Senior Research Technical Associate who has been working in the business forms art for approximately 32 years. In that time, I have regularly worked with business forms, varied production applications, related manufacturing processes, and forms handling equipment processing systems that incorporate use of products provided with cohesive/adhesive chemistries. I am named inventor on two patents for business forms handling equipment and business forms design and four pending patent applications.

2. I am familiar with some of the forms manufactured and sold by Standard Register Company ("SRC") that are related to Moore's U.S. patent 5,201,464, particularly one that is denoted "Form 8140CO4" dated 11-96 and with the "Image

Seal" trademark. This form competes directly with a form manufactured by Moore, and a version of which is provided as Exhibit 1 hereto.

3. The SRC Form 8140C04 provides a so-called C-fold outgoing mail form which, like the form of the '464 patent, contains an integral return mail envelope. The SRC form is called a C-fold because it is a paper sheet which is divided into three sections by transverse tear lines. One of the sections formed is small than the other two.

4. The SRC Form 8140C04 is further divided into two margin portions in a center section by two longitudinal lines of weakness formed in the paper. The SRC Form also includes a transverse line of weakness that allows ready separation of the return envelope from the remainder of the form.

5. The SRC Form 8140C04 has first, second, third, and fourth longitudinal strips of adhesive on the front face of the form, two longitudinal strips of adhesive in the margin portion on the back side of the form, and a transverse adhesive strip on the front side of the form which is used to seal the return envelope.

6. The first and second longitudinal strips of adhesive extend approximately 6 and 11/16 inches along the longitudinal marginal portion of the form. These two strips have exactly the same function, in exactly the same way, to achieve exactly the same results, as if the length of the adhesive strips was 7.001 inches, that is 50.01% of the length of the form intermediate.

7. The length of the third and fourth longitudinal strips of adhesive are each approximately 6 9/16 inches along the longitudinal marginal portions. The ratio of the lengths of the third and fourth longitudinal strips of adhesive to the lengths of the first and second longitudinal strips of adhesive is about .98. Thus the lengths of the third and fourth strips of adhesive is

less than of the first and second. I know of no claim language that calls for this difference to be less by a significant amount; however whether the third and fourth strips of adhesive extend 6 9/16 inches, or only 6 inches, the SRC form, and the adhesive strips thereof, function exactly the same, in exactly the same way, to get exactly the same results, as the adhesive strips in the '464 patent and the Moore commercial form under the '464 patent.

8. When run through a sealer to seal the adhesive strips in both the SRC forms and the forms of the '464 patent the sealing action will be identical, and the adhesive will hold the form together so that it can be properly mailed, the various components can be effectively detached while the reply envelope is not harmed, and the adhesive strips otherwise function to provide an entirely acceptable mailer. More specifically, the first and second longitudinal adhesive strips function to seal the C-folded outgoing mailpiece. Although it is not necessary, like the form of the '464 patent, the SRC Form 8140C04 uses the optional strips of adhesive provided in the margins on the back side of the form to enhance the seal closing the outgoing mailpiece. The third and fourth longitudinal strips of adhesive serve to seal the sides of the return envelope.

9. The SRC third and fourth longitudinal strips of adhesive of the SRC form 8140CO4, provided for holding the reply envelope together, and for holding the mailer together, have substantially the same function as the adhesive strips in the Moore mailer of Exhibit 1 and what is illustrated and claimed in the '464 patent, and perform that function in substantially the same way, to get substantially the same results. In both cases the strips hold the mailer together so that it can be properly mailed, yet properly retain a reply envelope together so that an insert can be inserted therein and it can be return-mailed.

10. In the normal use of the SRC mailer, and the manner in which it is intended to be used by SRC, outgoing address indicia, outgoing return address indicia, a return envelope address indicia, and facilitating and suggesting indicia, are all printed on the SRC form, as in the photocopy of a commercial SRC form like Form 8140C04, which is Exhibit 2 hereto. Exhibit 3 is a photocopy of the form of Ex. 2 after it has been opened up, and the reply envelope exposed.

11. SRC Form 8140C04 re-arranged some of the components that form the return envelope from what is disclosed as the form of the '464 patent. [Moore made revisions of the same type on its own commercial form Ex. 1]. Specifically, in the SRC form, the transverse adhesive strip used to seal the top of the return envelope, has been moved from the third section of the form to the second section of that form. The tear strip provided for separating the return envelope has also been moved to suit the new location of the transverse adhesive strip. The re-arrangement of the form to move the adhesive strip and associated tear line would be readily apparent to one skilled in the art of form design and manufacture as merely the substitution of one location for another, and a mere rearrangement of parts without any affect on the function of the form. Whether the reply envelope adhesive strip (blue on the SRC form) and associated perforation line, are in the second or third section, they function in detachment of the reply envelope and ready use thereof as a reply envelope.

12. The Moore form covered by the '464 patent which is Exhibit 1 hereto was cut on the market, and well known to SRC sales personnel before SRC came out on the market with the SRC Form 8140CO4. The logical conclusion that I come to in comparing the Moore and SRC forms is that the SRC form is a copy, with minor changes which have no affect whatsoever

on the functionality of the form, of the Moore form covered by the '464 patent.

13. I have inspected many SRC mailers over the years and my experience has been that different production runs of SRC forms have different locations, lengths, and extents of adhesive strips. This is apparent for the forms of interest by comparing the 12-96 version of SRC Form 8140CO4 to the 11-96 version. In these different versions the positions, extents, and relative positions, of the adhesive strips which seal the form into a mailer and reply envelope are different.

14. I declare under penalty of perjury that the foregoing is true and correct to the best of my information, knowledge, and belief.

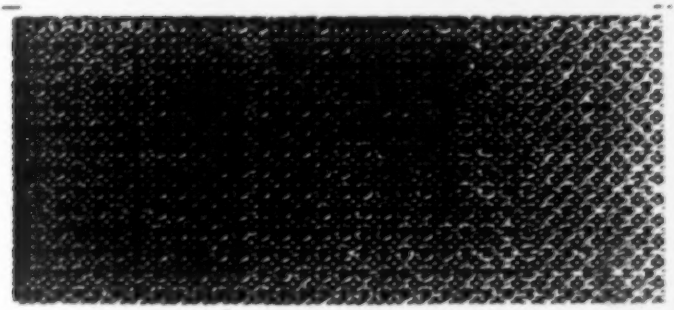
s/ David G. Wagner
David G. Wagner

March 30, 1998
Date

BEST AVAILABLE COPY

WHY CONVERT MISSION CRITICAL MAILING DOCUMENTS TO PRESSURE SEAL?

- To use laser technology to improve readability and quality of the mailpiece
- To utilize intelligent return documents built right into the mailpiece increasing accuracy, cash flow and cycle time
- To employ customer specific targeting to encourage interaction with your customers
  - REQUESTING INFORMATION
  - REDEEMING REWARDS
  - PURCHASING ADDITIONAL PRODUCTS
  - RESPONDING TO SURVEY QUESTIONS
- To improve cycle time 2-3 times vs. traditional insertion processes



DETACH AT PERF
THEN REMOVE THIS STRIP

I WOULD LIKE
MORE INFORMATION

DETACH AT PERF

APPLICATION

FOLD WITH FLAP AND SEAL

Standard Register.
600 Albany Street
P.O. Box 1167
Dayton, OH 45401-1167

IMAGE SEAL™ C-Fold Application with Return Envelope

A Non-Impact Printer Mailing Solution

Montgomery Burns
3 Simpson Way
Los Angeles CA 90066-1234

1
REMOVE THESE EDGES FIRST
▼ TO OPEN - FOLD AND TEAR ALONG PERFORATION ▼
IMAGE SEAL™
Finished by the Standard Register IMAGE SEAL™ Mailing System. This mailer is designed for duplex printing to include a return envelope.
• Eliminate envelope costs
• Bypass inserting operations
• Ensure document security / confidentiality
• Speed processing. Up to 18,000 per hour
• Stand-alone or in-line systems available (depending on printer)
• Nationwide Standard Register service
For more information, please contact your local Standard Register Sales Representative.
2
REMOVE BLUE EDGES FIRST
▼ TO OPEN THIS BLUE - BLUE FINGER UNDER THIS EDGE ▼
▲ TO OPEN - FOLD AND TEAR ALONG PERFORATION ▲
REMOVE THESE EDGES FIRST

[illegible] HAS BEEN PLACED WITH OUR OFFICE FOR
IMMEDIATE COLLECTION !

THIS IS A DEMAND FOR PAYMENT IN FULL AT ONCE.
DEBTS NOT PAID MAY BE PLACED IN YOUR CREDIT BUREAU FILE.

DID FURTHER CONTACT, PLEASE RETURN THIS LETTER WITH PAYMENT
IN FULL TODAY !

EFT MASTERCARD, VISA AND POST DATED CHECKS (MAXIMUM 2 WEEKS)

ame	Creditor Account #	ABCO Account #	Total Amount Due
adbeat	KAC52765-5T	N2N78791-3	$ 1012.64

▲ REMOVE THIS PORTION ▲

RETURN THIS PORTION WITH YOUR PAYMENT

ease detach this part and retain for your records. Return top part with remittance.

Client Name	Creditor Account #	ABCO Account #	Total Amount Due
Ira Deadbeat	KAC52765-5T	N2N78791-3	$ 1012.64

Check Number	Date Paid	Amount Paid

notify this office within 30 days after receiving this notice that you dispute the
the debt or any portion thereof, this office will assume this debt is valid. If you
office in writing within 30 days from receiving this notice, this office will obtain
of the debt and mail a copy to you of such verification. If you request this office
within 30 days after receiving this notice, this office will provide you with the name
of the original creditor, if different from the current creditor. This is an attempt
t debt. Any information obtained will be used for that purpose

RETAIN THIS PORTION FOR YOUR RECORDS

PLACE
STAMP
HERE

BOX # NEW ADDRESS

AMERICAN BANKWELL CORPORATION
760 MOUNTAIN RD
DELIVERY POINT U.S.A. 14609-0710

Standard Register
500 Albany Street
P.O. Box 1167
Dayton, OH 45401-1167

IMAGE SEAL C-Fold Application with Return Envelope

A Non-Impact Printer Mailing Solution

ARCHIE LEACH
4 CAMBRIDGE CENTER
CAMBRIDGE MA 02110-1709

IMAGE SEAL

Finished by the Standard Register IMAGE SEAL™ Mailing System. This mailer is designed for duplex printing to include a return envelope.

- *Eliminate envelope costs*
- *Bypass inserting operations*
- *Ensure document security / confidentiality*
- *Speed processing: Up to 18,000 per hour*
- *Stand-alone or in-line systems available (depending on printer)*
- *Nationwide Standard Register service*

For more information, please contact your local Standard Register Sales Representative.

(2)
REMOVE SIDE EDGES FIRST
▼ TO OPEN THIS SIDE - SLIDE FINGER UNDER THIS EDGE ▼

BEST AVAILABLE COPY

APPENDIX P

US005201464A

United States Patent [19] [11] Patent Number: 5,201,464

File [45] Date of Patent: Apr. 13, 1993

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[54] **PRESSURE SEAL C-FOLD TWO-WAY MAILER**

[75] Inventor: Jerry E. File, Mundelein, Ill.

[73] Assignee: Moore Business Forms, Inc., Grand Island, N.Y.

[21] Appl. No.: 742,344

[22] Filed: Aug. 8, 1991

[51] Int. Cl.[5] B65D 27/06; B65D 27/04

[52] U.S. Cl. 229/305; 229/304; 229/314

[58] Field of Search: 229/69, 71, 73, 92.1, 229/92.3, 301, 303, 304, 305, 314, 316

[56] References Cited

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Primary Examiner -- Allan N. Shoap

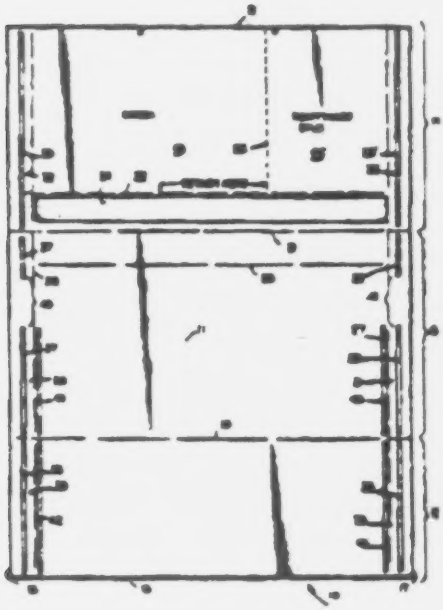
Assistant Examiner -- Jes F. Pascua

Attorney, Agent, or Firm -- Nixon & Vanderhye

[57] **ABSTRACT**

A C-fold simple mailer is provided which may be processed on a laser (or other non-impact) printer. Pressure sensitive adhesive is utilized to form the mailer, and integral return envelope. C-folding and sealing are effected after printing of variable data on the form. In one construction variable data is printed on both faces of the form utilizing a duplex sheet feed laser printer, while in a second construction a simplex continuous laser printer is utilized and variable data -- including the outgoing addressee address indicia -- is printed on only one face. In the second construction a die cut window is provided so that the outgoing address information is visible from the exterior of the mailer.

19 Claims, 4 Drawing Sheets



U.S. Patent Apr. 13, 1993 Sheet 1 of 4 5,201,464

Fig. 1

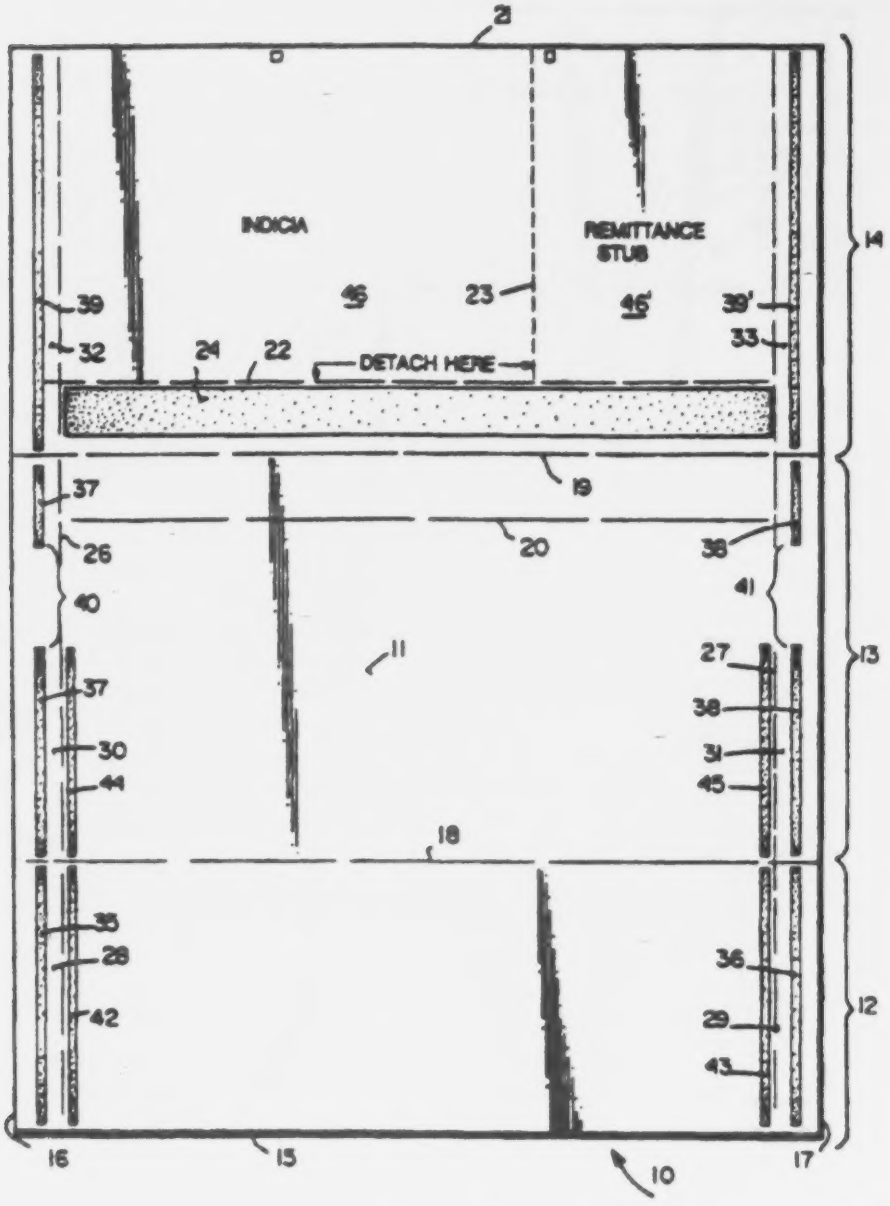


Fig. 2

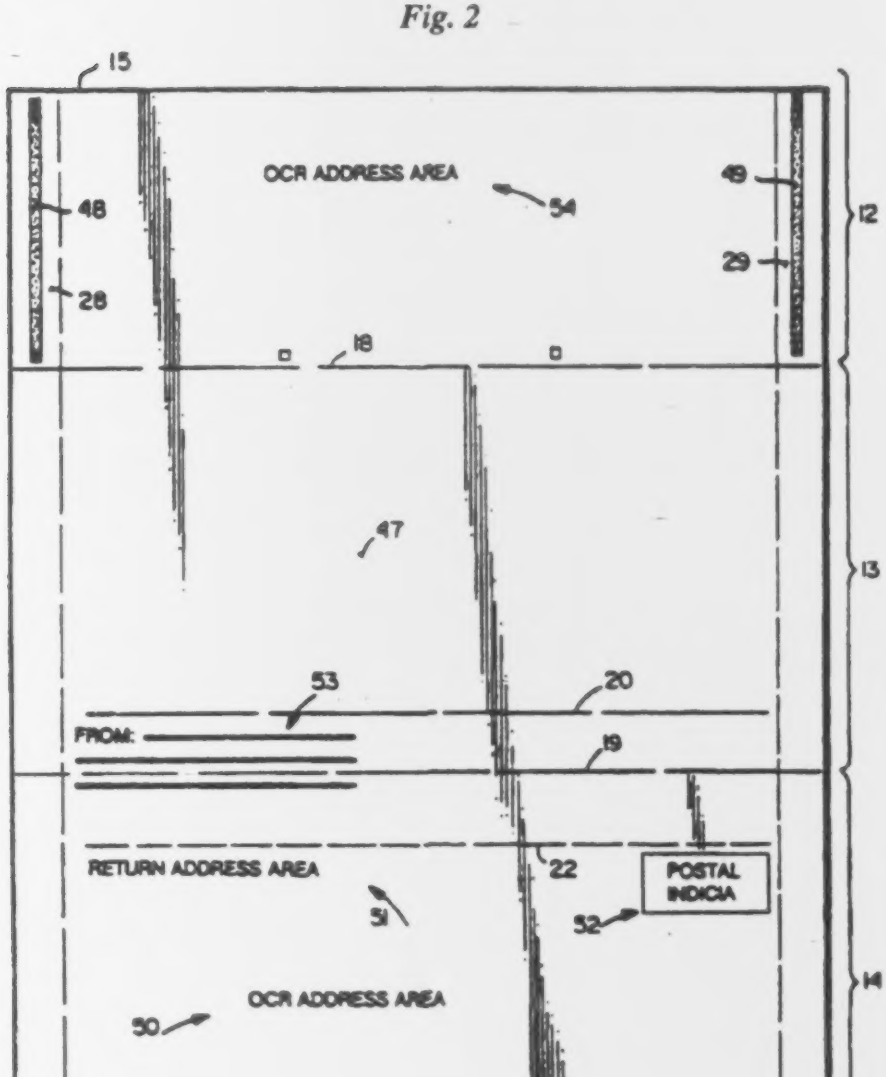

15
OCR ADDRESS AREA
54
49
48
29
28
18
12
47
13
53
20
FROM:
19
RETURN ADDRESS AREA
22
POSTAL INDICIA
51
32
OCR ADDRESS AREA
14
50
16
21
10
17

Fig. 3

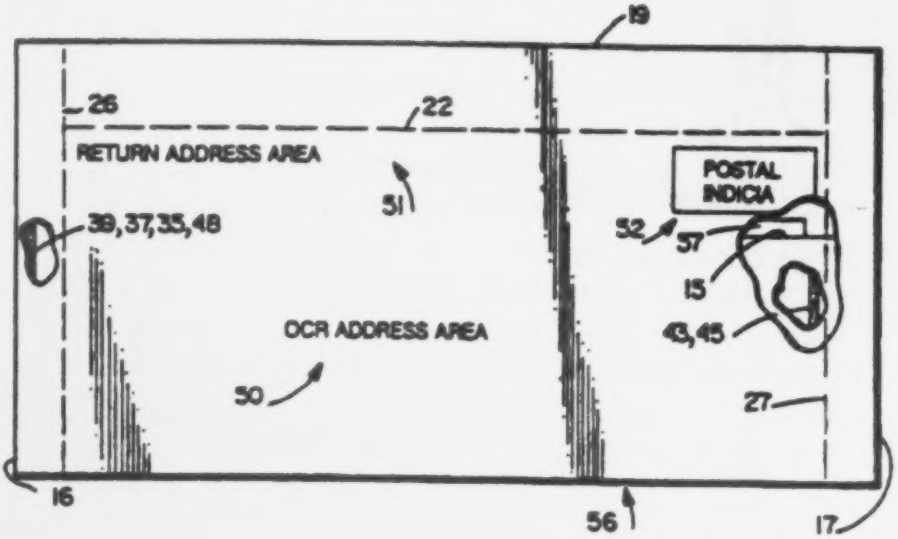

19
26
22
RETURN ADDRESS AREA
51
POSTAL INDICIA
39,37,35,48
52
57
15
OCR ADDRESS AREA
43,45
50
27
16
56
17

Fig. 4

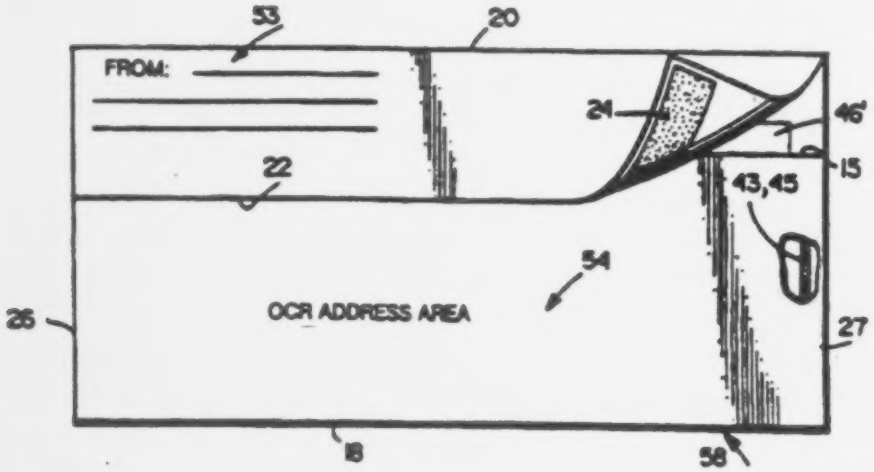

53
20
FROM:
24
46'
22
15
43,45
54
OCR ADDRESS AREA
26
27
18
58

Fig. 6

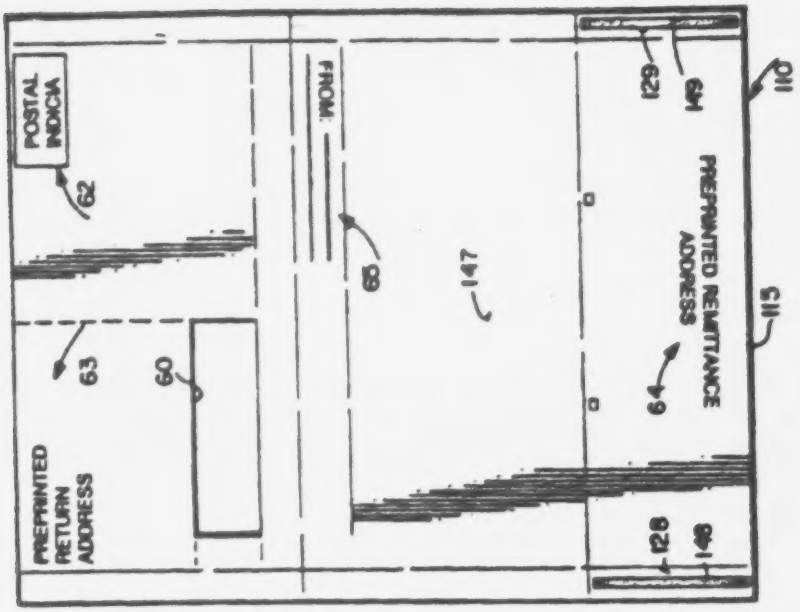
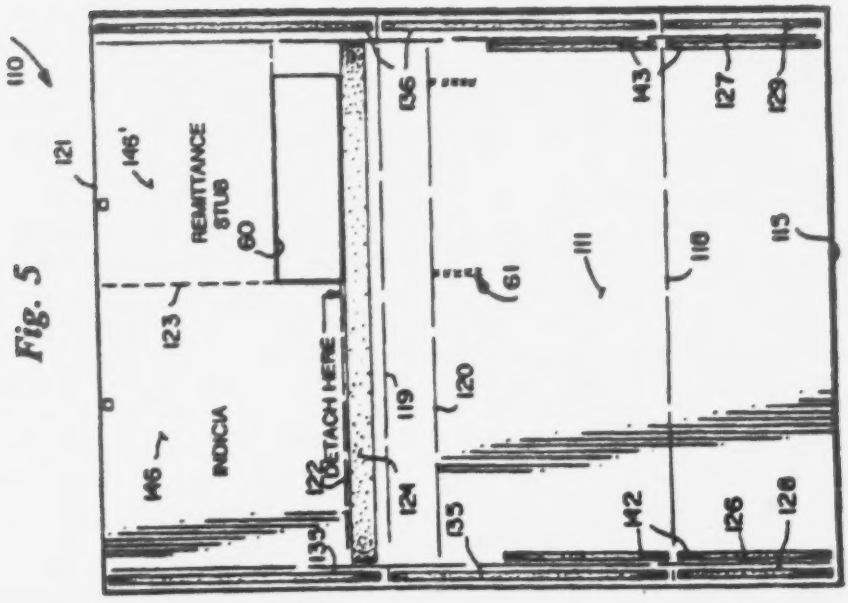

POSTAL INDICIA
62
FROM
68
147
129
149
110
PREPRINTED REMITTANCE ADDRESS
64
115
63
60
PREPRINTED RETURN ADDRESS
128
148

Fig. 5


110
121
146'
REMITTANCE STUB
60
123
INDICIA
146
DETACH HERE
122
139
136
119
120
124
135
61
111
143
118
142
127
129
115
126
128

PRESSURE SEAL C-FOLD TWO-WAY MAILER

BACKGROUND AND SUMMARY OF THE INVENTION

It is desirable to be able to make simple mailers utilizing non-impact printers (such a laser printers). One way to accomplish that result is to utilize simple C-fold constructions, with integral return envelopes, such as shown in U.S. Pat. Nos. 4,896,823 and 4,915,287. Such constructions typically utilize heat seal adhesive. Heat seal adhesive presents many practical difficulties in use in some establishments, often requiring heat sealing before printing with a laser printer (which generates heat). Also, typical prior art constructions -- such as shown in U.S. Pat. No. 4,896,823 -- can be unacceptable as a reusable mailer because the original bar code remains on the face of the return envelope. If address block bar coding is officially accepted, then such a reusable mailer can be used, but only with non-impact printers which can image the bar code in the address block.

According to the present invention, an advantageous simple mailer type business form, with integral return envelope, is provided, as well as an intermediate of such a form, and methods of construction thereof. According to the present invention, the return envelope is created during the folding and sealing process as opposed to prefolding the form prior to printer imaging, or attaching a separate envelope or additional paper ply that forms an envelope. Also, the invention preferably utilizes pressure seal adhesive which eliminates the necessity for heat sealing, and the mess of applying glue or water during the folding and sealing process. Two different constructions are provided according to the invention, one construction allowing the nesting of inserts in the mailer, and the other construction allowing simplex imaging.

Both constructions according to the invention have many uses. One exemplary use for the first construction is in periodical subscription billing wherein the billing is prepared on a cut sheet laser printer having duplex imaging capabilities which prints the billing information on a first face of the sheet, and address information on the second sheet. Informational or promotional inserts can be nested in the mailer. An exemplary use of the second construction is a payment past due notice which is imaged on a continuous laser printer or a cut sheet with simplex laser printer, all the printing being done by the non-impact printer on the first face of the sheet, with address information visible through the die cut window.

With either inventive construction, after laser printer imaging of variable information the forms are processed on conventional pressure seal equipment, such as the SpeediSealer® pressure seal equipment marketed by Moore Business Forms, and are subsequently mailed. The recipient opens the mailer by removing stubs on the left and right edges and then unfolds it to reveal confidential information within it. The top panel can then be removed via a perforation, and a remittance stub removed from the top panel and inserted in the return envelope, which then may be sealed with rewettable adhesive and mailed.

According to one aspect of the present invention, a mailer type business form intermediate is provided. The intermediate comprises: A sheet of paper having a first face, adapted to provide the majority of the interior of the mailer when constructed, and a second face, adapted to provide the majority of the exterior of the mailer when constructed, the sheet having first and second opposite, parallel, longitudinal edges, and opposite ends. First and second longitudinal lines of weakness formed in the sheet parallel to and adjacent, but spaced from, the first and second longitudinal edges, respectively, the lines of weakness defining, with the longitudinal edges, longitudinal

marginal portions. First and second longitudinal strips of adhesive disposed in the first and second longitudinal marginal portions, respectively, of the first face, extending the majority of the lengths of the longitudinal marginal portions, and parallel to the first and second longitudinal edges. Third and fourth longitudinal strips of adhesive disposed parallel to the first and second strips, and disposed adjacent the first and second lines of weakness on the opposite side thereof from the first and second strips, on the first face, the third and fourth longitudinal strips disposed closer to one end of the ends than the other, and extending a distance substantially less than the extent of the first and second strips. Means defining a transverse adhesive strip on the first face, perpendicular to the third and fourth strips, longitudinally spaced from the third and fourth strips; and means defining a line of weakness adjacent the transverse strip, on the opposite side thereof from the third and fourth strips, to allow ready separation of the paper at that line.

The adhesive strips are preferably pressure sensitive adhesive. The intermediate also preferably comprises fifth and sixth longitudinal strips of adhesive parallel to the first and second longitudinal edges and disposed in the first and second marginal portions, respectively, on the second face. A first transverse fold line forming means is also preferably disposed in the sheet at about the midpoint of the third and fourth adhesive strips, which are discontinuous thereat. The transverse adhesive strip is preferably rewettable glue.

The invention also contemplates a mailer type business form within integral return envelope. Such a form comprises: A C-folded paper sheet having first and second faces, first and second opposite longitudinal edges, and first and second transverse fold lines defining first, second, and third sections of the sheet (the second and third sections are larger than the first section). First and second lines of weakness formed in the sheet parallel to and adjacent, but spaced from, the first and second

longitudinal edges, respectively, the lines of weakness defining, with the longitudinal edges, longitudinal marginal portions. First and second longitudinal strips of adhesive disposed in the first and second longitudinal marginal portions, respectively, of the first face, and parallel to the first and second longitudinal edges, the first and second longitudinal strips connecting at least the first and second sections, and the third and first sections, together at the longitudinal marginal portions. Third and fourth longitudinal strips of adhesive disposed parallel to the first and second strips, and disposed adjacent the first and second lines of weakness on the opposite side thereof from the first and second strips, on the first face, the third and fourth longitudinal strips connecting the first section to a part of the second section to form the sides of a return envelope. Means defining a transverse adhesive strip on the first face, perpendicular to the third and fourth strips, in the third section. Means defining a transverse line of weakness adjacent the transverse strip in the third section, on the opposite side thereof from the second section, to allow ready separation of the form at that line; and outgoing address, and outgoing return address, indicia, visible from the third section second face.

The longitudinal strips of adhesive are preferably pressure sensitive adhesive. Also, there preferably is provided a longitudinal line of weakness in the third section, intersecting the transverse line of weakness, and a third transverse fold line between the first and second lines in the second section. The outgoing addresses address indicia may be printed on the first face in the second section with a die cut window in the third section allowing viewing of the outgoing address information therethrough. Alternatively, the outgoing addressee address indicia is printed on the second face in the third section.

The invention also contemplates the methods for constructing two different constructions of C-fold mailer type business forms according to the invention.

According to a first method, a mailer type business form with integral return envelope is constructed from a sheet of paper having first and second parallel longitudinal edges, first and second parallel transverse edges perpendicular to the longitudinal edges, and first and second faces. The method comprises the steps of: (a) Forming first and second longitudinal lines of weakness in the sheet parallel to and adjacent, but spaced from, the first and second longitudinal edges, respectively, the lines of weakness defining, with the longitudinal edges, longitudinal marginal portions. (b) Providing first and second longitudinal strips of pressure sensitive adhesive in the first and second longitudinal marginal portions, respectively, of the first face, extending parallel to the first and second longitudinal edges. (c) Providing third and fourth longitudinal strips of pressure sensitive adhesive disposed parallel to the first and second strips, and disposed adjacent the first and second lines of weakness on the opposite side thereof from the first and second strips, on the first face, the third and fourth longitudinal strips disposed closer to the first transverse edge than the second. (d) Providing a transverse adhesive strip on the first face, perpendicular to the longitudinal edges, and longitudinally spaced from the third and fourth strips. (e) Providing a line of weakness adjacent the transverse strip, on the opposite side thereof from the third and fourth strips, to allow ready separation of the paper at that: line. (f) Providing first and second transverse fold lines, the first fold line closer to the first transverse edge and the second fold line closer to the second transverse end, to define a first section between the first transverse edge and the first fold line, a second section between the first and second fold lines, and a third section between the second fold line and second transverse edge. (g) Feeding the sheet to a non-impact duplex printer to print indicia on both the first and second faces, including outgoing addressee address indicia on the second face in the third section, and return envelope addressee indicia on

the second face in the first section. (h) Folding the sheet so that the first section first face overlies a part, but not all, of the second section first face, and the marginal portions thereof are in engagement, and so that the third section first face overlies a portion of the second section first face, and all of the first section second face, with the marginal portions thereof in engagement; and applying pressure to the sheet at the longitudinal strips of pressure sensitive adhesive to seal the sheet into a mailer, the first and second sections forming a return envelope and all of the sections forming an outgoing mailer.

According to the second method of the invention, a mailer type business form within integral return envelope is constructed from a sheet of paper having first and second parallel longitudinal edges, and first and second parallel transverse edges perpendicular to the longitudinal edges, having first and second faces. The second method comprises the steps of: (a) Forming first and second longitudinal lines of weakness in the sheet parallel to and adjacent, but spaced from, the first and second longitudinal edges, respectively, the lines of weakness defining, with the longitudinal edges, longitudinal marginal portions. (b) Providing first and second longitudinal strips of pressure sensitive adhesive in the first and second longitudinal marginal portions, respectively, of the first face, extending parallel to the first and second longitudinal edges. (c) Providing third and fourth longitudinal strips of pressure sensitive adhesive disposed parallel to the first and second strips, and disposed adjacent the first and second lines of weakness on the opposite side thereof from the first and second strips, on the first face, the third and fourth longitudinal strips disposed closer to the first transverse end than the second. (d) Providing a transverse adhesive strip on the first face, perpendicular to the third and fourth strips, longitudinally spaced from the third and fourth strips. (e) Providing a line of

weakness adjacent the transverse strip, on the opposite side thereof from the third and fourth strips, to allow ready separation of the paper at that line. (f) Providing first and second transverse fold lines, the first fold line closer to the first transverse edge and the second fold line closer to the second transverse edge, to define a first section between the first transverse edge and the first fold line, a second section between the first and second fold lines, and a third section between the second fold line and second transverse edge. (g) Die cutting a window in the third section at the portion thereof adapted to overlie outgoing addressee address indicia once the mailer is formed. (h) Feeding the sheet to a non-impact simplex printer to print indicia on only the first face, including outgoing addressee address indicia on the first face in the second section. (i) Folding the sheet so that the first section first face overlies a part, but not the outgoing address indicia, of the second section first face, and the marginal portions thereof are in engagement, and so that the third section first face overlies a portion of the second section first face so that the outgoing address indicia is visible through the window in the third section, and all of the first section second face, with the marginal portions thereof in engagement; and applying pressure to the sheet at the longitudinal strips of pressure sensitive adhesive to seal the sheet into a mailer, the first and second sections forming a return envelope and all of the sections forming an outgoing mailer.

It is the primary object of the present invention to provide a simple, easily constructed, yet very functional and versatile mailer type business form with integral return envelope. This and other objects of the invention will become clear from an inspection of the detailed description of the invention, and from the appended claims.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a top plan view of a first face of first exemplary mailer type business form intermediate according to the invention;

FIG. 2 is a view like that of FIG. 1 only of the second face;

FIG. 3 is a top plan view, with portions cut away for clarity of illustration of the underlying components, of the outgoing mailer type business form according to the invention constructed from the intermediate of FIGS. 1 and 2;

FIG. 4 is a view like that of FIG. 3 for the return envelope portion of the mailer of FIG. 3, ready for return mailing; and

FIGS. 5 and 6 are views like those of FIGS. 1 and 2, respectively, only for a second exemplary embodiment of an intermediate according to the invention.

DETAILED DESCRIPTION OF THE DRAWINGS

A first construction of an exemplary mailer type business form intermediate according to the invention is illustrated generally by reference numeral 10 in FIGS. 1 and 2. A first face 11 of the intermediate is illustrated in FIG. 1, which is ultimately formed into first, second, and third sections 12 through 14, respectively. The intermediate 10 has a first transverse end, in this case a transverse edge 15 (since the intermediate 10 is a cut paper sheet), and it has longitudinal first and second edges 16, 17, which are parallel to each other and perpendicular to the first transverse edge 15. The first through third sections 12 through 14 are formed by first and second transverse fold lines 18, 19, respectively. A third transverse fold line 20 may also be provided in the second section 13, adjacent the second transverse line 19 Opposite the first transverse edge 15 is a second transverse edge 21, also perpendicular to the longitudinal edges 16, 17. The first section

12 is defined by the edge 15 and fold line 18, the second section 13 by the fold lines 18, 19, and the third section 14 by the fold line 19 and edge 21.

The intermediate 10 preferably also comprises a line of weakness -- such as a perforation -- 22 disposed in the third section 14, spaced from and parallel to the second fold line 19, and a longitudinal line of weakness 23 -- such as a perforation -- may be provided in the third section 14, intersecting the transverse line of weakness 22. Below the transverse line of weakness 22, and between it and the fold line 19, is a transverse strip of adhesive 24, which preferably comprises rewettable glue.

The intermediate 10 also comprises first and second longitudinal lines of weakness 26, 27, such as perforations, formed in the paper sheet and parallel to and adjacent, but spaced from, the longitudinal edges 16, 17, respectively. The lines of weakness 26, 27 define -- with the longitudinal edges 16, 17 -- longitudinal marginal portions, including the longitudinal marginal portions 28, 29 in the first section 12, 30, 31 in the second section 13, and 32, 33 in the third section 14.

The intermediate 10 also comprises first and second longitudinal strips of adhesive disposed in the longitudinal marginal portions of the first face 11 and extending the majority length of the marginal portions and parallel to the longitudinal edges 16, 17. The first and second strips are interrupted at the fold lines 18, 19, and perhaps elsewhere. The first longitudinal strip comprises the adhesive sections 35, 37 and 39, formed in the first, second, and third sections 12 through 14, respectively, while the second longitudinal strip comprises the sections 36, 38, 39', again formed in the first through third sections 12 through 14, respectively. Discontinuities 40, 41 are disposed in the adhesive strip sections 37, 38, respectively, in the second section 13 merely to

facilitate engagement of the friction feeding mechanism of most conventional cut sheet laser printers at that area, which eliminates the possibility of adhesive flaking off and contaminating sensitive printer components. If the intermediate 10 is used with a continuous laser printer, or a type of printer not requiring the same type of friction feeding mechanism, then the discontinuities 40, 41 need be provided.

While the longitudinal adhesive strip sections 35 through 39' are illustrated in FIG. 1 as extending essentially the entire length of the face 11, depending on the particular type of adhesive utilized and the end requirements, it may only be necessary for the adhesive to extend about half of the length of face 11.

The intermediate 10 also comprises third and fourth longitudinal strips of adhesive disposed parallel to the first and second strips of adhesive, and disposed adjacent the first and second lines of weakness 26, 27, respectively, on opposite sides thereof from the first and second strips of adhesive, on the first face, 11. The third and fourth longitudinal strips of adhesive are disposed closer to first end 15 than to second end 21, and extend a distance substantially less than the extent of the first and second strips of adhesive. In fact, typically the third and fourth longitudinal strips of adhesive extend longitudinal distance slightly less than half (e.g., about 45%) of the length of the edges 16, 17. The third longitudinal strip of adhesive is illustrated by portions 42, 44 in FIG. 1, in sections 12, 13 respectively, while the fourth longitudinal strip of adhesive is illustrated by portions 43, 45 in the sections 12, 13, respectively. The sections 42, 44 and 43, 45, respectively, are coextensive. Depending upon the particular type of adhesive, only one of the sections 42, 44 or 43, 45 need be provided.

It is preferred according to the present invention that the adhesive used to form all of the longitudinal strips -- e.g., the

adhesive for strip portions 35 through 39', and 42 through 45 -- be a pressure sensitive adhesive, such as for use with conventional pressure seal equipment, such as the SpeediSealer® pressure seal equipment marketed by Moore Business Forms. One example of such an adhesive is that marketed by Toppan Moore of Japan under the trade designation TN-124, which is a styrene-natural rubber copolymer. Another commercially available adhesive that may be utilized is the Fuller HL-9016 adhesive. Other pressure sensitive adhesive compositions which may be satisfactory are those shown in U.S. Pat. Nos. 3,041,308; 3,444,269; 3,449,471; 3,862,913; 4,228,256; 4,471,082; 3,644,579; 3,849,358; 4,483,951; and 4,397,992.

The intermediate 10 includes an upper portion detachable along the perforation 22, as illustrated by reference numeral 46, with a remittance stub portion or the like, 46', to the right of the longitudinal perforation 23 as seen in FIG. 1. The portions 46, 46' are detached by the recipient of the mailer type business form constructed from the intermediate 10, and the remittance stub 46' is returned in the integral return envelope.

FIG. 2 illustrates the second face, 47, of the intermediate 10. On the second face 47 it is preferred that fifth and sixth longitudinal pressure sensitive adhesive strips 48, 49 are provided in the marginal portion sections 28, 29, respectively, of the adhesive second face 47. The strips 48, 49 are aligned with the adhesive strip sections 39, 39', although they extend less than the distance thereof, extending the length of the first section 12, which is less than that of the second and third sections 13, 14. The adhesive strips 48, 49 are not always necessary, depending upon the particular type of adhesive utilized, but typically are provided when the pressure sensitive adhesives TN-124, or HL-9016 -- described above -- are utilized.

On the second face 47, outgoing addressee address information 50 is printed by a non-impact printer in the third section 14, as is return address information 51 also printed in the third section 14 second face 47, and a postal indicia area 52 is provided (or printed) opposite the return address information 51. Also, indicia facilitating and suggesting the insertion of return address information on a return envelope form from the intermediate 10 is printed as indicated at 53, by a non-impact printer on the face 47, typically overlapping the second section 13 and third section 14 thereof, as illustrated in FIG. 2. Finally, the laser printer will print address information for the return envelope, as illustrated at 54 in FIG. 2, in the first section 12 on the second face 47.

FIG. 3 illustrates a C-fold mailer type business form, with the integral return envelope, 56 according to the invention. As is readily apparent from FIG. 3, after printing on a laser printer, the form 56 is constructed by folding the sheet at the first fold line 18 so that the first face 11 of the first section 12 overlies a part of the first face of the second section 13, and then folding the sheet at the second fold line 19 so that the third section 14 first face overlies a portion of the second section 13 first face, and the entire first section 12 second face 47. In this position, the glue strip sections 35, 37, 39, and 48 are aligned, the glue strip sections 42, 44, are aligned, the glue strip sections 36, 38, 39' and 49 are aligned, and the glue strip sections 43, 45 are aligned. The outgoing envelope address information 50 is readily visible on the exterior of the mailer 56, and covers the return envelope address information 54.

When the mailer 56 is constructed, one or two inserts 57 may be provided if desired.

FIG. 4 illustrates the integral return envelope 58, which is detachable from the mailer 56. When the addressee of the mailer 56 receives it, he or she removes the longitudinal

marginal portions 28 through 33 by detachment along the perforations 26, 27, detaches the portions 46, 46' by separating the sheet at the perforations 22, 23, and then inserts the remittance stub portion 46' into the return envelope 56, between the first face of the first section 12 and the first face of the second section 13. When the user is ready to seal the return envelope 56, he or she merely wets the transverse adhesive strip 24, and bends the form about the third transverse fold line 20 (which preferably does not extend into the marginal portions 28-33), and presses the adhesive 24 into contact with the second face of the first section 12 adjacent the first transverse edge 15. The return envelope address indicia 54 is then clearly visible on the outside of the return envelope 58, as is the indicia 53 facilitating and suggesting the insertion of return address information on return envelope 58 by the user.

The intermediate 10, mailer 56, and return envelope 58 now having been described, the method of forming the mailer type business form 56 from a sheet of paper will now be set forth. The method comprises the steps of: (a) Forming first (26) and second (27) longitudinal lines of weakness in the sheet parallel to and adjacent, but spaced from, the first and second longitudinal edges 16, 17, respectively, the lines of weakness defining, with the longitudinal edges, longitudinal marginal portions 28-33. (b) Providing first (35, 37, 39) and second (36, 38, 39') longitudinal strips of pressure sensitive adhesive in the first and second longitudinal marginal portions 28-33, respectively of the first face 11, extending parallel to the first and second longitudinal edges 16, 17. (c) Providing third (42, 44) and fourth (43, 45) longitudinal strips of pressure sensitive adhesive disposed parallel to the first and second strips of adhesive, and disposed adjacent the first and second lines of weakness 26, 27 on the opposite side thereof from the first and second strips of adhesive, on the first face 11, the third and fourth longitudinal strips of adhesive disposed closer to the first

transverse edge 15 than the second 21. (d) Providing a transverse adhesive strip 24 on the first face 11, perpendicular to the longitudinal edges 16, 17, and longitudinally spaced from the third and fourth strips of adhesive (42-45). (e) Providing a line of weakness 22 adjacent the transverse strip 24, on the opposite side thereof from the third and fourth strips of adhesive (42-45), to allow ready separation of the paper at that line. (f) Providing first and second transverse fold lines 18, 19, the first fold line 18 closer to the first transverse edge 15 and the second fold line 19 closer to the second transverse edge 21, to define a first section 12 between the first transverse edge 15 and the first fold line 18, a second section 13 between the first 18 and second 19 fold lines, and a third section 14 between the second fold line 19 and second transverse edge 21. (g) Feeding the sheet to a non-impact (e.g. laser) duplex printer to print indicia on both the first 11 and second 47 faces, including outgoing addressee address indicia 50 on the second face 47 in the third section 14, and return envelope address indicia 54 on the second face 47 in the first section 12. (h) Folding the sheet (e.g., with a conventional C-folder utilized with Moore SpeediSealer® pressure seal equipment) so that the first section 12 first face 11 overlies a part, but not all, of the second section 13 first face 11, and the marginal portions (28, 30; 29, 31) thereof are in engagement, and so that the third section 14 first face 11 overlies a portion of the second section 12 first face 11, and all of the first section 12 second face 47, with the marginal portions (28, 30, 32; 29, 31, 33) thereof in engagement; and (i) applying pressure (e.g., with the Moore SpeediSealer® pressure seal equipment) to the sheet at the longitudinal strips (35-39, 42-45) of pressure sensitive adhesive to seal the sheet into a mailer, the first and second sections forming a return envelope (58) and all of the sections forming an outgoing mailer (56).

Step (i) is practiced -- particularly when Moore SpeediSealer® equipment is used -- so that pressure is applied

only in alignment with the longitudinal strips of adhesive, and not over the entire width of the form. Also, there preferably is a further step (j) of -- between steps (h) and (i) of providing one or more inserts in the mailer. Also, step (g) is preferably practiced to also print return address information on the outgoing envelope, on the second face 47 of the third section 14, and indicia 53 facilitating and suggesting the insertion of return address information on the return envelope 58, on the second face 47 on both the second section 13 and third section 14.

FIGS. 5 and 6 illustrate a second construction of mailer intermediate 110 according to the invention. In this embodiment, structures the same as those in the FIGS. 1 through 4 embodiment are illustrated by the same reference numeral only preceded by a "1". The common elements, with the "1" prefex numeral will not be described in detail, but rather only the different structures.

In the FIGS. 5 and 6 embodiment, a die cut window 60 is formed in the third section 114, adjacent the transverse line of weakness 122 and the longitudinal line of weakness 123, close to the second section 113. The outgoing addressee address information is printed at 61 on the first face 111 of the second section 113, at a portion thereof adjacent the third fold line 120, which will insure that the window 60 overlies the indicia 61 when a mailer is formed (the spacing between the perforation 122 and first fold line 119 being approximately the same as the spacing between the second and third fold lines 119, 120). In the FIG. 5 embodiment, the first and second longitudinal strips of adhesive 135, 136 do not have discontinuities 40, 41 such as illustrated in the FIG. 1 embodiment, since preferably the transverse ends 115, 121 of the intermediate 110 are connected in continuous format to like intermediates 110, and are fed through a continuous laser printer, rather than sheet fed. However, the intermediates 110 can be sheet fed too, in which

case discontinuities like the discontinuities 40, 41 preferably are provided in the adhesive strips 135, 136.

On the second face 147 (FIG. 6) of the intermediate 110, the outgoing envelope return address 63, postal indicia 62, remittance address 64, and return address insertion facilitating indicia 65 are preprinted, since the intermediate 110 is used with a simplex printer rather than duplex printer, so that the only indicia capable of being printed thereby is on the first face 111.

A method of forming a mailer type business form with integral return envelope from a sheet of paper having first and second parallel longitudinal edges 116, 117, and first and second parallel transverse ends 115, 121, and first and second faces 111, 147 is provided. This method comprises the following steps: (a) Forming first (126) and second (127) longitudinal lines of weakness in the sheet parallel to and adjacent, but spaced from, the first and second longitudinal edges, respectively, the lines of weakness defining, with the longitudinal edges, longitudinal marginal portions 128, 129. (b) Providing first (135) and second (136) longitudinal strips of pressure sensitive adhesive in the first and second longitudinal marginal portions 128, 129, respectively, of the first face 111, extending parallel to the first and second longitudinal edges 116, 117. (c) Providing third (142) and fourth (143) longitudinal strips of pressure sensitive adhesive disposed parallel to the first and second lines of weakness 126, 127 on the opposite side thereof from the first and second strips of adhesive 135, 136, on the first face, the third and fourth longitudinal strips of adhesive disposed closer to the first transverse end 115 than the second 121. (d) Providing a transverse adhesive strip 124 on the first face, perpendicular to the longitudinal edges, longitudinally spaced from the third and fourth strips of adhesive 142, 143. (e) Providing a line of weakness 122 adjacent the transverse strip, on the opposite side

thereof from the third and fourth strips of adhesive 142, 143, to allow ready separation of the paper at that line. (f) Providing first and second transverse fold lines 118, 119, the first fold line 118 closer to the first transverse end 115 and the second fold line 119 closer to the second transverse edge 121, to define a first section 112 between the first transverse edge and the first fold line, a second section 113 between the first and second fold lines, and a third section 114 between the second fold line and second transverse edge. (g) Die cutting a window 60 in the third section 114 at the portion thereof adapted to overlie outgoing addressee address indicia (61) once the mailer is formed. (h) Feeding the sheet 110 to a non-impact (e.g. continuous laser) simplex printer to print indicia on only the first face 111, including outgoing addressee address indicia 61 on the first face 111 in the second section 113. (i) Folding the sheet (e.g., with a conventional C-folder utilized with Moore SpeediSealer® pressure seal equipment) so that the first section 112 first face overlies a part, but not the outgoing address indicia 61, of the second section 113 first face, and the marginal portions 128, 129 thereof are in engagement, and so that the third section 114 first face overlies a portion of the second section 113 first face so that the outgoing address indicia 61 is visible through the window 60 in the third section 114, and all of the first section 112 second face 147, with the marginal portions 128, 129 thereof in engagement; and (j) applying pressure (e.g., with the Moore SpeediSealer® pressure seal equipment) to the sheet at the longitudinal strips 135, 136, 142, 143 of pressure sensitive adhesive to seal the sheet into a mailer, the first and second sections forming a return envelope and all of the sections forming an outgoing mailer.

It will thus be seen that according to the present invention an intermediate for a mailer type business form, a mailer type business form with integral return envelope, and methods of forming mailer type business form with integral return

envelopes, are provided, which are simple and advantageous. While the invention has been herein shown and described in what is presently conceived to be the most practical preferred embodiment, it will be apparent to those of ordinary skill in the art that many modifications may be made thereof within the scope of the invention, which scope is to be accorded the broadest interpretation of the appended claims so as to encompass all equivalent products and procedures.

What is claimed is:

1. A mailer type business form intermediate, comprising:

a sheet of paper having a first face, adapted to provide the majority of the interior of the mailer when constructed, and a second face, adapted to provide the majority of the exterior of the mailer when constructed;

said sheet having first and second opposite, parallel longitudinal edges extending the entire length thereof, and opposite ends;

first and second longitudinal lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;

first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, extending the majority of the lengths of said longitudinal marginal portions, and parallel to said first and second longitudinal edges;

third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed

adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips disposed closer to one end of said ends than the other, and extending a distance substantially less than the extent of said first and second strips;

fifth and sixth longitudinal strips of adhesive parallel to said first and second longitudinal edges and disposed in said first and second marginal portions, respectively, on said second face, said fifth and sixth strips located adjacent the same end of said sheet as said third and fourth strips, and having a longitudinal extent at the most equal to said and fourth strips;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips, longitudinally spaced from said third and fourth strips; and

means defining a line of weakness adjacent said transverse strip, on the opposite side thereof from said third and fourth strips, to allow ready separation of the paper at that line.

2. An intermediate as recited in claim 1 wherein said first through sixth adhesive strips are of pressure sensitive adhesive.

3. An intermediate as recited in claim 2 wherein said third and fourth strips each have a longitudinal extent of about half the length of each of said first and second strips, and said fifth and sixth strips each have a longitudinal extent of about half the length of each of said third and fourth strips.

4. An intermediate as recited in claim 3 further comprising a first transverse fold line forming means disposed in said sheet

at about the midpoint of said third and fourth strips, said third and fourth strips being discontinuous thereat.

5. An intermediate as recited in claim 4 further comprising second and third transverse fold line forming means disposed in said sheet on the opposite side of said transverse adhesive strip from said transverse line of weakness, and intersecting said first and second longitudinal adhesive strips, but not said third and fourth strips.

6. An intermediate as recited in claim 5 wherein said ends of said sheet are edges, and wherein said first and second strips have a break therein to facilitate feeding by a printer sheet feeder.

7. An intermediate as recited in claim 5 wherein said ends of said sheet: are lines of weakness releasably connected said sheet: to other sheets, in continuous form; and further comprising a die cut window formed in said sheet.

8. An intermediate as recited in claim 2 wherein said first through sixth adhesive strips are of pressure sensitive adhesive.

9. A mailer type business form, with integral return envelope, comprising:

a C-fold paper sheet having first and second faces, first and second opposite longitudinal edges extending the entire length thereof, and first and second transverse fold lines defining first, second and third sections of said sheet;

said second and third sections being larger than said first section;

first and second lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines

of weakness defining, with said longitudinal edges, longitudinal marginal portions;

first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, and parallel to said first and second longitudinal edges; said first and second longitudinal strips connecting at least said first and second sections, and said third and first sections, together at said longitudinal marginal portions;

third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips connecting said first section to a part of said second section to form the sides of a return envelope;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips, in said third section;

means defining a transverse line of weakness adjacent said transverse strip in said third section, on the opposite side thereof from said second section, to allow ready separation of the form at that line;

outgoing address, and outgoing return address, indicia visible from said second face of said third section;

return envelope address indicia printed on said second face in said first section; and

indicia facilitating and suggesting the insertion of return address information on said return envelope, said

facilitating and suggesting indicia printed on said second face in both said second and third sections.

10. A business form as recited in claim 9 wherein said longitudinal strips of adhesive are pressure sensitive adhesive.

11. A business form as recited in claim 9 further comprising means defining a longitudinal line of weakness in said third section, intersecting said transverse line of weakness.

12. A business form as recited in claim 9 further comprising at least one insert.

13. A business form as recited in claim 9 further comprising fifth and sixth longitudinal strips of adhesive parallel to said first and second edges disposed in said marginal portions of said first section on said second face.

14. A business form as recited in claim 9 further comprising at least one insert.

15. A business form as recited in claim 9 further comprising a third transverse fold line between said first and second fold liens in said second section, and not extending into said marginal portions.

16. A mailer type business form, with integral return envelope, comprising:

a C-fold paper sheet having first and second faces, first and second opposite longitudinal edges extending the entire length thereof, and first and second transverse fold lines defining first, second and third sections of said sheet;

a third transverse fold line between said first and second fold lines in said second section, and not extending into the marginal portions;

said second and third sections being larger than said first section;

first and second lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;

first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, and parallel to said first and second longitudinal edges; said first and second longitudinal strips connecting at least said first and second sections, and said third and first sections, together at said longitudinal marginal portions;

third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips connecting said first section to a part of said second section to form the sides of a return envelope;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips, in said third section;

means defining a transverse line of weakness adjacent said transverse strip in said third section, on the opposite side thereof from said second section, to allow ready separation of the form at that line; and

outgoing address, and outgoing return address, indicia visible from said second face of said third section.

17. A mailer type business form, with integral return envelope, comprising:

a C-fold paper sheet having first and second faces, first and second opposite longitudinal edges extending the entire length thereof, and first and second transverse fold lines defining first, second and third sections of said sheet;

said second and third sections being larger than said first section;

first and second lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;

first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, and parallel to said first and second longitudinal edges; said first and second longitudinal strips connecting at least said first and second sections, and said third and first sections, together at said longitudinal marginal portions;

third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips connecting said first section to a part of said second section to form the sides of a return envelope;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips, in said third section;

means defining a transverse line of weakness adjacent said transverse strip in said third section, on the opposite side thereof from said second section, to allow ready separation of the form at that line; and

outgoing addressee address indicia printed on said first face in said second section, and means defining a die cut window in said third section allowing viewing of said outgoing addressee address information therethrough.

18. A business form as recited in claim 17 further comprising preprinted outgoing return address information printed on said second face in said third section.

19. A mailer type business form, with integral return envelope, comprising:

a C-fold paper sheet having first and second faces, first and second opposite longitudinal edges extending the entire length thereof, and first and second transverse fold lines defining first, second and third sections of said sheet;

said second and third sections being larger than said first section;

first and second lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;

first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, and parallel to said first and second longitudinal edges; said first and second longitudinal strips connecting at least said first and

second sections, and said third and first sections, together at said longitudinal marginal portions;

third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips connecting said first section to a part of said second section to form the sides of a return envelope;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips, in said third section;

means defining a transverse line of weakness adjacent said transverse strip in said third section, on the opposite side thereof from said second section, to allow ready separation of the form at that line;

outgoing address, and outgoing return address, indicia visible from said second face of said third section;

wherein said longitudinal strips of adhesive are pressure sensitive adhesive; and

a third transverse fold line between said first and second fold lines in said second section, and not extending into said marginal portions.

* * * * *

APPENDIX Q

US005253798A

United States Patent [19] [11] **Patent Number: 5,253,798**

Lombardo [45] **Date of Patent: Oct 19, 1993**

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[54] PRESSURE SEAL ADHESIVE PATTERN FOR IBM 3800 PRINTERS

[75] Inventor: Leo Lombardo, Manchester, N.H.

[73] Assignee: Moore Business Forms, Inc., Grand Island, N.Y.

[21] Appl. No.: 824,408

[22] Filed: Jan, 23, 1992

[51] Int. Cl.[5] B65D 27/34; B65D 27/10

[52] U.S. Cl. 229/92.1; 229/314

[58] Field of Search: 229/92.1, 92.3, 314

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Primary Examiner -- Stephen P. Garber

Attorney, Agent, or Firm -- Nixon & Vanderhye

[57] **ABSTRACT**

A folded (e.g., Z-folded) mailer type business form is constructed so that it may be printed using an IBM 3800 printer without sticking to the printer fuser or backer rolls. Pressure sensitive adhesive patterns (e.g., discontinuous strips) are placed on the first face of a paper sheet near a first transverse edge, and the second face of the paper sheet near a second transverse edge. The spacings from the edge are about 5/16 inches in each case, sufficient to insure that the adhesive is not engaged by the printer rolls during pausing of the printer.

16 Claims, 3 Drawing Sheets

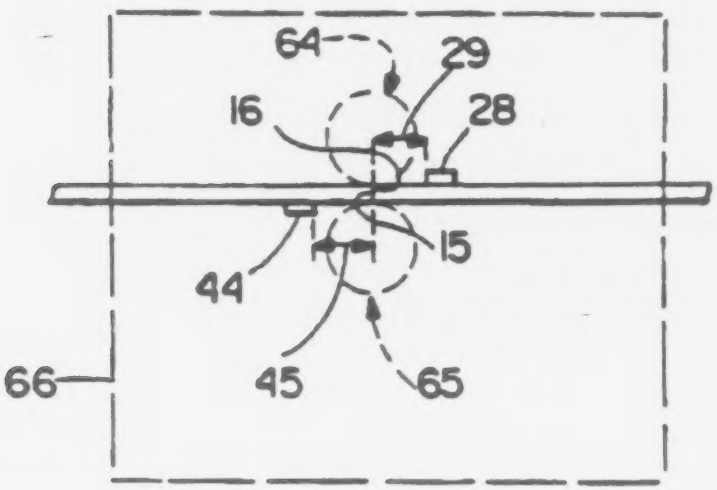
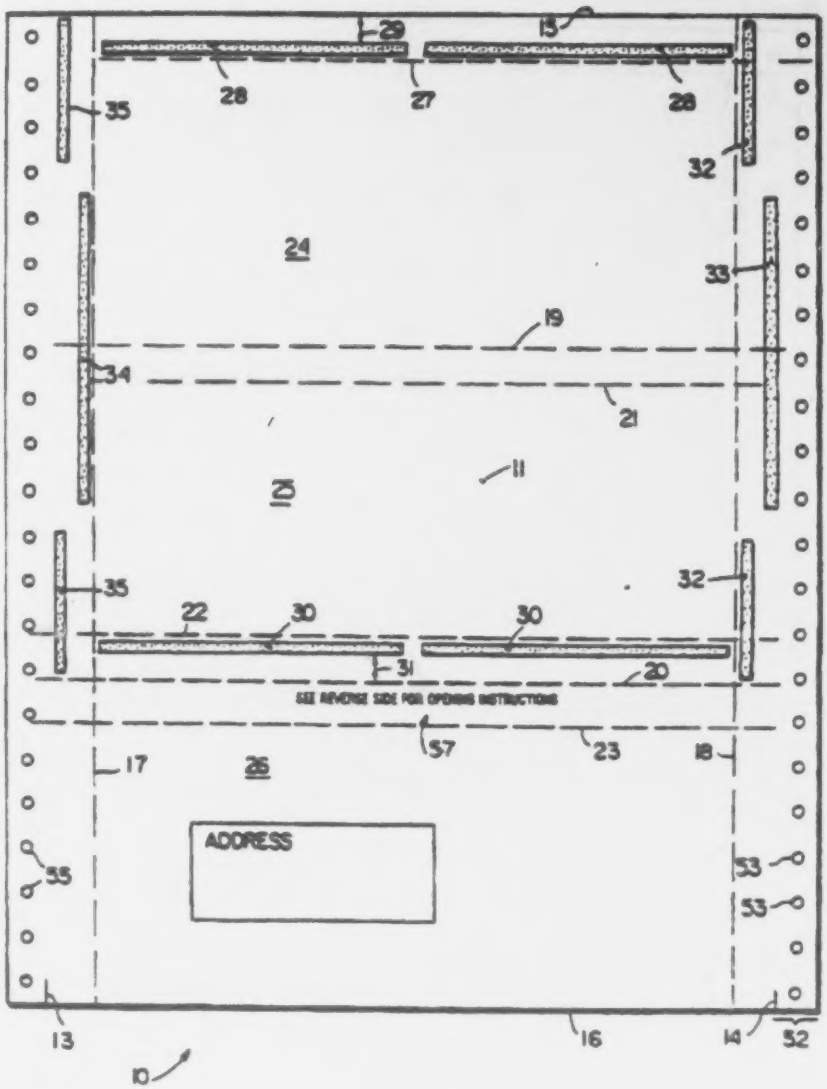


Fig. 1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SEE REVERSE SIDE FOR OPENING INSTRUCTIONS
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ADDRESS
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Fig. 2

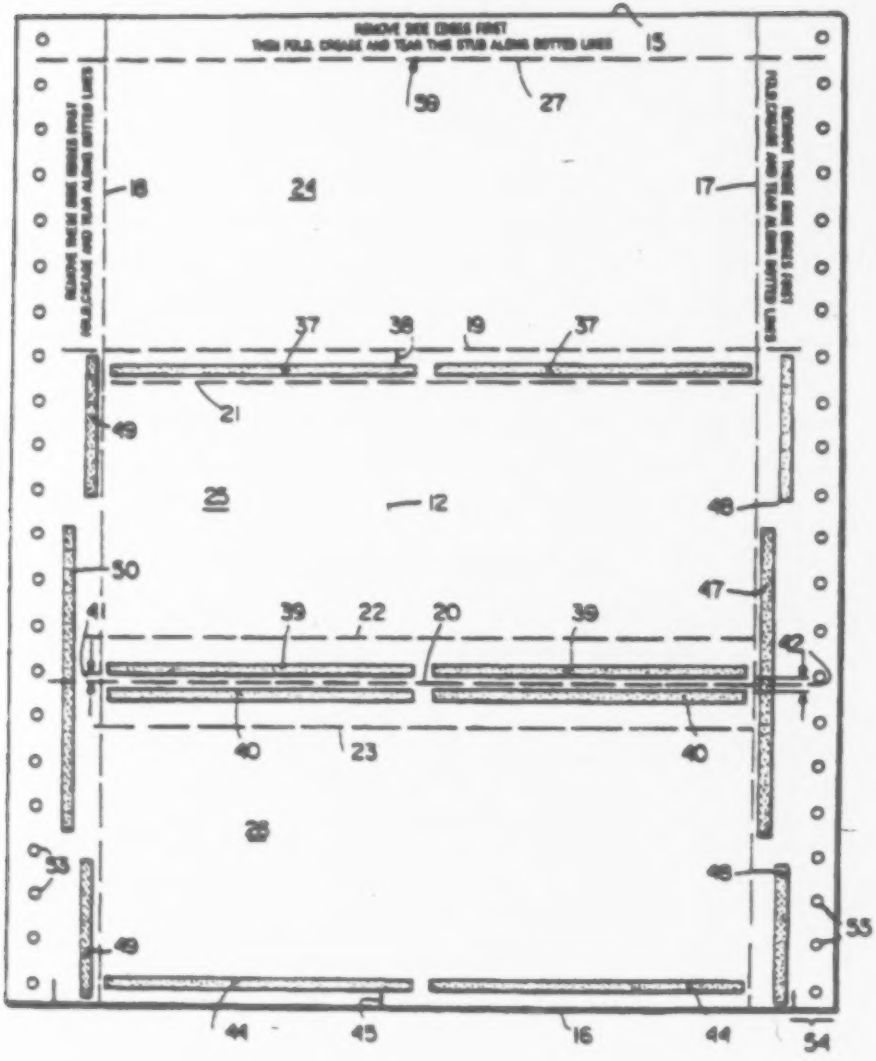
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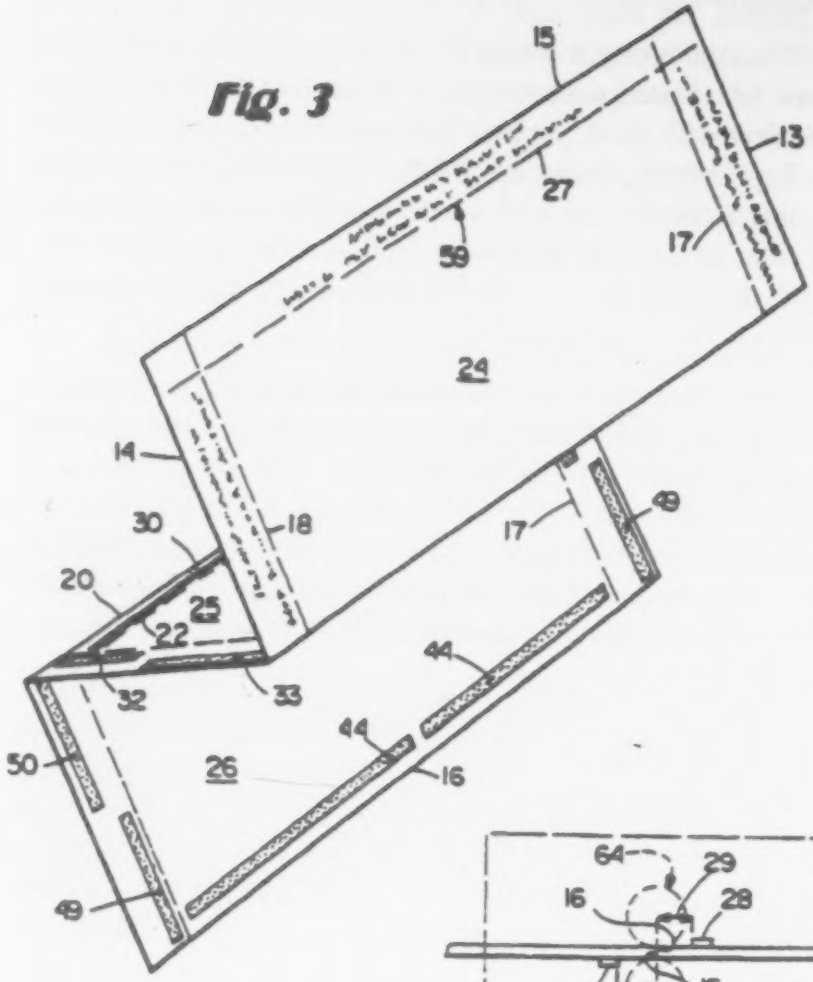
Fig. 3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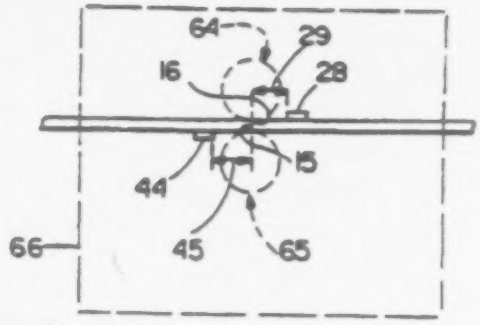
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Fig. 4

PRESSURE SEAL ADHESIVE PATTERN FOR IBM 3800 PRINTERS

BACKGROUND AND SUMMARY OF THE INVENTION

The conventional mailer forms used in the Moore Business Forms, Inc. Speedisealer® equipment, sold under the trademark Speedisealer®, have proven to be very simple and efficient to use. Typically the forms are fed through a laser printer in sheet or continuous format with variable printing being applied to one side, or typically both sides, and then the forms are burst, the tractor guide portions are slit, and individual sheets are then folded and pressure sealed.

While the conventional forms in the Moore Speedisealer® pressure seal system have been very effective, there has been one substantial problem when utilized with certain types of printers, such as the IBM 3800 printers. When conventional mailer forms with pressure adhesive are utilized with the 3800 printer, the forms sometimes jump out of time, warp the fuser rolls of the printer, and cause other problems.

Upon close inspection of the cooperation between the IBM 3800 printers and the conventional pressure seal forms, the source of the problems discussed above has been identified. The IBM 3800 printer operates in such a way that it pauses at regular intervals. When the printer pauses, it has been found that an impression is created 1/4 inch on either side of the fold perforations between forms in the continuous web. Since there is adhesive in that impression area, the forms are caused to stick to the fuser roll and/or the backup roller. This then results in the forms jumping out of time, warping of the fuser rollers, etc., as described above.

According to the present invention, the problem described above has been solved in a simple yet effective manner. According to the present invention, the adhesive patterns on the

form have been changed so that they do not interfere with the rollers of the printer used to process the mailers. That is, on both the front and back of the form, the adhesive patterns which are conventionally located 1/16 inch from the leading and trailing edges of the individual forms in the continuous web are repositioned so that they are 5/16 inch away from the leading and trailing edges. This repositioning does not adversely affect the action on the forms in the Moore Speedisealer® pressure seal equipment nor the integrity of the final mailers produced, yet allows the mailers to be processed without the problems discussed above.

According to one aspect of the present invention a method of forming a mailer type business form from a sheet of paper having first and second faces (and typically being a continuous web) using an IBM 3800 printer having fuser and backup rollers is provided. The method comprises the following steps: (a) Forming first and second longitudinal lines of weakness in the sheet parallel to and adjacent, but spaced from, the first and second longitudinal edges, respectively, the lines of weakness defining, with the longitudinal edges, longitudinal marginal portions. Forming first and second transverse fold lines in said sheet to form the first, second, and third sections. (c) Providing matching longitudinal patterns of pressure sensitive adhesive in the longitudinal marginal portions. (d) Providing transverse patterns of pressure sensitive adhesive (e.g., first, second, third and fourth transverse patterns of pressure sensitive adhesive on the sheet, the first and third on the first face, and the second and fourth on the second face), so that the first and third patterns and second and fourth patterns cooperate with each other when the sheet is folded about the fold lines, and so that none of the transverse adhesive patterns are engaged by the fuser and backer rollers during pausing of the printer. (e) Passing the sheet through the 3800 printer to effect printing thereof. (f) Folding the sheet about the fold lines so that all the

corresponding patterns of adhesive cooperate with each other. And, (g) Applying pressure to the sheet at the adhesive strips to activate the pressure sensitive adhesive and seal the sheet into a mailer.

Typically the sheet is in continuous web format in which case there is the further step (h), between steps (e) and (f), of bursting the continuous web into individual sheets. The sheet also typically has tractor holes along the longitudinal edges thereof and step (e) is practiced by feeding the sheet through the printer using the tractor holes. There is also the further step (i), after step (e), of slitting the sheet adjacent the longitudinal edges to remove the tractor hole containing portions. Prefolding step (f) is preferably Z-folding.

The invention also relates to a mailer type business form. The form has the following elements: A folded paper sheet having first and second faces, first and second opposite longitudinal edges, and first and second transverse fold lines defining first, second and third sections of the sheet. First and second longitudinal lines of weakness forming with the longitudinal edges first and longitudinal marginal portions. A first transverse edge and a second transverse edge, both parallel to the first and second fold lines. Longitudinal patterns of adhesive disposed in the longitudinal marginal portions for holding the marginal portions of the first through third sections together. At least one of first and second transverse patterns of adhesive disposed adjacent at least one of the first and second transverse edges on the first face and first section, and second face and second section, respectively; and at least one of the the first and second transverse patterns of adhesive being spaced from its associated transverse edge a distance sufficient to insure that the adhesive does not interfere with rollers of a printer used to process the mailer. Preferably both the first and second transverse patterns of adhesive are provided, and are each spaced from the first and second transverse edges,

respectively, about 5/16 inches, and the sheet is Z-folded. The first and second transverse patterns of adhesive are typically discontinuous strips, although other patterns may be provided.

The transverse adhesive patterns are typically pressure sensitive adhesive, and third and fourth transverse patterns are also provided for cooperating with the first and second patterns to hold the mailer together. The third pattern is formed on the first face, second section, adjacent the second transverse fold line, and the fourth pattern is formed on the second face, second section, adjacent the first transverse fold line.

It is a primary object of the present invention to provide a method of forming a mailer type business form including printing using an IBM 3800 printer without substantial operational difficulties, and to provide a mailer type business form that is simply and effectively produced. This and other objects of the invention will become clear from an inspection of the detailed description of the invention, and from the appended claims.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a top plan view of a mailer intermediate according to the present invention;

FIG. 2 is a bottom plan view of the mailer intermediate of FIG. 1;

FIG. 3 shows the intermediate of FIGS. 1 and 2 after slitting to remove the side tractor feed holes, and as it is being Z-folded to produce a final mailer; and

FIG. 4 is a side schematic view showing the positions of pressure seal adhesive strips adjacent the trailing and leading edges of consecutive continuous forms during pausing an IBM 3800 printer.

DETAILED DESCRIPTION OF THE DRAWINGS

A mailer type business form, as illustrated in FIG. 3, is produced from a folded (preferably Z-folded) paper sheet 10 having first and second faces 11, 12 (FIGS. 1 and 2, respectively), first and second opposite longitudinal edges 13, 14 (formed by slitting the intermediate of FIGS. 1 and 2), and first and second opposite transverse edges 15, 16. The transverse edges 15, 16 are typically connected to like sheets 10 in continuous web format during processing of the form by an IBM 3800 printer, but the sheets 10 are burst from the continuous web along perforations at the transverse edges 15, 16. The sheets 10 also comprise longitudinal lines of weakness (such as perforations) 17, 18 parallel to the longitudinal edges 13, 14, and first and second transverse fold lines 19, 20, respectively, parallel to the transverse edges 15, 16. Transverse lines of weakness 21, 22 also are preferably provided spaced about ½ of an inch from the transverse fold lines 19, 20, the lines of weakness 21, 22 preferably being perforations.

The transverse fold lines 19, 20 divide the sheet 10 into first, second, and third sections 24, 25, and 26, respectively. The third section 26 is typically the section having the address area for the mailer produced from the sheet 10. The spacing between the first transverse fold line 19 and the line of weakness 21 is about ½ of an inch, while the spacing between each of the lines of weakness 22, 23 and the second transverse fold line 20 is ½ inch respectively.

Adjacent the first transverse (leading) edge 15 there preferably is provided a transverse line of weakness (e.g., perforation) 27, parallel to the edge 15 and spaced between about ½ inch from the edge 15. Between the line of weakness 27 and the first transverse edge 15 is an adhesive pattern, such as the discontinuous transverse strip 28, which is parallel to the edge 15. While heat activated adhesive may be utilized for the

adhesive pattern 28, preferably it is conventional pressure sensitive adhesive used with the Moore Speedisealer® pressure seal equipment, as on the conventional Moore Sealermate® Z-folded pressure seal system form. One example of such an adhesive is that marketed by Topan Moore of Japan under the trade designation TM-124, which is a styrene-natural rubber copolymer. Another commercially available adhesive that may be utilized is the Fuller HL-9016 adhesive.

According to the present invention, the adhesive pattern 28 is spaced from the edge 15 a distance 29 which is sufficient to insure that the pattern 28 does not interfere with the fusion or backup rollers of an IBM 3800 printer during pausing of the printing in its natural timing sequence. In conventional Sealermate® pressure seal forms, the spacing of the adhesive patterns 28 from the edge 15 is only about 1/16 of an inch, which has been found according to the invention to result in engagement of the adhesive with the backup and/or fusion rollers during pausing of the printer, and subsequent problems. According to the invention, the spacing 29 is approximately 5/16 of an inch. This is sufficient to avoid engagement of the fusion or backup rollers with the strips 28 when the printer pauses. Yet the spacing 29 is not significant enough so as to adversely affect the integrity of the final mailer produced. With such a spacing 29, the final mailer is still sufficiently integral and secure after pressure sealing that no operational or aesthetic problems are associated with the mailer.

The face 11 also includes a transverse pattern (e.g., discontinuous strip) 30 of adhesive (typically pressure sensitive adhesive) spaced a distance 31 from the second transverse fold line 20, and second section 25. The spacing 31 is different from that in a conventional form, having been adjusted to accommodate the shifting of the pattern 28 (and a like pattern on the opposite face 12 to be hereafter described). Typically,

the distance 31 is about 1/4 inch, that is the pattern 30 is about 1/16 inch away from the transverse tear-off perf 22.

Longitudinal strips of adhesive are also disposed on the sheet 10 face 11. They are disposed in the longitudinal marginal portions formed between the first and second longitudinal lines of weakness 17, 18 and the first and second longitudinal edges 13, 14. As illustrated in FIG. 1, the longitudinal patterns 32, 33 -- spaced transversely from each other, in the form of integral or discontinuous strips -- are provided in the longitudinal portion adjacent the second longitudinal line of weakness 18, while similar patterns 34, 35 are disposed adjacent the first longitudinal line of weakness 17.

On the face 12 (FIG. 2) other transverse adhesive patterns are provided. For example, the patterns (discontinuous strip) 37 are provided in the first section 24, spaced a distance 38 which is preferably about 5/16 inch away from the first transverse fold line 19. Transverse patterns 39, 40 are provided in the second and third sections 25, 26, respectively, each spaced about 1/16 inch from the second transverse fold line 20, as indicated by the spacings 41, 42. A transverse pattern (in the form of a discontinuous strip 44) is also provided adjacent the second (trailing) transverse edge 16, the pattern 44 being spaced a distance 45 from the edge 16, which preferably is about 5/16 of an inch, and in any event is sufficient to prevent the IBM 3800 printer fuser backup rollers engaging the pattern 44 during pausing. On the face 12 are also further longitudinal patterns which cooperate with each other to effect holding of the final mailer together, in the form of the patterns 47, 48 in the longitudinal margin adjacent the first longitudinal line of weakness 17, and patterns 49, 50 adjacent the second longitudinal line of weakness 18. All of the patterns 37, 39, 40, 44, and 47 through 50 are preferably pressure sensitive adhesive as described above with respect to the pattern 28.

Normally the paper sheet 10 -- as indicated above -- is part of a continuous web (see FIG. 4) during processing by an IBM 3800 printer. This is accomplished by providing a longitudinal drive portion 52 having openings 53 therein (see FIG. 1) and the longitudinal drive portion 54 having tractor holes 55 therein. As is conventional, after processing through the printer, the portions 52, 53 are removed to form the longitudinal edges 13, 14 by slitting.

The sheet 10 also has various instructional indicia thereon, such as the indicia 57 (FIG. 1) and 59 (FIG. 2).

Note that all of the adhesive patterns/strips provided with the sheet 10 align with each other to produce the final mailer. The longitudinal strips/patterns 32 through 35 and 47 through 50 are disposed in such a way that at no point do the marginal portions have a double thickness of adhesive when the sheet 10 is flat (that is, the patterns 32, 33 do not overlie the patterns 49, 50 and the patterns 34, 35 do not overlie the patterns 47, 48). However, when the sheet 10 is Z-folded -- as illustrated in FIG. 3 -- to produce the completed mailer, the adhesive portions 32 will align with each other, each half of the portion 33 will align with the other half, and likewise for the portions 34, 35, and 47 through 50. When the forms are thus run "longitudinally" and folded, through the conventional Speedisealer® pressure seal equipment, a positive adhesive seal will be provided.

As can be determined by viewing FIG. 3, in the final mailer a pattern 44 will align with the pattern 37, the patterns 39 and 40 will be aligned, and the patterns 28 and 30 will align, and be positively sealed by the pressure seal equipment. Once the final mailer is produced, and received by the ultimate user, access to the mailer contents is gained by separating the mailer components along the lines of weakness 17, 18, 27, 21 through 23.

FIG. 4 illustrates, in schematic form, the pausing of an IBM 3800 printer 66 while processing sheets 10 in continuous format. In FIG. 4 the fuser and backup rollers are illustrated in dotted line and schematically by reference numerals 64 and 65. Note that the spacings 29, 45 of the adhesive patterns 28, 44, respectively, are sufficient so that during this pause the strips 28, 44, will not be engaged by the rollers 64, 65. When the rollers 64, 65 engage the strips 28, 44 while the printer is operating, during normal operation, there is insufficient contact to result in problems. However, if the printer 66 is in a pause mode and the rollers 64, 65 engage the strips 28, 44, sufficient adhesive will be transferred so as to result in the forms jumping out of time, or warping of the rolls 64, 65, etc., due to at least limited sticking action of the adhesive to the rollers 64, 65. As can be seen in FIG. 4, this problem is avoided according to the invention.

The invention not only relates to the mailer 34 described with respect to FIGS. 1 through 3, but also a method of forming that mailer from a sheet 10 of paper having first and second faces 11, 12 utilizing an IBM 3800 printer 66 having fuser and backup rollers (64, 65). The method comprises the following steps:

a) forming first and second longitudinal lines of weakness (17, 18) in the sheet (10) parallel to and adjacent, but spaced from, the first and second longitudinal edges (13, 14), respectively, the lines of weakness (17, 18) defining, with the longitudinal edges (13, 14), longitudinal marginal portions (52, 54);

(b) forming first and second transverse fold lines (19, 20) in the sheet (10) to form the first (24), second (25), and third (26) sections;

(c) providing matching longitudinal patterns (e.g., 32-35) of pressure sensitive adhesive in the longitudinal marginal portions;

(d) providing a plurality of transverse patterns of pressure sensitive adhesive (e.g. first (28), second (44), third (30) and fourth (37) transverse patterns) on the sheet (e.g., the first (28) and third (30) on the first face (11), and the second (44) and fourth (37) on the second face (12), so that the first (28) and third (30) patterns and second (44) and fourth (37) patterns cooperate with each other when the sheet is folded about the fold lines), so that none of the transverse adhesive patterns (28, 30, 37, 39, 40, 44) are engaged by the fuser and backer rollers (64, 65) during pausing of the printer;

(e) passing the sheet (10) through the 3800 printer (66) to effect printing thereof;

(f) folding (preferably Z-folding) the sheet (10) about the fold lines (19, 20) so that all the corresponding patterns (28, 30, 37, 39, 40, 44) of adhesive cooperate with each other (see FIG. 3); and

(g) applying pressure to the sheet (10) at the adhesive strips to activate the pressure sensitive adhesive and seal the sheet into a mailer, typically by using a conventional Moore Speedisealer® pressure seal system.

The sheet (10) is preferably in continuous web form during processing by the printer 66 (see FIGURE 4), and there is the further step (see h), between steps (e) and (f) of bursting the continuous web into individual sheets (along transverse edges 15, 16).

The sheet 10 also has tractor holes 53, 55 disposed along the longitudinal edges thereof during feeding through the printer, and therefore step (e) is practiced by feeding the sheet through the printer 66 using the tractor holes 53, 55, and there

is the further step (i), after step (e) of slitting the sheet 10 adjacent the longitudinal edges 13, 14 to remove the tractor hole containing portions 52, 54.

Step (d) is practiced by forming the first transverse pattern 28 so that it is on the first face 11 and spaced about 5/16 inch from the leading transverse edge 15 of the sheet 10, prior to bursting, and by forming the second transverse pattern 44 so that it is on the second face 12 and spaced about 5/16 inch from the trailing transverse edge 16 of that sheet prior to bursting.

It will thus be seen that according to the present invention an improved method of forming a mailer type business form from a sheet of paper using an IBM 3800 printer has been provided, as well as a mailer produced according to that method.

While the invention has been herein shown and described in what is presently conceived to be the most practical and preferred embodiment, it will be apparent to those of ordinary skill in the art that many modifications may be made thereof within the scope of the invention, which scope is to be accorded the broadest interpretation of the appended claims so as to encompass all equivalent methods and structures.

What is claimed is:

1. A mailer type business form processed by a printer having rollers, and operated to occasionally pause, the mailer comprising:

a folded paper sheet having first and second faces, first and second opposite longitudinal edges, and first and second transverse fold lines defining first, second and third sections of said sheet;

first and second longitudinal lines of weakness forming with said longitudinal edges first and second longitudinal marginal portions;

a first transverse edge and a second transverse edge, both parallel to said first and second fold lines;

longitudinal patterns of adhesive disposed in said longitudinal marginal portions for holding said marginal portions of said first through third sections together;

a first transverse pattern of adhesive disposed adjacent said first transverse edge on said first face and first section; and

said first transverse pattern of adhesive being spaced from its associated transverse edge a distance sufficient to insure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer.

2. A mailer as recited in claim 1 wherein said longitudinal patterns of adhesive comprise first and second longitudinal patterns formed in said first and second sections in said marginal patterns on said first face; and third and fourth longitudinal patterns formed in said second and third sections in said marginal patterns on said second face; said first through fourth patterns disposed so that at no point do said marginal portions have a double thickness of adhesive.

3. A mailer as recited in claim 1 wherein said first transverse pattern of adhesive is spaced from its associated transverse edge a distance of about 5/16 inch.

4. A mailer as recited in claim 1 further comprising a second transverse pattern of adhesive disposed adjacent said second transverse edge on said second face.

5. A mailer as recited in claim 4 wherein both said first and second transverse patterns are provided spaced first and second distances from said transverse edges, and wherein said distances, when said sheet is Z-folded, are each about 5/16 inches.

6. A mailer as recited in claim 5 wherein the transverse adhesive patterns are pressure sensitive adhesive, and further comprising third and fourth transverse patterns for cooperating with said first and second patterns to hold the mailer together, said third strip formed on said first face, second section, adjacent said second transverse fold line, and said fourth strip formed on said second face second section, adjacent said first transverse fold line.

7. A mailer as recited in claim 6 wherein said third and fourth transverse adhesive patterns are spaced about 5/16 inches, each from said second and first transverse fold lines, respectively.

8. A mailer as recited in claim 7 further comprising, first, second, third and fourth transverse lines of weakness adjacent to, but spaced from, said first transverse edge, said first transverse fold-line, and both sides of said second transverse fold line, and is in said first section, second section, second section, and third section, respectively; and wherein said first transverse adhesive is disposed between said first transverse edge and said first transverse line of weakness, said third transverse adhesive strip is disposed between said second fold line and said third transverse line of weakness.

9. A mailer as recited in claim 5 wherein said first and second transverse patterns of adhesive are discontinuous patterns.

10. A mailer as recited in claim 4, wherein the transverse adhesive patterns are pressure sensitive adhesive, and further

comprising third and fourth transverse patterns for cooperating with said first and second patterns to hold the mailer together, said third pattern formed on said first face, second section, adjacent said second transverse fold line, and said fourth pattern formed on said second face second section, adjacent said first transverse fold line.

11. A mailer as recited in claim 10 wherein said third and fourth transverse adhesive patterns are spaced about 5/16 inches, each from said second and first transverse fold lines, respectively.

12. A mailer as recited in claim 11 further comprising, first, second, third and fourth transverse lines of weakness adjacent to, but spaced from, said first transverse edge, said first transverse fold line, and both sides of said second transverse fold line, and is in said first section, second section, second section, and third section, respectively; and wherein said first transverse adhesive is disposed between said first transverse edge and said first transverse line of weakness, said third transverse adhesive strip is disposed between said second fold line and said third transverse line of weakness.

13. A mailer type business form comprising:

a Z-folded paper sheet having first and second faces, first and second opposite longitudinal edges, and first and second transverse fold lines defining first, second and third sections of said sheet;

first and second longitudinal lines of weakness forming with said longitudinal edges first and second longitudinal marginal portions;

a first transverse edge and a second transverse edge, both parallel to said first and second fold lines;

longitudinal patterns of adhesive disposed in said longitudinal marginal portions for holding said marginal portions of said first through third sections together;

first and second transverse patterns of adhesive disposed adjacent said first and second transverse edges on said first face and first section, and second face and third section, respectively; and

said first and second transverse patterns of adhesive each being spaced from said first and second transverse edges, respectively, about 5/16 inches.

14. A mailer as recited in claim 13 wherein said first and second transverse patterns of adhesives are discontinuous patterns.

15. A mailer as recited in claim 14 wherein the transverse adhesive patterns are pressure sensitive adhesive, and further comprising third and fourth transverse patterns for cooperating with said first and second patterns to hold the mailer together, said third pattern formed on said first face, second section, adjacent said second transverse fold line, and said fourth pattern formed on said second face second section, adjacent said first transverse fold line.

16. A mailer as recited in claim 13 wherein the transverse adhesive patterns are pressure sensitive adhesive, and further comprising third and fourth transverse patterns for cooperating with said first and second patterns to hold the mailer together, said third pattern formed on said first face, second section, adjacent said second transverse fold line, and said fourth pattern formed on said second face second section, adjacent said first transverse fold line.

* * * * *

APPENDIX R

Leo Lombardo
Serial No. 07/824,408

* * * * *

REMARKS

Enclosed herewith is page 7 of the specification as well as applicant's postcard receipt indicating that all pages of the specification were submitted to the PTO. Also, the change to page 6 of the specification requested has been made.

By the present amendment the claims have also been revised to take care of all points raised in the 35 U.S.C. §112 rejections. All of the necessary changes have been made so that the claims should be clearly definite. Perhaps the only item that may be remaining relates to the objection "based upon different printers having different configurations; therefore, the spacing of the adhesive cannot be determined." It is respectfully pointed out that regardless of the fact that different printers have different spacings, the invention is entitled to a scope that covers all such printers. The fact that a claim is broad does not mean that it is vague or indefinite or incomplete. As provided by MPEP 706.03(d), second paragraph, claims in cases such as this may be drafted as broadly as allowed by the prior art. Here, there is nothing in the prior art to suggest a transverse pattern of adhesive being spaced from its associated transverse edge a distance sufficient to ensure that the adhesive does not interfere with rollers of a printer. This definition by result is inherently proper within the purview of 35 U.S.C. §112. In this regard, attention is directed to *In re Halleck*, 164 USPQ 647, 649 (CCPA 1970):

> "The claims were also rejected by the examiner as 'too broad and *** functional at the exact point of alleged novelty' because the claims failed to set out

> specifics regarding proportions of substances to be used. *We have set out above our view that the 'exact point' of novelty lies in the discovery that the agents in question stimulate growth in animals, not in the amount used other than that it be an amount effective to stimulate growth. The functional term 'an effective amount *** for growth stimulation' is not objectionable where the amount as such is not critical and its use has been approved in many cases.* See In re Caldwell, 50 CCPA 1464, 319 F. 2d 254, 138 USPQ 243 (1963)." (Emphasis added)

It is believed that all of the claims are now clearly proper within the purview of 35 U.S.C. §112, and since there has been no art rejection, early passage of the case to issue is earnestly solicited.

Submitted herewith are three (3) sheets of formal drawings, which have been corrected to add the strip indicated by reference numeral 48 in the middle of Figure 2.

Should any small matters remain outstanding, it is requested that the undersigned attorney be given a call so that such matters may be worked out and the application placed in condition for allowance without necessity of another Action and amendment.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: s/ Robert A. Vanderhye
Robert A. Vanderhye
Reg. No. 27,076

RAV: maw

Attachments

1100 North Glebe Rd.
8th Floor
Arlington, VA 22201-4714
703-816-4000

* * * * *

Serial No. 824408

Art Unit 2401

15. Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is indefinite because it is impossible to determine the distance claimed in the last paragraph. Applicant's remarks concerning this rejection have been considered. However, it is believed to be proper for the following reasons.

This rejection has been applied in accordance with *In re Hammack*, 166 USPQ 204, which states (with respect to 35 U.S.C. 112, 2nd paragraph):

> "Its purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance."

Furthermore, the fact situation in this application is different from the one in "Halleck". In "Halleck" the Court ruled that it was unnecessary to claim specific amounts of the claimed agents because the amounts are not critical. In this invention, however, the exact spacing *is* critical because adhesive which is too close to its transverse edge will cause the printer problems noted on page 1 of the specification.

The claimed invention is further distinguishable from "Halleck" in that the scope and meaning of applicant's claim relies upon the construction and sizing of an apparatus which

is not part of the invention either as claimed or as disclosed. It is unreasonable to expect those working in future enterprise (as referred to in "Hammeck") to be required to inspect all makes and models of printers to determine whether their item of manufacture infringes this claim.

Therefore, in order to be definite, this claim must recite a numerical spacing for the adhesive recited in the last paragraph.

16. Claim 2 overcomes the deficiency of claim 1.

17. In view of the newly discovered U.S. patent to Denay, the following rejection is deemed appropriate.

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claim 1 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Denay '114. To the extent that it can be determined, the embodiment illustrated in figure 10a anticipates all claimed structural features. The phrase beginning in the first line of the claim with "processed by" imparts no structural feature to the claimed mailer and does not define over Denay. Note that Denay discloses "first and second longitudinal lines of weakness" 33a and 33b which form the inner boundaries of "first and second longitudinal marginal portions". As for the last paragraph of the claim it is submitted that adhesive 34 *is* spaced as claimed.

20. Claims 2-4, 6, 7, 9, 10, 17, 20, and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Denay '114. It is submitted that Denay anticipates all claimed features, including the adhesive spacing. It is submitted that the spacing shown in the drawings, when scaled up to actual size, is at least the dimensions recited in the claims.

21. Claims 5 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is inaccurate because there is no transverse line of weakness adjacent to but spaced from the second transverse edge.

22. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

23. Claims 18 and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over the art as applied to claim 17 and further in view of either Plimpton or Ahlquist. To make Denay's adhesive patterns discontinuous, as taught by Plimpton or by Ahlquist at 7 in Figure 1 would have been obvious because it would save on adhesive.

24. Any inquiry concerning this communication should be directed to Stephen Garbe at telephone number (703) 308-1207.

s/ Stephen P. Garbe

STEPHEN P. GARBE
EXAMINER
ART UNIT 241

S. Garbe/ssh
January 07, 1993

* * * * *

REMARKS

By the present amendment the informalities pointed out in paragraph 21 on page 4 of the Action have been taken care of.

Reconsideration is respectfully requested of the rejection of claim 1 as indefinite under 35 U.S.C. 5112, second paragraph. The *In re Halleck* case cited in the amendment of November 24, 1992 (164 U.S.P.Q. 647, 649) is directly on point. Also, when the *In re Hammack,* 166 U.S.P.Q. 204, 208 (C.C.P.A. 1970) cases is considered in its entirety, it also clearly supports the definiteness of claim 1.

Claim 1 has specified as the spacing of the first transverse pattern of adhesive "a distance sufficient to insure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer." This is a functional description, providing a complete, definite and accurate statement of what the spacing should be. The fact that the spacing is not in numerical terms is irrelevant since a functional term such as this, so long as it is itself definite, is entirely appropriate. That is exactly what *In re Halleck* holds. In *Halleck*, the exact numerical amount of chemical added to the animal feed was not critical or specified, but rather the functional term "an effective amount for growth stimulation". That is the same situation here. The exact numerical spacing is not critical, and will vary from printer to printer, just as the effective amount of growth hormone in *Halleck* varied from animal to animal. The functional result of "insuring that the adhesive does not interfere with rollers ... during pausing" is entirely definite just as the "effective for growth stimulation" recitation was appropriate in *Halleck.*

In re Hammack is not inconsistent with *In re Halleck,* and supports that claim 1 is definite here. While the quote from

Hammack on page 2 of the previous action is certainly correct, and certainly is the law, in that case there was no indefiniteness because the boundaries of protection were not properly set forth, whereas they are here. It is impossible for the applicant to anticipate printers with pauses that come out on the market in the future, and measure the exact distance that is necessary for such printers with pauses in the future, but that does not mean that applicant should be denied the rights to his invention. Anyone can determine whether or not they infringe by comparing their product with the functional recitation in claim 1, which is *entirely definite*. Note that in *Hammack*, the indefiniteness rejection was upheld because the expression in the claims did not interrelate steps of the claims to an attribute in the preamble. That is, at the bottom of the first column of page 208 of *Hammack* it was stated:

> "What is equally important, the expression does not state how the 'configurations' are 'associated' with the 'points' nor make it clear how the determinations so recited are operatively related to each other or to the other steps of the claim so as to define a method which performs the function of determining the 'position of each of a number of well separated points in space,' as attributed to the method in the preamble.

That situation has no relevance here. However, the *In re Halleck* situation is directly on point.

Claim 1 is not indefinite, merely broad enough to protect applicant's real invention. Claims are not indefinite merely because broad; M.P.E.P. 706.03(d), second paragraph.

Claim 2 has been revised to correct a typographical error therein.

Reconsideration is respectfully requested of the anticipation rejection of claims in paragraphs 19 and 20 of the

previous action, applying the Denay '114 patent. It is alleged that the adhesive strip 34 in Denay is spaced as recited in at least claims 1, 2, 17 and 21. In fact, no appropriate anticipation rejection based upon Denay is possible.

The rejection is based on the allegation that the Denay strip 34 inherently corresponds to what is claimed in, for example, claims 1, 17, 21 and 2. There is absolutely no disclosure in the written portion of Denay with respect to the spacing of the element 34, from its associated edge (in fact, its associated edge is not even numbered, and the reference numeral 34 applies not just to the transverse adhesive strip, but also to the longitudinal adhesive strips). Further, Denay does recognize the proximate problem dealt with by the invention, namely out of time transfer of the forms due to the adhesive engaging the rollers during "pause" of the printer. The appropriate test for inherency has been defined by the Federal Circuit as follows:

> "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled .... [such] that *the missing ... matter is necessarily present in the ... reference*, and that it would be so recognized by persons of ordinary skill .... 'inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient ....'".

Continental Can Co. USA, Inc. v Monsanto Co., 948 F. 2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (citations omitted).

Since the alleged inherency in Denay is based solely upon the drawings, and not any verbal description, the disclosure must be even more clear in teaching necessity rather than possibility, in order to support an anticipation rejection. See

Food Machinery Corporation v Pacific Can Co., 66 F. Supp. 109, 112, wherein the Court held:

> "The Fig. 5 relied upon is an illustration of a can track in solid lines with the other side of the track shown by dotted lines which appear to run diagonally. Defendants' witnesses testified that they would interpret this drawing to show a lead, no lead can track. Plaintiff's witnesses testified that it was only a schematic drawing and too full of errors to permit any clear interpretation. The patent contains nothing in either the specification or claims to indicate that Chapman had in mind anything other than the conventional continuous spiral track, nor is the type of canway relevant to his invention. Chapman stated his object to be the provision of a 'continuous cooker in which jets of air, water or team are used to force the cans into the cooker and to discharge the cans therefrom.' The Court's language in Brill v Third Ave. R. Co., C.C. 103 F. 289, 292, 293, is pertinent: 'Mainier's invention was not designed, nor adapted, nor used for the performance of the function performed by Brill's device, nor was the way to accomplish Brill's result suggested by Manier's invention.' *If anticipation is to be found in a drawing unaided by any text, the disclosure must be clear.* Trussell Mfg. Co. v Wilson-Jones Co., 2 Cir., 50 F. 2d 1027, 1029, and cases cited therein. Chapman's Fig. 5 makes no such clear disclosure and defendants' interpretation is pure conjecture, insufficient to support the defense of anticipation."

In this case, as in *Food Machinery*, *supra*, it is clear that the alleged relationship in the rejection between the line of adhesive 34 which extends adjacent to an edge, and the unnumbered edge associated therewith, of Denay is pure

conjecture, and not based upon any words, or scientific analysis. Therefore, the anticipation rejection is entirely inappropriate.

Note that while the anticipation rejection with respect to Denay is completely inappropriate with respect to claim 1, it is even more inappropriate with respect to dependent claims, and claim 17. For example, there is absolutely no suggestion whatsoever of the 5/16 inch spacing recited in claims 2 and 17, or claims 4 and 7. In fact, no disclosure is seen whatsoever in Denay of the specific transverse adhesive patterns recited in claims 4 and 7, let alone the spacing.

Since claims 5 and 8 have not been rejected on art and since they have not been amended so that they are proper within the purview of 35 U.S.C. §112, it is believed that they are clearly allowable.

Claims 18 and 19 are allowable for the same reason that claim 17 is allowable. The Plimpton and Ahlquist references do not remedy the deficiencies of Denay as far as teaching what is recited in claim 17 is concerned, and none of Denay, Plimpton, Ahlquist are concerned with the same proximate problem as the present invention, namely, the forms jumping out of time as a result of adhesive adjacent the edges sticking to the fuser and/or backup roller of the printer as described on pages 1 and 2 of the instant application specification. Without the suggestion that they deal with the same proximate problem, or even recognize the source of the problem, there can be no obviousness. *See In re Pye*, 148 USPQ 426, 429 (CCPA 1966) wherein the Court held:

> "While, as an abstract proposition, it might be possible to select certain statements from Fikentscher and mechanically combine them with Touey to arrive at appellants' claimed combination, we find absolutely no basis for making such a combination. Neither

> reference is directed to the *problem solved by appellants' invention, namely developing* a *cleaning composition for the skin having improved lubricity characteristics*. In our view, *only appellants' specification suggests* any reason for combining the teachings of the prior art but use of such suggestion is, of course, improper under the mandate of 35 USC 103. *In re Shaffer*, 43 CCPA 758, 229 F.2d 476, 108 USPQ 326." (Emphasis added.)

In conclusion all of the claims clearly patentably distinguish from the art. Therefore, early passage of the subject application to issue is earnestly solicited.

Should any small matters remain outstanding it is requested that the undersigned attorney be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action and amendment.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: s/ Robert A. Vanderhye
Robert A. Vanderhye
Reg. No. 27,076

RAV: maw
1100 North Glebe Road
8th Floor
Arlington, Virginia 22201-4714
703-816-4000
Fax: 703-816-4100

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAME APPLICANT	ATTORNEY DOCKET NO.

EXAMINER

ART UNIT	PAPER NUMBER
	10

DATE MAILED:

NOTICE OF ALLOWABILITY

PART I.

1. ☒ This communication is responsive to *the amendment filed 4/9/93.*

2. ☐ All the claims being allowable. PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice Of Allowance And Issue Fee Due or other appropriate communication will be sent in due course.

3. ☒ The allowed claims are *1 – 10 and 17 – 22*.

4. ☐ The drawings filed on _____ are acceptable.

5. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has (__) been received, (__) not been received, (__) been filed in parent application Serial No. _____ filed on ____.

6. ☐ Note the attached Examiner's Amendment.

7. ☐ Note the attached Examiner's Interview Summary Record, PTOL-413.

8. ☐ Note the attached Examiner's Statement of Reasons for Allowance.

9. ☐ Note the attached NOTICE OF REFERENCES CITED. PTO-892.

10. ☐ Note the attached INFORMATION DISCLOSURE CITATION, PTO-1449.

PART II.

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" indicated on this form. Failure to timely comply will result in the ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

1. ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

2. ☐ APPLICANT MUST MAKE THE DRAWING CHANGES INDICATED BELOW IN THE MANNER SET FORTH ON THE REVERSE SIDE OF THIS PAPER.

a. ☐ Drawing informalities are indicated on the NOTICE RE PATENT DRAWINGS, PTO-948, attached hereto or to Paper No. _____ CORRECTION IS REQUIRED.

b. ☐ The proposal drawing correction filed on _____ Has been approved by the examiner. CORRECTION IS REQUIRED.

c. ☐ Approved drawing corrections are described by the examiner in the attached EXAMINER'S AMENDMENT. CORRECTION IS REQUIRED

d. ☐ Formal drawings are now REQUIRED.

Any response to this letter should include in the upper right hand corner, the following information from the NOTICE OF ALLOWANCE AND ISSUE FEE DUE: ISSUE BATCH NUMBER, DATE OF THE NOTICE OF ALLOWANCE, AND SERIAL NUMBER.

Attachments:

- Examiner's Amendment
- Examiner's Interview Summary Record. PTOL-413
- Reasons for Allowance
- Notice of References Cited. PTO-892
- Information Disclosure Citation. PTO-1449
- Notice of Informal Application. PTO-152
- Notice re Patent Drawings. PTO-948
- Listing of Bonded Draftsman
- Other

s/ Stephen P. Garbe
STEPHEN P. GARBE
EXAMINER
ART UNIT 241

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NIXON & VANDERHYE
8TH FLOOR
1100 NORTH GLEBE ROAD
ARLINGTON, VA 22201-4714

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

☒ Note attached communication from the Examiner
☐ This notice is issued in view of applicants communication filed _____.

SERIES CODE SERIAL NO.	07/824,408
FILING DATE	01/23/92
TOTAL CLAIMS	016
EXAMINER AND GROUP ART UNIT	GARBE, S 2401
DATE MAILED	05/07/93
First Named Applicant	LOMBARDO, LEO
TITLE OF INVENTION	PRESSURE SEAL ADHESIVE PATTERN FOR IBM 3800 PRINTERS
ATTY'S DOCKET NO.	3 268-694
CLASS-SUBCLASS	229-092,100
BATCH NO.	M90

APPLN. TYPE	UTILITY
SMALL ENTITY	NO
FEE DUE	$1170.00
DATE DUE	8/29/??

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

I. Review the SMALL ENTITY Status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the Status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or

B. If the Status is the same, apy the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

A. Pay FEE DUE shown above, or

B. File verified statement of Small Entity Status before, or with payment of ½ the FEE DUE shown above.

II. Part B of this notice should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by a charge to deposit account, Part B should be completed and returned. If you are charging the ISSUE FEE to your deposit account, Part C of this notice should also be completed and returned.

III. All communications regarding this application must give series code (or filing date) serial number and batch number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: ***Patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees.***

PATENT AND TRADEMARK OFFICE COPY

APPENDIX S

APPEAL CLOSED
JURY PROTO

U.S. District Court
Eastern District of Virginia (Alexandria)

CIVIL DOCKET FOR CASE #: 97-CV-2054

Moore U.S.A, Inc, v. Standard Register Co
Assigned to: Judge Albert V. Bryan, Jr.
Demand: $0,000
Lead Docket: None
Dkt# in other court: None

Filed: 12/22/97
Jury demand: Both
Nature of Suit: 830
Jurisdiction: Federal Question

Cause: 35:271 Patent Infringement

MOORE U.S.A., Inc.
plaintiff

Robert Arthur Vanderhye
[COR LD NTC]
Nixon & Vanderhye PC
1100 N Glebe Rd
8th Fl
Arlington, VA 22201
(703) 816-4000

v.

STANDARD REGISTER COMPANY defendant	Charles L. Gholz [COR LD NTC] Oblon, Spivak, McClelland, Maier & Neust 1755 Jefferson Davis Highway Arlington, VA 22202 (703) 413-3000

STANDARD REGISTER COMPANY counter-claimant	Charles L. Gholz [COR LD NTC] Oblon, Spivak, McClelland, Maier & Neust 1755 Jefferson Davis Highway Arlington, VA 22202 (703) 413-3000
v.	
MOORE U.S.A., INC, counter-defendant	Robert Arthur Vanderhye [COR LD NTC] Nixon & Vanderhye PC 1100 N Glebe Rd 8th Fl Arlington, VA 22201 (703) 816-4000

Docket as of May 21, 1998 4:33 p.m.

12/22/97	1	COMPLAINT Filing Fee $150.00 Receipt # 118310; jury demand (mcke) [Entry date 12/30/97]
12/22/97	--	SUMMONS (ES) (Org. & 1) issued & given to atty for service by SPS as to deft Standard Register Co (mcke) [Entry date 12/30/97]
12/22/97	--	Jury Trial Flag (mcke) [Entry date 12/30/97]
1/13/98	6	MEMORANDUM by Standard Register Co in support of [5-1] motion by Standard Register Co for Summary/Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 (Deft. filed pleading UNDER SEAL/called counsel re: no protective order in place) (ltun) [Entry date 02/18/98]
2/5/98	2	ANSWER to Complaint; jury demand and COUNTERCLAIM by Standard Register Co (Attorney Charles L. Gholz) against Moore U.S.A., Inc. (ltun) [Entry date 02/06/98]
2/10/98	3	SUMMONS Returned Executed as to Standard Register Co 1/16/98 Answer due on 2/5/98 for Standard Register Co (ltun) [Entry date 02/11/98]
2/10/98	4	Response to by Moore U.S.A., Inc. [2-2] counter claim by Standard Register Co (ltun) [Entry date 02/11/98]

2/13/98	5	MOTION by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 (ltun) [Entry date 02/18/98]
2/13/98	7	Statement of Material Facts Not in Dispute (Local Rule 56 (b)) filed by defendant Standard Register Co (pleading filed UNDER SEAL with exhibits/counsel called re: no protective order in place) (ltun) [Entry date 02/18/98]
2/13/98	8	NOTICE of Hearing: Motion Hearing set for 10:00 2/27/98 for [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 (ltun) [Entry date 02/18/98]
2/17/98	9	MOTION by Standard Register Co to Rule Two Documents in Evidence (ltun) [Entry date 02/18/98]
2/17/98	10	MEMORANDUM by Standard Register Co in support of [9-1] motion by Standard Register Co to Rule Two Documents in Evidence (ltun) [Entry date 02/18/98]
2/17/98	11	NOTICE of Hearing: Motion Hearing set for 10:00 2/27/98 for [9-1] motion by Standard Register Co to Rule Two Documents in Evidence (ltun) [Entry date 02/18/98]

2/17/98	12	MOTION by Moore U.S.A., Inc. to Strike [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 by Standard Register Co (ltun) [Entry date 02/18/98]
2/17/98	13	MEMORANDUM by Moore U.S.A., Inc. in support of [12-1] motion by Moore U.S.A., Inc. to Strike [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 by Standard Register Co (ltun) [Entry date 02/18/98]
2/17/98	14	NOTICE of Hearing: Motion Hearing set for 10:00 3/6/98 for [12-1] motion by Moore U.S.A., Inc. to Strike [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 by Standard Register Co (ltun) [Entry date 02/18/98]
2/20/98	15	MOTION by Standard Register Co for Leave to File an Amended answer (bsha) [Entry date 02/23/98]
2/20/98	16	MEMORANDUM by Standard Register Co in support of [15-1] motion by Standard Register Co for Leave to File an Amended Answer (bsha) [Entry date 02/23/98]

2/20/98	17	NOTICE of Hearing: Motion Hearing set for 10:00 2/27/98 for [15-1] motion by Standard Register Co for Leave to File and Amended Answer (bsha) [Entry date 02/23/98]
2/20/98	18	MOTION by Standard Register Co, Standard Register Co for Entry of a Protective Order (bsha) [Entry date 02/23/98]
2/20/98	19	MEMORANDUM by Standard Register Co, Standard Register Co in support of [18-1] motion by Standard Register Co, Standard Register Co for Entry of a Protective Order (bsha) [Entry date 02/23/98]
2/20/98	20	NOTICE of Hearing: Motion Hearing set for 10:00 2/27/98 for [18-1] motion by Standard Register Co, Standard Register Co for Entry of a Protective Order (bsha) [Entry date 02/23/98]
2/20/98	21	MOTION by Moore U.S.A., Inc. for Emergency Scheduling (bsha) [Entry date 02/23/98]
2/20/98	22	Reply by Standard Register Co to [21-1] motion by Moore U.S.A., Inc. for Emergency Scheduling (bsha) [Entry date 02/23/98]

2/23/98	23	ORDER that the hearing on deft Motion for SJ and Motion to Rule 2 Documents into Evidence is cont. to 3/6/98 (signed by Judge T. S. Ellis III) Copies Mailed: (jsol)
2/23/98	--	Deadline updated; Motion Hearing set for 10:00 3/6/98 for [9-1] motion by Standard Register Co to Rule Two Documents in Evidence, set for 10:00 3/6/98 for [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 (jsol)
2/24/98	24	MEMORANDUM by Standard Register Co in opposition to [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 by Standard Register Co (bsha)
2/25/98	25	MOTION by Moore U.S.A., Inc. Emergency Scheduling (clar)
2/25/98	26	First MOTION by Moore U.S.A., Inc. to Compel Discovery (clar)
2/25/98	27	MEMORANDUM by Moore U.S.A., Inc. in support of [26-1] motion by Moore U.S.A., Inc. to Compel Discovery (clar)
2/25/98	28	NOTICE of Hearing: Motion Hearing set for 10:00 3/6/98 for [26-1] motion by Moore U.S.A.., Inc. to Compel Discovery (clar)

2/26/98	29	Opposition by Moore U.S.A., Inc., to [18-1] motion by Standard Register Co, Standard Register Co for Entry of a Protective Order and [15-1] motion by Standard Register Co for Leave to File an Amended Answer (clar)
2/26/98	30	Reply Brief by Standard Register Co in support of [18-1] motion for Entry of a Protective Order and for Leave to File an Amended answer by Standard Register Co, Standard Register Co (clar) [Entry date 02/27/98]
2/27/98	--	Minute entry: Judge W. Curtis Sewell. Tape #81. Appearances; of counsel. Reporter; Casamo and assoc. Matter came on as Defts. otion for protective order-argued and granted. Defts motion for leave to file amended answer-argued and granted. Order to follow. (ntho)
2/27/98	31	ORDER granting [18-1] motion by Standard Register Co, Standard Register Co for Entry of a Protective Order, granting [15-1] motion by Standard Register Co for Leave to File an Amended Answer (signed by Magistrate Judge W. C. Sewell) Copies Mailed: y. (ntho) [Entry date 03/02/98]
2/27/98	--	**Set Protective Order Flag. (ntho) [Entry date 03/02/98]

2/27/98	32	ORDER ordering that the attached protective order be entered in this case. (signed by the Magistrate Judge W. C. Sewell) Copies Mailed: y. (ntho) [Entry date 03/02/98] [Edit date 03/25/98]
2/27/98	33	ORDER, for Protective Orderre: handeling and labeling of confidential materials (see order for details) (signed by Magistrate Judge W. C. Sewell) (ntho) [Entry date 03/02/98]
2/27/98	34	MOTION by the Reynolds and Reynolds Company to Intervene for the Limited Purposes of Inspecting papers filed Under Seal (bsha) [Entry date 03/03/98]
2/27/98	35	MEMORANDUM in support of [34-1] motion by the Reynolds and Reynolds Company to Intervene for the Limited Purposes of Inspecting papers filed Under Seal (bsha) [Entry date 03/03/98]
2/27/98	36	NOTICE of Hearing: Motion Hearing set for 10:00 3/6/98 for [34-1] motion by the Reynolds and Reynolds Company to Intervene for the Limited Purposes of Inspecting papers filed Under Seal (bsha) [Entry date 03/03/98]

2/27/98	37	RESPONSE by Moore U.S.A., Inc. in opposition to [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 by Standard Register Co (SEALED DOCUMENT) (bsha) [Entry date 03/03/98]
2/27/98	38	RESPONSE by Moore U.S.A., Inc. in opposition to [9-1] motion by Standard Register Co to Rule Two Documents in Evidence by Standard Register Co (SEALED DOCUMENT) (bsha) [Entry date 03/03/98]
3/3/98	39	RESPONSE by Moore U.S.A., Inc. in opposition to [34-1] motion by the Reynolds and Reynolds Company to Intervene for the Limited Purposes of Inspecting papers filed Under Seal (bsha)
3/3/98	40	SUPPLEMENT TO Motion to Strike standard register's motion for summary Judgment in view of the Motion to intervene filed by Reynolds and Reynolds Co. filed by plaintiff Moore U.S.A., Inc. (SEALED DOCUMENT) (bsha)
3/3/98	41	Amended Response to by Moore U.S.A., Inc. [2-2] counter claim by Standard Register Co (ltun)

3/3/98	42	REPLY by Standard Register Co to response to [9-1] motion by Standard Register Co to Rule Two Documents in Evidence by Standard Register Co (SEALED DOCUMENT) (bsha) [Entry date 03/04/98] [Edit date 03/05/98]
3/3/98	43	REPLY by Standard Register Co to response to [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent 4,918,128 by Standard Register Co (SEALED DOCUMENT) (bsha) [Entry date 03/04/98] [Edit date 03/04/98]
3/4/98	44	AMENDED ANSWER to Complaint and Counterclaims by Standard Register Co : amends [2-1] answer by Standard Register Co; jury demand (ltun) [Entry date 03/05/98]
3/4/98	45	RESPONSE by Standard Register Co in opposition to [26-1] First motion by Moore U.S.A., Inc., to Compel Discovery by Moore U.S.A., Inc. (bsha) [Entry date 03/05/98]
3/5/98	46	REQUEST by Moore U.S.A., Inc. for Leave to File Sur-Reply and Included Sur-Reply (bsha)

3/5/98	47	REPLY by Moore U.S.A., Inc. to response to [26-1] motion by Moore U.S.A, Inc. to Compel Discovery by Moore U.S.A., Inc. (SEALED DOCUMENT) (bsha) [Entry date 03/06/98]
3/6/98	--	Minute entry: Judge Buchanan. Rpt. : Casamo. Apr. : counsel. Matter came on for pltf's first motion to compel - argued & denied w/o prejudice. Order to be entered. (lbac) [Entry date 03/09/98]
3/6/98	48	ORDER denying [26-1] motion by Moore U.S.A., Inc. to Compel Discovery. If deft's motion to dismiss regarding the '128 patent is denied, deft shall produce disc. responses regarding the '128 patent w/in (11) days of entry of order denying the motion to dismiss. (signed by Magistrate Judge Theresa C. Buchanan) Copies Mailed: yes (lbac) [Entry date 03/09/98]

3/6/98	49	ORDER granting [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128, granting [9-1] motion by Standard Register Co to Rule Two Documents in Evidence, denying [12-1] motion by Moore U.S.A., Inc. to Strike [5-1] motion by Standard Register Co for Summary Judgment that Pltf. Lacks Standing to Sue on U.S. Patent No. 4,918,128 by Standard Register Co - ent. & filed (signed by Judge Albert V. Bryan Jr.) Copies Mailed: yes (UNDER SEAL) (ltun) [Entry date 03/10/98]
3/6/98	50	ORDER denying [34-1] motion by the Reynolds and Reynolds Company to Intervene for the Limited Purposes of Inspecting papers filed Under Seal (see order for details) - ent. & filed (signed by Judge Albert V. Bryan Jr.) Copies Mailed: yes (ltun) [Entry date 03/10/98]
3/6/98	51	MOTION by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no.5,253,798 (bsha) [Entry date 03/11/98]

3/6/98	52	MEMORANDUM by Standard Register Co in support of [51-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,253,798 by Standard Register Co (EXHIBIT 3 FILED UNDER SEAL - ONLY) (bsha) [Entry date 03/11/98]
3/6/98	53	NOTICE of Hearing: Motion Hearing set for 10:00 3/20/98 for [51-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,253,798 (bsha) [Entry date 03/11/98]
3/6/98	54	MOTION by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,314,110 (bsha) [Entry date 03/11/98]
3/6/98	55	MEMORANDUM by Standard Register Co in support of [54-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,314,110 by Standard Register Co (EXHIBIT 3 FILED UNDER SEAL - ONLY) (bsha) [Entry date 03/11/98]
3/6/98	56	NOTICE of Hearing: Motion Hearing set for 10:00 3/20/98 for [54-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,314,110 (bsha) [Entry date 03/11/98]

3/13/98	57	SECOND MOTION with Memorandum in Support by Moore U.S.A., Inc. by Moore U.S.A., Inc. to Compel Discovery (SEALED DOCUMENT) (bsha) [Entry date 03/16/98]
3/13/98	58	NOTICE of Hearing: Motion Hearing set for 10:00 3/20/98 for [57-1] Second motion by Moore U.S.A., Inc. to Compel Discovery (bsha) [Entry date 03/16/98]
3/17/98	59	RESPONSE by Moore U.S.A., Inc. in opposition to [54-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,314,110 by Standard Register Co (bsha)
3/17/98	60	RESPONSE by Moore U.S.A., Inc. in opposition to [51-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,253,798 by Standard Register Co (bsha)
3/18/98	61	Opposition by Standard Register Co to [57-1] motion by Moore U.S.A., Inc to Compel Discovery (clar)
3/19/98	62	Reply Brief by Standard Register Co in support of [54-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,314,110 (clar) [Entry date 03/20/98]

3/19/98	63	Reply Brief by Standard Register Co in support of [51-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,253,798 (clar) [Entry date 03/20/98]
3/19/98	64	REPLY by Moore U.S.A., Inc. to response to [57-1] Second motion by Moore U.S.A., Inc. to Compel Discovery (clar) [Entry date 03/20/98]
3/19/98	65	Supplement by Moore U.S.A., Inc. to Opposition to [51-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,253,798 (clar) [Entry date 03/20/98]
3/19/98	66	Supplement by Moore U.S.A., Inc. in opposition to [54-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,314,110 (clar) [Entry date 03/20/98]
3/20/98	--	Minute entry: Magistrate Judge Poretz. Reporter: Casamo & Assoc. Appearances: Counsel for Pltf. & Deft. This matter came on for Pltf's. second Motion to Compel Discovery - Matter argued and taken under advisement. (jsch)
3/20/98	67	MOTION by Standard Register Co for Summary Judgment of Non-Infringement of U.S. Patent No. 5,201,464 (clar) [Entry date 03/23/98]

3/20/98	68	MEMORANDUM by Standard Register Co in support of [67-1] motion by Standard Register Co for Summary Judgment of Non-Infringement of U.S. Patent No 5,201,464 filed tog. w/Exhibits (Large Pleading) (clar) [Entry date 03/23/98]
3/20/98	69	NOTICE of Hearing: Motion Hearing set for 10:00 4/3/98 for [67-1] motion by Standard Register Co for Summary Judgment of Non-Infringement of U.S. Patent No. 5,201,464 (clar) [Entry date 03/23/98]
3/20/98	70	ORDER granting [51-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,253,798, granting [54-1] motion by Standard Register Co for Summary Judgment of non-infringement of U.S. Patent no. 5,314,110 (see order for details) - ent. & filed (signed by Judge Albert V. Bryan Jr.) Copies Mailed: yes (ltun) [Entry date 03/25/98]
3/24/98	71	Memorandum by Moore U.S.A., Inc. to Judge Poretz Regarding Doctrine of Equivalents and Moore's Second Motion to Compel Discovery (sent to BRP) (klau) [Entry date 03/25/98]

3/26/98	72	MEMORANDUM to Magistrate Judge Poretz Regarding the opposition to Moore U.S.A., Inc.'s Second Motion to Compel Discovery by defendant Standard Register Co (bsha) [Entry date 03/27/98]
3/31/98	73	ORDER denying [57-1] motion by Moore U.S.A., Inc.. to Compel Discovery - ent. & filed (signed by Magistrate Judge Barry R. Poretz) Copies Mailed: yes (ltun)
3/31/98	74	RESPONSE by Moore U.S.A., Inc. in opposition to [67-1] motion by Standard Register Co for Summary Judgment of Non-Infringement of U.S. Patent No. 5,201,464 by Standard Register Co (bsha) [Entry date 04/01/98]
3/31/98	75	MOTION with Memorandum in Support by Moore U.S.A., Inc. by Moore U.S.A., Inc. to Amend to Complaint (bsha) [Entry date 04/01/98]
3/31/98	76	NOTICE of Hearing: Motion Hearing set for 10:00 4/10/98 for [75-1] motion by Moore U.S.A., Inc. to Amend to Complaint (bsha) [Entry date 04/01/98]

4/2/98	77	REPLY MEMORANDUM in support by Standard Register Co of [67-1] motion by Standard Register Co for Summary Judgment of Non-Infringement of U.S. Patent No. 5,201,464 by Standard Register Co (bsha) [Entry date 04/03/98]
4/3/98	79	ORDER granting in part, denying in part [67-1] motion by Standard Register Co for Summary Judgment of Non-Infringement of U.S. Patent No. 5,201,464. Accordingly, defendant's motion for summary judgment is denied with regard to plaintiff's claims for infringement under the doctrine of equivalents. See order for details. (signed by Judge Albert V. Bryan Jr.) Copies Mailed: yes (tthu) [Entry date 04/06/98]
4/6/98	78	RESPONSE by Standard Register Co to [75-1] motion by Moore U.S.A., Inc. to Amend to Complaint by Moore U.S.A., Inc. (bsha)
4/6/98	78	REQUEST by Standard Register Co for Sanctions (Filed w/opposition to pltf's motion to amend) (bsha)
4/6/98	80	SCHEDULING ORDER setting Discovery cutoff 7/31/98 ; Pretrial Conference for 1:20 8/20/98 ; (signed by Judge Claude M. Hilton) Copies Mailed: yes (ltun) [Entry date 04/07/98]

4/7/98	81	REPLY by Moore U.S.A, Inc. to opposition to [75-1] motion by Moore U.S.A., Inc. to Amend to Complaint by Moore U.S.A., Inc. (bsha) [Entry date 04/08/98]
4/10/98	82	MOTION by Standard Register Co for Reconsideration of [79-1] order dated 4/3/98 (bsha) [Entry date 04/13/98]
4/10/98	83	MEMORANDUM by Standard Register Co in support of [82-1] motion by Standard Register Co for Reconsideration of [79-1] order dated 4/3/98 by Standard Register Co (bsha) [Entry date 04/13/98]
4/10/98	84	NOTICE of Hearing: Motion Hearing set for 10:00 4/17/98 for [82-1] motion by Standard Register Co for Reconsideration of [79-1] order dated 4/3/98 (bsha) [Entry date 04/13/98]
4/10/98	--	Minute entry: Magistrate Judge Jones. Reporter: Rudiger & Green. Appearances: Counsel for Pltf. & Deft. This matter came on for Pltf's. Motion to amend complaint - Matter argued and Granted. Order to be entered. (jsch) [Entry date 04/15/98]

4/10/98	85	ORDERED, that the plaintiff's motion for leave to file an amended complaint is granted, and the amended complaint will be filed this date (signed by Magistrate Judge Thomas R. Jones Jr.) Copies Mailed: y (jsch) [Entry date 04/15/98]
4/10/98	88	AMENDED COMPLAINT by Moore U.S.A., Inc. amending [1-1] complaint ;; jury demand (mcke) [Entry date 04/20/98]
4/15/98	86	RESPONSE by Moore U.S.A., Inc. in opposition to [82-1] motion by Standard Register Co for Reconsideration of [79-1] order dated 4/3/98 by Standard Register Co (bsha)
4/16/98	87	REPLY by Standard Register Co to opposition to [82-1] motion by Standard Register Co for Reconsideration of [79-1] order dated 4/3/98 by Standard Register Co (bsha) [Entry date 04/17/98]
4/17/98	89	MEMORANDUM OPINION - filed (signed by Judge Albert V. Bryan Jr.) Copies Mailed: yes (mcke) [Entry date 04/20/98]

4/17/98	90	ORDER granting [82-1] motion by Standard Register Co for Reconsideration of [79-1] order dated 4/3/98, and this action is hereby dismissed with prejudice - ent & filed (signed by Judge Albert V. Bryan Jr.) Copies Mailed: yes (mcke) [Entry date 04/20/98]
4/17/98	--	Case closed (mcke) [Entry date 04/20/98]
4/17/98	--	CASE assigned to Judge Albert V. Bryan Jr. (mcke) [Entry date 04/20/98]
4/20/98	91	TRANSCRIPT for dates of 4-10-98 before Mag. Judge Jones (rwar) [Entry date 04/23/98]
5/1/98	92	MOTION by Standard Register Co to have this case declared an exceptional case within the meaning of 35 USC sec 285 (bsha) [Entry date 05/04/98]
5/1/98	93	MEMORANDUM by Standard Register Co in support of [92-1] motion by Standard Register Co to have this case declared an exceptional case within the meaning of 35 USC sec 285 by Standard Register Co (SEALED DOCUMENT) (bsha) [Entry date 05/04/98] [Edit date 05/05/98]

5/1/98	94	NOTICE of Hearing: Motion Hearing set for 10:00 5/8/98 for [92-1] motion by Standard Register Co to have this case declared an exceptional case within the meaning of 35 USC sec 285 (bsha) [Entry date 05/04/98]
5/1/98	95	MOTION by Standard Register Co for excess costs, expenses and Attorney Fees under 28 USC Sec. 1927 (bsha) [Entry date 05/04/98]
5/1/98	96	MEMORANDUM by Standard Register Co in support of [95-1] motion by Standard Register Co for excess costs, expenses and Attorney Fees under 28 USC Sec. 1927 by Standard Register Co (SEALED DOCUMENT) (bsha) [Entry date 05/04/98]
5/1/98	97	NOTICE of Hearing: Motion Hearing set for 10:00 5/8/98 for [95-1] motion by Standard Register Co for excess costs, expenses and Attorney Fees under 28 USC Sec. 1927 (bsha) [Entry date 05/04/98]
5/1/98	98	Bill of costs in the amount of $9,504.11 filed by Standard Register Co (clar) [Entry date 05/05/98]
5/1/98	99	MEMORANDUM by Standard Register Co in support of [98-1] Bill of Costs (clar) [Entry date 05/05/98]

5/6/98	100	RESPONSE by Moore U.S.A., Inc. in opposition to [98-1] bill of costs, [95-1] motion by Standard Register Co for excess costs, expenses and Attorney Fees under 28 USC Sec. 1927 by Standard Register Co, [92-1] motion by Standard Register Co to have this case declared an exceptional case within the meaning of 35 USC sec 285 by Standard Register Co (SEALED DOCUMENT) (bsha)
5/7/98	101	CONSOLIDATED REPLY by Standard Register Co to response to [95-1] motion by Standard Register Co for excess costs, expenses and Attorney Fees under 28 USC Sec. 1927 by Standard Register Co, [92-1] motion by Standard Register Co to have this case declared an exceptional case within the meaning of 35 USC see 285 by Standard Register Co (Sealed Document) (bsha) [Entry date 05/08/98]
5/8/98	102	ORDER denying [95-1] motion by Standard Register Co for excess costs, expenses and Attorney Fees under 28 USC Sec. 1927, denying [92-1] motion by Standard Register Co to have this case declared an exceptional case within the meaning of 35 USC sec 285 (see order for details) - ent. & filed. (signed by Judge Albert V. Bryan Jr.) Copies Mailed: yes (clar) [Edit date 05/11/98]

5/14/98	103	NOTICE OF APPEAL of Orders of 3/6/98, 3/20/98, 4/3/98 & 4/17/98 by Moore U.S.A., Inc. FILING FEE $105.00 RECEIPT # 100 121234 Copies sent to Moore U.S.A., Inc., Standard Register Co, Copy of Notice, Order and docket sheet sent to USCA Federal Circuit (clar) [Entry date 05/20/98]
5/19/98	104	NOTICE OF CROSS APPEAL of Order 4/17/98 by Standard Register Co. FILING FEE $105.00 RECEIPT # 100 121343 Copies sent to Moore U.S.A., Inc., Standard Register Co; Copy of notice; order and docket sheet sent to USCA Federal Circuit. (ltun) [Entry date 05/21/98]

APPENDIX T

Appeal Nos. 98-1386 and 98-1387

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

MOORE U.S.A., INC.,
Plaintiff-Appellant,

v.

STANDARD REGISTER COMPANY,
Defendant-Cross Appellant.

Motion of Plaintiff-Appellant Moore U.S.A., Inc., Now Known as Moore North America, Inc., For Leave To Include Additional Material in the Appendix Under Seal

NON-CONFIDENTIAL

Robert A. Rowan
James D. Berquist
NIXON & VANDERHYE P.C.
1100 North Glebe Road
8th Floor
Arlington, Virginia 22201
(703) 816-4000

Attorneys for Plaintiff-Appellant
MOORE NORTH AMERICA, INC.
FORMERLY KNOWN AS MOORE U.S.A., INC.

I. GROUNDS FOR MOTION, RELIEF SOUGHT AND ARGUMENT

On September 22, 2000, this Court ruled on Moore U.S.A., Inc.'s ("Moore")[1] appeal of the summary judgment decisions of the United States District for the Eastern District of Virginia, affirming, *inter alia*, the District Court's denial of discovery under Fed. R. Civ. P. 56(f) and the District Court's finding that defendant-cross appellant Standard Register Company ("SRC") did not infringe Moore's U.S. Patent No. 5,253,798 ("the '798 patent"). Moore is concurrently filing with this Court its Petition For Rehearing And Suggestion For Rehearing *En Banc* as to the Court's rulings with respect to the '798 patent, as well as its holding regarding non-infringement of Moore's U.S. Patent No. 5,201,464. In connection with that petition, Moore also requests leave to include the documents attached at Tab A as part of the Appendix in this appeal, albeit under seal.[2]

In reaching its determination of non-infringement of the '798 patent, this Court (encouraged to do so by SRC's brief and accompanying Mudry Declaration, (SRC Br. at 6, Appendix at 71 ¶5)) looked exclusively to the dimensions of the IBM 3800 printer, assuming, at least implicitly, that this was the only printer relevant to the infringement analysis, and noting that it was Moore's burden of proof to have established otherwise. September 22 Opinion ("Op.") at 36. However, Moore was prevented from meeting that burden, despite its virtually immediate service of written discovery requests because the Eastern District of Virginia, despite

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[1] Moore U.S.A., Inc. has changed its corporate name to Moore North America, Inc.

[2] The documents attached at Tab A have been designated "highly confidential" by SRC pursuant to the Protective Order in the action pending in the Western District of New York. (*See* Tab B). Pursuant to Federal Circuit Rule 28(d), Moore is filing confidential and non-confidential versions of this Motion.

Moore's protest and Fed. R. Civ. P. 56(f) motion to defer ruling until meaningful discovery could be completed, granted summary judgment of non-infringement less than two months after service of Moore's Complaint and before SRC had produced a single document to Moore or any party had taken a single deposition. Op. 44. Accordingly, Moore was effectively deprived, by the actions of the District Court and SRC, of the very documents which this Court asserts should have been submitted into evidence. Only by way of later formal discovery in a parallel litigation between the parties in the Western District of New York[3] were such previously withheld documents discovered.

Those documents, first available to Moore only after the district court's summary adjudication, conclusively show that key factual assumptions of this Court were erroneous. Specifically, these internal SRC documents affirmatively show that SRC's pressure seal forms had been tested and "qualified" by SRC for use with over 30 other printers and that SRC's "Chase" mailer, which was the specific subject of SRC's Mudry Declaration is actually used with two non-IBM printers. (*See* Tab A at A836, A850-51). These documents, which date back to November 11, 1994, were clearly in existence at the time of the District Court's grant of SRC's motion for summary judgment, but were not produced to Moore in the Virginia case. Moreover, as internal SRC documents, they obviously were not available to Moore without formal discovery, which was denied to Moore in this case, despite Moore's timely Rule 56(f) motion.

As held in *Dakota Industries, Inc. v. Dakota Sportswear, Inc.*, 988 F.2d 61 (8th Cir. 1993) (cited in this Court's September 22 Opinion at p. 46), an appellate court may, despite the general rule against considering evidence not

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[3] Moore North America v. Standard Register Company, W.D.N.Y., Civ No. 1:98-00485.

contained in the record below, order the record enlarged "[w]hen the interests of justice demand it." *Id.* at 63. The Court explained:

> We are faced with a situation in which misrepresentation, willful or otherwise, left the district court with an incomplete picture of the infringement alleged by Industries. Perhaps we would apply a different analysis if this information had come to light after a full trial....However, this case is far different....Discovery has not yet been completed, and there has been no trial on the merits. Further, we are left with the impression that Sportswear has been less than forthcoming with the court.
>
> Sportswear prevented the court from fully and fairly deciding whether a preliminary injunction should be issued. Industries, therefore, cannot be charged with neglect for failing to bring Sportswear's multiple Dakota marks to the attention of the district court. If an appellate court could never consider new evidence in such cases, parties would have a distinct incentive to deceive the district courts, and the appellate courts would be powerless to remedy such deceptions.

Id. at 63-64.

As described above and in its Petition For Rehearing, Moore was clearly prejudiced by of the District Court's denial of discovery under Rule 56(f), which prevented Moore from discovering and using pivotal evidence before the District Court and this Court. Accordingly, Moore, by this motion, respectfully asks this Court to consider the newly discovered evidence of SRC's testing and

"qualification" of over 30 different printer models for use with its pressure seal forms and SRC's manufacture, use and sale of the accused "Chase" forms with printers other than the IBM 3800, as part of the Appendix in this appeal.

It is respectfully submitted that "the interests of justice demand" that the record be enlarged in this case, since the attached documents, which were at all times in SRC's possession, conclusively show that the factual assumptions of this Court were not only inaccurate, but that Moore would easily have been able to demonstrate that fact had its timely Rule 56(f) motion not been improperly denied by the District Court.

II. STATEMENT OF CONSENT OR OPPOSITION TO THE MOTION

SRC has agreed to Moore's use of the attached documents for the purposes of Moore's concurrently filed Petition For Rehearing And Suggestion For Rehearing *En Banc*. (*See* Tab C).

Respectfully submitted,

MOORE NORTH AMERICA, INC.,
FORMERLY KNOWN AS
MOORE U.S.A., INC.
by its Attorneys

s/ Robert A. Rowan

Robert A. Rowan
NIXON & VANDERHYE P.C.
1100 North Glebe Road
8th Floor
Arlington, Virginia 22201
(703) 816-4000

CERTIFICATE OF INTEREST

Counsel for the plaintiff-appellant MOORE U.S.A., INC. hereby certifies the following:

1. The full name of every party or amicus represented by me was MOORE U.S.A., INC. at the time this appeal was made.

2. The full name of every party or amicus represented by me has changed to MOORE NORTH AMERICA, INC.

3. The name of the real party in interest represented by me was MOORE U.S.A., INC. at the time this appeal was made.

4. The name of the real party in interest represented by me has been changed to MOORE NORTH AMERICA, INC.

5. Moore's parent corporation is MOORE CORPORATION, LTD., whose stock is publicly traded on the New York Stock Exchange.

6. The names of all law firms and attorneys of those law firms that appeared for the party now represented by me in the lower Court or are expected to appear in this Court are: Robert A. Vanderhye, Robert A. Rowan, and James D. Berquist of NIXON & VANDERHYE P.C., Arlington, Virginia.

PROOF OF SERVICE

I hereby certify that on the 6th day of October, 2000, two true and correct copies of the foregoing MOTION FOR LEAVE TO INCLUDE ADDITIONAL MATERIAL IN THE APPENDIX UNDER SEAL (NON-CONFIDENTIAL) were served by Federal Express on Charles L. Gholz, OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C., Fourth Floor, 1755 Jefferson Davis Highway, Arlington, Virginia 22202.

s/ Jonathon T. Reavill
Jonathon T. Reavill

NOTE: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public order.

Appeal Nos. 98-1386 and 98-1387

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

MOORE U.S.A., INC.,
Plaintiff-Appellant,

v.

STANDARD REGISTER COMPANY,
Defendant-Cross Appellant.

Motion of Plaintiff-Appellant Moore U.S.A., Inc., Now Known as Moore North America, Inc., For Leave To Include Additional Material in the Appendix Under Seal

NON-CONFIDENTIAL

Robert A. Rowan
James D. Berquist
NIXON & VANDERHYE P.C.
1100 North Glebe Road
8th Floor
Arlington, Virginia 22201
(703) 816-4000

Attorneys for Plaintiff-Appellant
MOORE NORTH AMERICA, INC.
FORMERLY KNOWN AS MOORE U.S.A., INC.

FILED
OCT 6 2000
JAN HORBALY
CLERK

LEAVE TO FILE IS GRANTED.

OCT 25 2000
Date

FOR THE COURT,

s/ Jan Horbaly

Supreme Court, U.S.
FILED
MAR 26 2001
OFFICE OF THE CLERK

No. 00-1346

IN THE
SUPREME COURT OF THE UNITED STATES

MOORE NORTH AMERICA, INC.,

Petitioner,

v.

THE STANDARD REGISTER COMPANY,

Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals for the Federal Circuit

---

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Charles L. Gholz, Esq.
(Counsel of Record)
William T. Enos, Esq.
Andrew M. Ollis, Esq.
Robert C. Nissen, Esq.
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1755 Jefferson Davis Highway, 4th Floor
Arlington, Virginia 22202
Tel. No.: (703) 413-3000
Attorneys for Respondent
The Standard Register Company

QUESTIONS PRESENTED

Question 1: Whether it is inappropriate for a patentee to use the doctrine of equivalents to read meaningful limitations completely out of patent claims, such that the public — relying on the statutory notice requirement for claims — could be ensnared in an infringement trap.

Question 2: Whether an issue that the petitioner found unimportant in its appeal (it devoted exactly **one** conclusory sentence to it in its appeal brief below) is now sufficiently compelling to serve as the basis for the Court to grant *certiorari*.

LIST OF PARTIES PURSUANT TO RULES 14.1(b) AND 29.6

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief in Opposition to Petition for Writ of Certiorari.

Respondent The Standard Register Company ("SRC") is not owned by a parent corporation, nor does any public company own at least 10% of SRC.

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BRIEF IN OPPOSITION

Respondent, The Standard Register Company ("SRC"), respectfully submits this Brief in Opposition to the Petition for a Writ of Certiorari of Moore North America, Inc. ("Moore").

Moore petitions the Court to overturn a panel decision of the United States Court of Appeals for the Federal Circuit.[1] The panel affirmed a determination by the United States District Court of the Eastern District of Virginia that there was no infringement of United States Patent Nos. 5,201,464 ("the '464 patent") and 5,253,798 ("the '798 patent").[2] The Federal Circuit subsequently denied Moore's petition for rehearing and suggestion for rehearing *en banc*.

STATEMENT OF THE CASE

Respondent disagrees with the Statement of the Case set out by petitioner and hereby submits its Statement in Opposition.

On December 22, 1997, Moore sued SRC, alleging infringement of four United States patents — the '464 patent, the '798 patent, and two other patents which are not before the Court.[3] The two patents at issue in Moore's *certiorari* petition

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[1] Judge Newman concurred in part and dissented in part.

[2] The entire panel agreed that there was no infringement of the '798 patent and claim 1 of the '464 patent, but for different reasons. Judge Newman dissented from the majority holding regarding claims 9, 16, 17, and 19 of the '464 patent.

[3] The Federal Circuit unanimously held that SRC did not infringe U.S. Patent 5,314,110. Moore has not sought review of that

concern the folding patterns, including adhesive placement, on what are known as "business mailer forms," such as those used for the W-2 and 1099 statements mailed to taxpayers.

With respect to the patents at issue, Moore eventually conceded that there was no literal infringement. However, attempting to rewrite history and eliminate meaningful structural limitations from its claims, Moore argued that there was infringement of each under the doctrine of equivalents.

The structure of the accused products was undisputed. Accordingly, because there were no factual disputes concerning any of the accused products, SRC moved for summary judgment of non-infringement as to each patent. Before SRC's summary judgment motions were fully briefed, Moore's counsel spent several days inspecting SRC's documents and selecting those documents he thought important enough to have copied.[4]

On March 20, 1998, the district court, after considering Moore's opposition papers, granted summary judgment of non-infringement of the '798 patent. The district court considered, but rejected, the conclusory declarations by Moore's counsel

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decision. The district court granted summary judgment to SRC on U.S. Patent 4,918,128. Moore did not appeal that decision.

[4] Moore complains that SRC subsequently did not provide it with the documents. Pet. at 19 n.15. That statement is an example of how Moore has been reduced to distorting the record in an attempt to manufacture a cert-worthy question. What Moore fails to tell the Court is that it specifically asked SRC to **not** supply it with those documents as a cost-saving measure. Letter from Vanderhye to Enos, March 25, 1998 (Appendix A). This request came before the district court granted summary judgment on the '464 patent on April 17, 1998.

which simply stated that additional discovery was required; the court found that no "specific expected disclosures that could alter the court's conclusions and findings" were offered. Pet. App. at 79a.

On April 17, 1998, after a motion for reconsideration was submitted by SRC, the district court granted summary judgment of non-infringement of the '464 patent. It found that to permit Moore to use the doctrine of equivalents with respect to claim 1 of the '464 patent would "remove entirely 'the majority of lengths limitation' from the claim." Pet. App. at 63a. The district court also recognized that the remaining independent claims of the '464 patent (9, 16, 17, and 19) contain at least ***three*** distinct limitations which "***admittedly do not exist*** in defendant SRC's accused form." *Id.* at 64a (emphasis added). The district court refused to permit Moore to use the doctrine of equivalents to entirely eliminate these three additional structural limitations from the claim. *Id.*

On Moore's appeal, the Federal Circuit fully considered, but rejected, Moore's contentions. In rejecting Moore's contention regarding claim 1 of the '464 patent, the panel correctly followed the Court's teaching that "the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole." Pet. App. at 27a (*quoting Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997)). The panel also enunciated another reason for affirming the finding of non-infringement of claim 1 — namely, that a strip of adhesive that has a length equal to 99% of the length of another strip is not "substantially less" in length than that other strip.[5] Pet. App. 29a n.1. This

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[5] Thus, even were *certiorari* to be granted here and the decision of the Federal Circuit vacated with respect to claim 1 of the '464

was the reason why Judge Newman concurred in the finding of non-infringement of claim 1. Pet. App. 56a.

As to claim 9, the majority relied on the Court's guidance in *Warner-Jenkinson* to determine that Moore was attempting to violate the All Elements Rule. Pet. App. 32a, citing *Warner-Jenkinson*, 520 U.S. at 29-30. Moreover, the majority expressly ***adopted*** Moore's arguments concerning *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929) but, based on the undisputed facts of the case, still found there to be no infringement.

SUMMARY OF ARGUMENT

Appeals from the circuit courts of appeal are heard by the Court ***only*** for compelling reasons. *See* Sup. Ct. R. 10. This fact-specific case presents no such compelling reason. Petitioner's questions for review present hypothetical issues and lack factual foundation. Petitioner's argument, devoid of the rhetoric, is that the Federal Circuit panel incorrectly applied the correct law. When petitioner's questions are properly recast in the form of respondent's questions for review, the answers become obvious. To the first question, the answer is yes: it is, as the Federal Circuit held, inappropriate for a patentee to use the doctrine of equivalents to completely read meaningful limitations out of patent claims. The answer to the second question is no: an issue that the petitioner found so unimportant in its appeal that it devoted exactly **one** conclusory sentence to it is not sufficiently compelling for the Court to grant *certiorari*.

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patent, it would be an exercise in futility because the Federal Circuit would just reaffirm based upon this alternative basis.

ARGUMENT

I. THERE IS NO CONFLICT BETWEEN THE COURT'S PRECEDENT AND THE DECISION OF THE FEDERAL CIRCUIT.

The Federal Circuit panel looked to the Court's opinion in *Warner-Jenkinson* for guidance in deciding the present case. It did precisely what it was supposed to do and, indeed, had been instructed by the Court to do. Now attempting to create the illusion of a lower court run amok, Moore parses threads of language from various opinions of the Court and then weaves those threads into a tapestry of woe. Moore's fundamental problem, though, is that, when the tapestry is held up to the light of objective examination, it unravels.

The Federal Circuit did not "speak the death of the doctrine of equivalents" in this case. Nor is the patent system itself in jeopardy, despite Moore's protestation to the contrary. This is a simple case, with simple and undisputed facts and clearly applicable law. All that was done here was that the lower court interpreted the claims, as a matter of law, and compared those claims to the accused products. Noting that petitioner had acknowledged that literal infringement did not exist, the panel then reviewed infringement under the doctrine of equivalents.

In every instance, the Federal Circuit found that petitioner was attempting to use the doctrine to entirely vitiate claim limitations. The panel looked to the Court's recent precedent concerning the doctrine of equivalents and heeded the Court's warning that patentees cannot use the doctrine of equivalents to vitiate a claim element. *See Warner-Jenkinson*,

520 U.S. at 29, 34, 40. Indeed, the lower court cited to *Warner-Jenkinson* not ***once***, but ***ten*** separate times.

A. The Court Should Deny *Certiorari* on the First Question Presented.

All of the questions presented by Moore are inappropriate as a basis for the Court to grant *certiorari*. The first question does not even ascribe error to the lower court.[6] Perhaps its hypothetical question might make for a marginally interesting law review article, but the Court should not issue "advisory opinions on abstract propositions of law." *Hall v. Beals*, 396 U.S. 45, 48 (1969). In addition, the question is factually wrong because a functional analysis **was** performed by the lower court.

Perhaps misunderstanding *Warner-Jenkinson*, petitioner then misapplies that case to the present facts. Petitioner argues that, under *Warner-Jenkinson*, the doctrine of equivalents must apply "absent prosecution history estoppel or prior art." Pet. at 9. However, petitioner is wrong. This Court held in *Warner-Jenkinson* that, "if prosecution history estoppel would apply **or** if a theory of equivalents **would entirely vitiate** a particular claim element," the plaintiff **cannot** resort to the doctrine of equivalents to prove infringement. *Warner-Jenkinson*, 520 U.S. at 39 (emphasis added). Therefore, even if the Court were to consider reviewing this hypothetical question, it still should not grant *certiorari*.

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[6] The first question presented by Moore is: "Whether a functional analysis under the doctrine of equivalents can be summarily barred as a matter of law, where prosecution history estoppel does not apply." Pet. at i.

In addition, the Court should not grant *certiorari* in any event on the '798 patent because Moore's entire argument below regarding infringement of the '798 patent under the doctrine of equivalents was **one sentence**. The sole sentence stated that "there would be infringement under the doctrine of equivalents since the SRC forms are directly competitive with the Moore forms sold under the '798 patent." Brief for Appellant Moore at 33 (Appendix B). First, Moore provides no case law, nor could it, that holds that a product must infringe under the doctrine of equivalents if it is competitive with a patented product. More important, it defies logic for Moore to argue that this argument, which was worth one sentence below, is now so compelling that the Court should grant *certiorari* on its basis.

B. The Court Should Deny *Certiorari* on the Second Question Presented.

Respondent also disagrees with petitioner's second question.[7] Once again, the question is factually wrong because the lower court found that SRC had done more than "rearrange claim elements." Rather, it had entirely eliminated certain claim elements. Even if Moore's question were factually accurate, Moore cannot claim that a **compelling** question of law is presented because the panel found that, on the basis of the undisputed facts of the case, it would be impossible for "the transverse line of weakness . . . [to] be on the opposite side from said second section," as required by the corresponding claims of the patent. Pet. App. at 30a-31a (internal quotations omitted). Neither below nor in its petition did Moore ever offer

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[7] The second question presented by Moore is: "Whether the Federal Circuit can deny, as a matter of law, application of the doctrine of equivalents to rearranged claim elements." Pet. at i.

any explanation as to how its desired scope of equivalents would accommodate the omission in the SRC form of the "opposite side" requirement that the Federal Circuit pointed out. Pet. App. at 30a-31a.

Petitioner's reliance upon *Sanitary Refrigerator* with respect to these claims is therefore misplaced. As the court of appeals noted, *Sanitary Refrigerator* was an ordinary doctrine of equivalents case involving the ***replacement*** of an element with an insubstantially different element.[8] Pet. App. 32a. But even under Moore's theory of equivalents as to these claims, it could find no replacement for the "opposite" limitation.[9]

Nevertheless, Moore claims that the panel ignored the holding of the Court in *Sanitary Refrigerator*, 280 U.S. 30 (1929), relying instead on its own precedent. But what the lower court actually ***said*** on this issue — after a lengthy exposition of why Moore's arguments were incorrect — was that, "even assuming, as Moore argues, that *Sanitary Refrigerator* does allow the rearrangement of claim limitations, such rearrangement must not 'effectively vitiate [an] element in its entirety.'" Pet. App. at 32a (*quoting Warner-Jenkinson*, 520 U.S. at 29). Thus, in the alternative, the lower court actually ***accepted*** Moore's contentions but found that, even so, no infringement could be found. Moreover, *Sanitary Refrigerator* explicitly states that its holding is ***inapplicable*** "where form is of the essence of the invention." 280 U.S. at 42. In this crowded art, form — i.e., the location and

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[8] For example, if a patent claimed an adhesive comprising A + B, an adhesive comprising only A could ***never*** be the equivalent thereof, no matter how much A was used.

[9] The dissent below also overlooked this point.

dimensions, such as length, of the claim elements — is plainly "of the essence of the invention," as exemplified by the ***extremely*** detailed description of those elements in the claims. *See* Pet. App. at 140a-148a, 164a-165a. Indeed, petitioner has never suggested otherwise.

Additionally, petitioner has confused "reciprocal changes" in an accused product, as referred to in *Sanitary Refrigerator,* with the complete obviation of specific claim elements. Here, there was no "reciprocal change." Instead, SRC completely eliminated certain claim elements. Thus, the panel correctly did not allow a finding of infringement on those facts. *See* Pet. App. at 31a. *Sanitary Refrigerator* never held that a party could be liable for infringement when it did not practice **every** element in the claim. No authority whatsoever exists for **that** proposition!

In addition, as with claim 1, even were the Court to grant *certiorari*, vacate, and remand, the Federal Circuit noted that Moore did not contest the district court's finding that SRC's forms did not include several additional claim elements. Consequently, the panel held that "their absence would provide yet another ground for affirming the district court's grant of summary judgment." *See* Pet. App. at 33a n.2. Thus, again, on remand the lower court would simply reaffirm its holding upon the alternative basis set forth in its footnote 2.[10] Again, it

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[10] Moore ***now*** argues, as it did for ***the first time*** in its request for reconsideration below, that it does dispute the lower court's statement. Petitioner tries to finesse this point by arguing in the present tense: "Petitioner *does* argue that Respondent's accused form includes the other identified elements." Pet. at 11 n.8 (emphasis in original). Regardless of what Moore is now arguing, the Court should not "consider issues raised clearly for the first time in a petition for rehearing." *Adams v. Robertson*, 520 U.S. 83, 89 n.3 (1997).

would be a waste of the Court's resources to consider this issue.

C. The Court Should Deny *Certiorari* on the Third Question Presented.

Respondent also disagrees with petitioner's third question.[11] The Federal Circuit did not conclude that a strip of adhesive running 47.8% of the length of a business form is not equivalent to the claim requirement that the adhesive extend over a "majority" of the length of the form "without any functional analysis." Rather, the lower court implicitly accepted that the function of the adhesive in the accused form was the same as the function required by the claim element but found, as a matter of law, that to permit the doctrine of equivalents to reach what is the antithesis of the claim element would require the complete vitiation of that important claim element.

Similarly, petitioner's efforts to characterize as "swallow[ing] the doctrine of equivalents" the panel's decision that a majority amount did not include the minority amount of 47.8% are not compelling. *See* Pet. at 15. As evidenced by the patent specification itself, the "majority" limitation was an important claim element.[12] As the lower court held, a "minority" is the very antithesis of the term "majority" and, therefore, no reasonable juror could find a minority (be it

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[11] The third question presented by Moore is: "Whether the Federal Circuit can conclude that 47.8% is not equivalent to 'majority' as a matter of law without any functional analysis." Pet. at i.

[12] The specification disclosed other embodiments but did not claim those embodiments. Thus, the applicant must have considered the "majority" limitation to be important or "of the essence."

49.9% or 0.1%) to be the equivalent of a majority.[13] Pet. App. at 27a. Again Moore cannot demonstrate that it is a **compelling** question of law for the Court to decide the factual issue of whether a minority (*i.e.*, 47.8%) is equivalent to a majority.

D. The Court Should Deny *Certiorari* on the Fourth Question Presented.

Question 4 is likewise factually flawed.[14] It is based upon a misapprehension of what the Federal Circuit did and an erroneous attribution of "dedication estoppel" to the panel. Fundamentally, the lower court affirmed because it refused to allow Moore to entirely vitiate a claim element. It also noted that Moore had dedicated to the public an embodiment which, had it been claimed, might have allowed coverage under the doctrine of equivalents. The latter observation, which Moore characterizes as a new doctrine recently developed by the Federal Circuit in contravention of the Court's precedent, was actually espoused by the Court in *Miller v. Bridgeport Brass*

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[13] Were there to be any other result, this important limitation would be completely eliminated, as pointed out by the lower court. Pet. App. at 26a. This case is distinguishable from a case in which a numerical recitation is supplied. Suppose, for example, a claim included the numerical limitation of "5." Well, "4" is not the antithesis of 5, so it is possible that the doctrine of equivalents could reach a product including "4." Hence, the Federal Circuit's decision on remand in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 114 F.3d 1161, 1164 (Fed. Cir. 1997). However, the doctrine simply cannot be used to cover something that is the very antithesis of what is claimed.

[14] The fourth question presented by Moore is: "Whether the Federal Circuit can deny application of the doctrine of equivalents as a matter of law by employing its 'dedication' estoppel theory, an approach already rejected by this Court." Pet. at i.

Co., 104 U.S. 350, 352 (1881) ("The claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed."). Moreover, the Court has relatively recently reaffirmed the vitality of the holding in *Miller,* noting that a feature that is not specifically claimed in the patent, but is disclosed in the drawings and specification, is "[u]nder long settled law . . . public property." *Graham v. John Deere Co.*, 384 U.S. 1, 31 n.17 (1966) (citation to *Miller* omitted). Consequently, Moore's assertion that the Court has rejected the dedication to the public of features disclosed but not claimed is flatly wrong.

Moore's assertion that this is a new rule for the Federal Circuit is also flatly wrong. The Federal Circuit has consistently been applying this rule since at least 1989 to preclude findings of infringement, both literal and equivalent. *See Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) (literal) and *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098 (Fed. Cir. 1996) (doctrine of equivalents). Thus, this is neither a new issue nor one created by the lower court.

Finally, the Court should not grant *certiorari* on this question because the Court of Appeals for the Federal Circuit has announced *en banc* consideration of this issue. *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.* (Fed. Cir. Jan. 24, 2001) (Appendix C). As the Federal Circuit has initial responsibility to ensure national uniformity with respect to patent law, the Court should allow the Federal Circuit to first address this question. *Cf. Bonito Boats v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989). *Warner-Jenkinson* stated that the Federal Circuit should fill in the details in the doctrine of equivalents law, and that is what it is doing.

E. The Court Should Deny *Certiorari* on the Fifth Question Presented.

Question 5 is also factually incorrect because it ignores the determination by the panel that the district court committed only harmless error with respect to the claim construction of but one patent.[15] In other words, the question impermissibly exaggerates what actually occurred below. The question is also factually flawed because all the information for which Moore alleged discovery was required was already in Moore's hands.[16] Moreover, it was petitioner's burden to demonstrate to the appellate court ***how*** the trial court abused its discretion by failing to give credence to Moore's conclusory declarations, but petitioner completely failed to meet its burden.

This question is especially not worthy of *certiorari* because it does not even address Federal Circuit law. As even petitioner concedes, the panel was required to apply Fourth Circuit law in determining the proper standard for admitting summary judgment evidence. Pet. at 20-21. Because the standard for admitting summary judgment evidence is based on

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[15] The fifth question presented by Moore is: "Whether the Federal Circuit can affirm summary judgement that was based upon an acknowledged error of law without permitting 'adequate time for discovery' directed to the proper rule of law and despite a timely motion under Rule 56(f)." Pet. at i.

[16] Moore ascribed error to the refusal to permit discovery into the composition of SRC's adhesive. But, as subsequently learned from confidential documents produced by Moore in a different lawsuit, Moore ***knew*** the major distinction between SRC's adhesive and its own. Moore also knew what printers existed and what SRC forms were used on what printers. Finally, Moore's counsel had inspected all of the pressure seal forms made by SRC. Quite simply, as the district court correctly noted, no fishing expedition could save Moore.

the law of the regional circuit, the Federal Circuit cannot make law in this area. *See Vivid Tech., Inc. v. American Science & Eng'g, Inc.*, 200 F.3d 795, 806 (Fed. Cir. 1999). Therefore, at worst, petitioner is alleging that the panel applied the correct law, but that it did so incorrectly. But "*certiorari* is seldom granted when the asserted error consists of an erroneous factual finding **or the misapplication of a properly stated rule of law**."[17] Sup. Ct. R. 10(c) (emphasis added).

Moreover, the Federal Circuit did correctly apply the stated rule of law. First, Rule 56(f) uses the operative word "may." Thus, a district court's decision is discretionary and can be reversed only if a party demonstrates that the court "abused its discretion." *Nguyen v. CAN Corp.*, 44 F.3d 234, 242 (4th Cir. 1995). To demonstrate an abuse of discretion regarding discovery rulings is a heavy burden. *See Curtin v. Office of Personnel Management*, 846 F.2d 1373, 1378 (Fed. Cir. 1988). Moore, never even mentioning the appropriate standard below, offers no evidence that the district court abused its discretion.[18]

Second, both lower courts concluded that Moore's Rule 56(f) declarations were wholly conclusory. It has long been the

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[17] *Certiorari* is especially inappropriate in this case because the Federal Circuit cannot make binding precedent when it is merely interpreting the law of the regional circuit. *Cf. Exxon Corp. v. United States*, 931 F.2d 874, 877 n.4 (1991) (holding that the Federal Circuit's previous interpretation of Second Circuit law should also become the law of the Federal Circuit because that law is "commonly accepted in federal jurisprudence").

[18] Moore does mention, finally, the appropriate standard in its petition, but merely offers a conclusory opinion that it has been met. Pet. at 22.

law that conclusory declarations cannot defeat a properly supported motion for summary judgment. *See, e.g., Evans v. Technologies Applications & Serv. Co.*, 80 F.3d 954, 962 (4th Cir. 1996).

Third, the entire sum and substance of Moore's Rule 56 argument in its opening brief was that the "declarations speak for themselves." Moore Br. at 16 (Appendix B). That was the ***totality*** of Moore's argument. Now, it devotes ***ten*** pages in a petition for *certiorari* to this issue, ascribing error to the lower court. Pet. at 5-8, 17-23. If there was error, which there was not, it was (a) induced by Moore's ***one***-sentence brief and (b) is of a type not ordinarily reviewed by the Court. *See* Sup. Ct. R. 10. Moreover, the record demonstrates that more discovery would not have helped Moore.[19] Therefore, it cannot be error, let alone an abuse of discretion, for the district court to have refused to extend discovery.

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[19] The record demonstrates that Moore ***did*** meet SRC's motions. *See* Pet. App. at 202a (item 60); 203a (item 65); 205a (item 74); 208a (item 86). It did ***not*** seek postponement, as permitted by the Rule, to obtain ***specifically*** identified discovery. Although Moore protests that it needed discovery of SRC's adhesive composition, subsequent events have shown that Moore ***knew*** the major difference between SRC's adhesive and that used on the claimed forms. Moore also claims that it needed additional discovery regarding SRC forms to determine if any were used on printers like that mentioned in the '798 patent. The problems with this theory are (a) that Moore's counsel indisputably had inspected all of the pressure seal forms made by SRC ***before*** opposing SRC's motion (and thus knew what forms SRC had made) and (b) that no discovery from SRC would shed any light on the existence of other pausing printers. Quite simply, there are no printers, other than the IBM 3800, which suffer the problem that the form of the '798 patent was designed to correct. Further discovery simply would not have helped Moore oppose SRC's motions for summary judgment.

II. MOORE HAS FAILED TO RAISE ANY QUESTION THAT IS WORTHY OF THE COURT GRANTING *CERTIORARI*.

Moore has taken a "shotgun" approach to try to manufacture a single cert-worthy question out of five totally inadequate questions. Because there ***is*** no cert-worthy question, Moore is reduced to misstating facts, mischaracterizing what the Federal Circuit did, and finally using ten pages of its brief to rehash the factual basis for its claim that the Federal Circuit misapplied Fourth Circuit case law.[20] But the Federal Circuit court did not depart from the accepted and usual course of judicial proceedings so as to require the exercise of the Court's supervisory powers. It did not decide an important federal question in a way that conflicts with relevant decisions of the Court. It created no "new" law and made none of the errors attributed to it by petitioners. It did not ignore the Court's precedent, including *Warner-Jenkinson* and *Sanitary Refrigerator*; it was fully aware of that precedent and explicitly considered and applied it. It did not create a "new form of estoppel." It is the Federal Circuit that has been given initial responsibility to ensure national uniformity with respect to patent law questions such as this one. *Cf. Bonito Boats v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989). The Federal Circuit's decision in this case promotes such uniformity.

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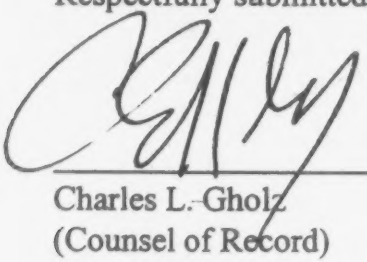
[20] The weakness of Moore's supposed cert-worthy questions is demonstrated by the fact that it spends ten pages discussing the clearly un-cert-worthy question of whether the Federal Circuit correctly applied Fourth Circuit evidentiary law, while breezing through its four other supposed cert-worthy questions in a total of ten pages.

Even if the lower court's decision were incorrect (which it most definitely is not), at best, petitioner is urging that the lower court misapplied a properly stated rule of law. Such an occurrence does not warrant the grant of *certiorari*. Sup. Ct. R. 10(c). Thus, there are no reasons, let alone ***compelling reasons,*** for the Court to grant *certiorari*.

CONCLUSION

For all the foregoing reasons, the petition for *certiorari* should be denied.

Respectfully submitted,



Charles L. Gholz
(Counsel of Record)
William T. Enos
Andrew M. Ollis
Robert C. Nissen
OBLON, SPIVAK, MCCLELLAND,
MAIER & NEUSTADT, P.C.
1755 Jefferson Davis Highway,
4th Floor
Arlington, Virginia 22202
Tel. No.: (703) 413-3000

Attorneys for Respondent
The Standard Register Company

Dated: March 23, 2001

APPENDIX

APPENDIX A

Nixon &Vanderhye P.C.
ATTORNEYS AT LAW

March 25, 1998

8TH FLOOR
1100 NORTH GLEBE ROAD
ARLINGTON, VIRGINIA 22201-4714

TELEPHONE: (703) 816-4000
FACSIMILE: (703) 816-4100
WRITER'S DIRECT DIAL NUMBER:
(703) 816-4004

VIA FACSIMILE/THEN MAIL

William T. Enos, Esq.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

Subject: ***Moore U.S.A., Inc. v. The Standard Register Company E.D.Va (Alexandria Division); Civil Action No. 97-2054-A Our Ref: 263-1165***

Dear Bill:

Further to our phone discussion of earlier today, I have asked that you stop copying documents identified by us for production. Any documents already copied and numbered I would appreciate you sending to us, but in view of the present status of the litigation, I suggest that SRC simply not go to the trouble and expense of copying the documents now. I hope you understand that this is merely a desire to save trouble and expense for the parties at the present time in view of the present

status of the litigation. If the status changes in the future, we can re-activate the document production on a reasonable basis. If you cannot agree to this for some reason, please advise.

As I also mentioned to you over the phone, our documents will be available for your inspection at our office on Monday, March 30, starting about 10 a.m. (if there is some change we would let you know by Thursday afternoon). You indicated you had no intention of bringing more than three people, and we ask that you do not bring more than three people. I presently expect your inspection will not take more than two days, but other time is available if necessary. After your inspection we will talk to see if you feel you really need large scale copying of documents, as opposed to small scale copying, in view of the present status.

I will provide supplementation to the interrogatory responses we specifically discussed -- pursuant to our agreement -- on Monday (probably not until Monday afternoon), verified by an officer of Moore; except that our contentions regarding infringement of the '464 patent will be provided by Tuesday, March 31.

I also recommended that after the decision on Summary Judgment for the '464 patent we discuss possibly staying the litigation in some manner pending an appeal. I presently view the desirable way of doing this as a request for certification for appeal, but would be pleased to entertain other options, such as dismissal without prejudice and staying the statute of limitations for your counterclaims, or for some aspects of the litigation, etc. I believe we need a few weeks, and ensuing events, to determine what would be cost efficient and effective for the parties, and do not expect any response from you at this time.

Please advise if there are any questions or misunderstandings.

Sincerely,

NIXON & VANDERHYE P.C.

By _____
Robert A. Vanderhye

cc: Michael C. Maier, Esq.

APPENDIX B

BRIEF FOR PLAINTIFF-APPELLANT MOORE U.S.A., INC.

IN THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal No. 98-1386, -1387

MOORE U.S.A., INC.,

Plaintiff-Appellant,

v.

STANDARD REGISTER COMPANY,

Defendant-Cross Appellant.

Appeal from Orders of the United States District Court for the Eastern District of Virginia in 97-2054-A Entered March 20, 1998 and April 17, 1998 By the Honorable Albert V. Bryan, Jr.

Robert A. Vanderhye
NIXON & VANDERHYE P.C.
1100 North Glebe Road
8th Floor

Arlington, Virginia 22201
(703) 816-4000

Attorney for Plaintiff-Appellant
MOORE U.S.A., INC.

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. . . .VI. ARGUMENT

A. The Lower Court Improperly Denied Moore Relevant Discovery, and Improvidently Granted Summary Judgment

With respect to each and every patent at issue, the lower court inappropriately disposed of the patent in a summary manner without allowing Moore appropriate discovery. Summary judgment is not appropriate when the party resisting summary judgment has had no worthwhile fact discovery and submits a declaration under Rule 56(f), as was done in this case individually with respect to each of the three patents involved.

With respect to the '110 and '798 patents, the lower court [A29] dismissed Moore's motion as not offering "any specific expected disclosure that would alter the Court's conclusions and findings" and said it was unwilling to allow Moore "to conduct 'fishing expeditions'". This was an inappropriate analysis, as an inspection of the declarations submitted [A82, 83, 73,74] reveals, which declarations speak for themselves.

With respect to the declaration under 56(f) regarding the '464 patent [A59-62], the lower court never even

considered or commented on the Rule 56(f) declaration submitted [see A36-A44].

This Court has consistently found it inappropriate for a lower court to grant summary judgment based on an incomplete record. As precisely put in *Burnside-Ott v The United States*, 985 F.2d 1574, 1582-3 (Fed. Cir. 1993):

> "'The Supreme Court has made clear that summary judgment is inappropriate unless a tribunal permits the parties adequate time for discovery'. *Dunkin' Donuts of America v Metallurgical Exoproducts Corp.*, 840 F.2d 917, 919 (Fed. Cir. 1988) (citing *Celotex Corp. v Catrett*, 477 U.S. 317, 326, 106 S.Ct. 2548, 2554, 91 L.Ed.2d 265 (1986)). Indeed, summary judgment should 'be refused where the nonmoving party has not had the opportunity to discover information that is essential to [its] opposition.' *Anderson v Liberty Lobby, Inc.*, 477 U.S. 242, 250 n. 5, 106 S.Ct. 2505, 2511 n. 5, 91 L.Ed.2d 202 (1986). . . . The fact that the government had not even responded to all of Burnside-Ott's discovery requests within the allotted discovery period and that no time remained for Burnside-Ott to file a second motion to compel also shows that Burnside-Ott was provided an inadequate opportunity for discovery. . . . Burnside-Ott must be given an adequate opportunity to discover facts as to those counts before summary judgment or other disposition would be appropriate."

Thus all three summary judgment determinations should be reversed for this reason alone.

Even if the lower court had properly concluded that it was appropriate to consider the question of infringement although Moore was denied any worthwhile discovery, the lower court erred as a matter of law in granting summary judgment with respect to each of the '464, '798, and '110 patents. . . .

In claim 1 the spacing of the position of a (single) transverse pattern of adhesive is functional, recited as "a distance sufficient to ensure that the adhesive does not interfere with rollers of a printer used to process the mailer during pausing of the printer". As the most logical interpretation of SRC's own evidence presented at the summary judgment stage shows [A70-71], the SRC forms don't have this problem -- thus SRC obviously has solved it by spacing like Moore does. Thus, either SRC has admitted that this limitation is present in its forms, or there is a fact in dispute with respect thereto. Also, as A83-85 make clear, there are SRC forms that clearly fall within the literal terms of claim 1.

Even if there were no literal infringement, which there is, there would be infringement under the doctrine of equivalents since the SRC forms are directly competitive with the Moore forms sold under the '798 patent, and perform substantially the same function in substantially the same way to get substantially the same results. [A85-87.]

Thus clearly as a matter of law the lower court erred in the interpretation of claim 1, and in finding no infringement because of this erroneous interpretation.

D. The Finding that the Claims of the '110 Patent Were Not Infringed as a Matter of Law is Based Upon an Erroneous Claim Construction, which Included the Failure to Consider the Prior Art and the Prosecution History. . . .

APPENDIX C

United States Court of Appeals for the Federal Circuit

99-1076, -1179, -1180

JOHNSON & JOHNSTON ASSOCIATES INC.,

Plaintiff-Appellee,

v.

R.E. SERVICE CO., INC. and MARK FRATER,

Defendants-Appellants.

Donald R. Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., of Washington, DC, argued for plaintiff-appellee. With him on the brief were Thomas H. Jenkins, and Virginia L. Carron. Of counsel on the brief was Matthew F. Weil, Howard, Rice, Nemerovski, Canady, Falk & Rabkin, of Newport Beach, California. Also of counsel on the brief were John L. Dupre', Richard A. Wise, and Dierdre E. Sanders, Hamilton, Brook Smith & Reynold, P.C., of Lexington, Massachusetts. Also of counsel on the brief were Fay E. Morisseau, Michael R. O'Neill, McDermott, Will & Emery, of Irvine, California.

Archie S. Robinson, Robinson & Wood, Inc., of San Jose, California, argued for defendants-appellants. With him on the brief were Thomas R. Fellows and Rebecca L. Moon. Of counsel on the brief was Jack M. Wiseman, of San Jose, California

Appealed from: United States District Court for the Northern District of California

Judge Charles R. Breyer

United States Court of Appeals for the Federal Circuit

99-1076, -1179, -1180

JOHNSON & JOHNSTON ASSOCIATES INC.,

Plaintiff-Appellee,

v.

R.E. SERVICE CO. INC., and MARK FRATER,

Defendants-Appellants.

Before MAYER, Chief Judge, NEWMAN, Circuit Judge, ARCHER, Senior Circuit Judge, MICHEL, LOURIE, CLEVENGER, RADER, SCHALL, BRYSON, GAJARSA, LINN, and DYK, Circuit Judges.

ORDER

This case, having been argued before a panel of three judges on December 7, 1999, and thereafter having been referred to the circuit judges who are in regular active service and a poll having been taken,

IT IS ORDERED THAT:

The Court sua sponte orders that the case be heard en banc.

New briefs will be filed. An original and 30 copies of all briefs shall be filed and two copies shall be served on opposing counsel. Amici curiae may file briefs, due at the time of the brief that supports their position. Appellants' brief is due within 60 days of the date of this Order. The due dates for the remaining briefs shall be computed in accordance with Fed. Cir. R. 31(a).

The parties are directed to confine their supplemental briefing and oral arguments before the Court en banc to the following questions:

(1) Whether and under what circumstances a patentee can rely upon the doctrine of equivalents with respect to unclaimed subject matter disclosed in the specification.

(2) Whether in this case the jury's finding of infringement should be reversed because the patentee was foreclosed from asserting the doctrine of equivalents with respect to unclaimed subject matter disclosed in the specification.

The en banc briefs and argument shall not address other issues in the case.

Oral argument will be scheduled by later order.

FOR THE COURT

January 24, 2001 — Jan Horbaly

Date — Jan Horbaly
Clerk

APR 9 2001

No. 00-1346

FILED

APR 9 2001

CLERK

IN THE

Supreme Court of the United States

MOORE NORTH AMERICA, INC. (FORMERLY KNOWN AS MOORE U.S.A., INC.),

Petitioner,

vs.

STANDARD REGISTER COMPANY,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO BRIEF IN OPPOSITION

ROBERT A. ROWAN
Counsel of Record
JAMES D. BERQUIST
JONATHON T. REAVILL
NIXON & VANDERHYE PC
1100 North Glebe Road, 8th Flr.
Arlington, VA 22201
(703) 816-4000

Attorneys for Petitioner

LIST OF PARTIES AND CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rules 14.1(b) and 29.6, counsel for the Petitioner, MOORE NORTH AMERICA, INC., formerly known as MOORE U.S.A., INC., hereby certifies the following:

1. The full names of every party to the proceeding sought to be reviewed are: MOORE NORTH AMERICA, INC., formerly known as MOORE U.S.A., INC., and the STANDARD REGISTER COMPANY.

2. Petitioner's parent corporation is MOORE CORPORATION, LTD., whose stock is publicly traded on the New York Stock Exchange.

3. To the best of Petitioner's information and belief, Respondent's stock is traded on the New York Stock Exchange, and there is no publicly held company that owns 10% or more of its stock.

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REPLY TO BRIEF IN OPPOSITION

Petitioner Moore North America, Inc. ("Moore"), submits this Reply to the Brief In Opposition filed by Respondent The Standard Register Company ("SRC").

ARGUMENT

SRC attempts to divert the Court's attention from the significant, equivalency-narrowing, precedent created by the decision below by arguing that it was merely "fact-specific" and presents no "compelling reasons" to grant *certiorari*. To do so, SRC not only misstates the record below, but ignores the Federal Circuit's own citation of this case in subsequent decisions and the critical commentary this case has already generated in the patent bar.

Recognizing SRC's attempt to bait Moore into a "fact-specific" reply, Moore will only address SRC's misstatements in context and focus on the significance of the legal questions presented. In addition to *DeMarini Sports, Inc. v. Worth, Inc.*, Nos. 99-1561, 99-1583, 2001 U.S. App. LEXIS 2093 (Fed. Cir. 2001), discussed at pages 4 and 12 of Moore's Petition, the Federal Circuit has since relied upon the decision below to bar application of the doctrine of equivalents, as a matter of law, by "implied" exclusions in patent claims. *See Scimed Life Systems, Inc.* v. *Advanced Cardiovascular Systems, Inc.*, No. 99-1499, 2001 U.S. App. LEXIS 3864 (Fed. Cir. Mar.14, 2001) (Reply App. A at 1a). These decisions, addressing Moore's Questions 1-3 on facts distinct from this case, directly refute SRC's contentions.

Moreover, the September 29, 2000 issue of the *Patent, Trademark & Copyright Journal* declares (focusing primarily on Question 4) that the decision under review "provides another occasion for lawyers to complain about conflicting Federal Circuit case law." Reply App. E at 54a. That comment was followed by a January 2001 article, citing the decision below (primarily Question 3), as further indicia

of "the Federal Circuit['s] whittling away at the ... doctrine [of equivalents]." Steven E. Koffs, *What's Left of The Doctrine of Equivalents?*, The Legal Intelligencer, Jan. 4, 2001, at 5 (Reply App. C at 38a). The instant decision is also cited (again regarding Question 3) by the Patent Resources Group in its seminar on "Federal Circuit Advanced Patent Law" as one of the five most "surprising and diverse" examples of "[t]he Federal Circuit's various panels' lack of coherent doctrinal stability." Reply App. D at 44a-45a. Finally, the decision below was the featured case in a recent article relating to Question 3, authored by Corwin P. Umbach, Ph.D., a colleague of SRC's own counsel at Oblon, Spivak, McClelland, Maier & Neustadt. In *Narrow Claiming and The Scope of Equivalents: I Meant What I Said And I Said What I Meant...*", Intell. Prop. Today, March 2001, Dr. Umbach describes the decision below as the "culminati[on]" of recent decisions "show[ing] that the Federal Circuit is willing to find legal limits on the scope of equivalents based solely on [a judicial assessment of] the narrowness of claim limitations." Reply App. B at 31a. Moreover, according to Dr. Umbach, the best that even Ph.D. patent practitioners can take from the decision below is the illogical conclusion that "substitution of 'greater than 50%' [*i.e.*, the literal definition of 'majority'] for the 'majority' limitation in *Moore* would have avoided the sharply restricted scope of equivalents." Reply App. B, at 32a. This commentary was not acknowledged in SRC's Opposition.[1]

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[1] SRC's curious Question 2, asserting that one issue presented by Moore for review was so "unimportant . . . [that Moore] devoted exactly one conclusory sentence to it in its appeal brief below," Opp. at i, is mystifying. If this statement refers to Moore's Question 5, *i.e.*, Moore's Fed. R. Civ. P. 56 argument, *see* Opp. at 15, SRC's own factual support, a *partial* reprint of Moore's opening brief below, Opp. App. B, itself shows three pages of single-spaced argument regarding the violation of Rule 56. If, however, SRC's Question 2 is intended to refer to equivalency under the '798 patent, Opp. at 7, Moore's Petition presents no such issue for review.

I. The Court Should Grant *Certiorari* of Moore's First Question Presented.

The Federal Circuit cited, but refused to follow, this Court's precedent requiring a functional analysis under the doctrine of equivalents. SRC attempts to justify the Federal Circuit's error in two unavailing ways.

First, SRC contends (without supporting citation) that the lower court actually performed a functional analysis with respect to U.S. Patent No. 5,201,464 ("the '464 patent").[2] The record shows that the Federal Circuit, driven solely by its literal interpretation of disputed claim terms, failed to apply the doctrine of equivalents to the '464 patent at all, let alone perform a functional analysis. *See* Pet. App. at 24a-33a. Moore's First Question is clearly not "hypothetical."

Second, like the Federal Circuit, SRC incorrectly concludes that the All-Elements Rule can foreclose a functional equivalency analysis. The logical fallacy in this argument is that every equivalency case involves a "missing" claim limitation. *See, e.g., Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1564-65 (Fed. Cir. 1989) ("The essence of the doctrine of equivalents is that it permits recovery for infringement where the accused device does *not* fall within the literal scope of the claims and is, therefore, outside their literal scope."); *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 149 F.3d 1309, 1317 (Fed. Cir. 1998). Accordingly, the determination of whether an accused product comports with the All-Elements Rule must be made *after*, not before, a functional analysis of the "role" played by the missing element.

Where the accused product does not infringe literally, the factfinder must first determine the role of the "missing" element in order to determine whether a counterpart element

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[2] Moore's equivalency argument is limited to the '464 patent.

is present in the accused product. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 40 (1997).[3] If a counterpart element for that role is present, the factfinder must then determine whether the accused element is "insubstantially different" from the claimed element, if it is a "known interchangeable" of the claimed element, or if it performs "substantially the same function in substantially the same way to achieve substantially the same result as the claimed element." *Id.* If the accused product also contains all other claim elements, either literally or by equivalents, the All-Elements Rule is satisfied.

The Federal Circuit and SRC nevertheless insist that the equivalency analysis begin and end with the All-Elements Rule. However, that approach restricts the doctrine of equivalents to cases in which the accused product already meets each claimed limitation *literally*. As such, the Federal Circuit's approach reduces the doctrine of equivalents to a useless and redundant literal analysis that completely eviscerates this Court's holding in *Warner-Jenkinson Co.*

II. The Court Should Grant *Certiorari* of Moore's Second Question Presented.

The district court expressly relied upon the Federal Circuit's more recent decision in *Sage Products, Inc. v. Devon Industries., Inc.*, 126 F.3d 1420 (Fed. Cir. 1997), as controlling authority over this Court's decision in *Sanitary*

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[3] *See also Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1259 (Fed. Cir. 1989) ("An equivalent must be found for every limitation of the claim *somewhere* in an accused device, *but not necessarily in a corresponding component*, although that is generally the case.") (emphasis added); *Ethicon*, 149 F.3d at 1320 ("[o]ne-to-one correspondence of components is not required, and elements or steps may be combined without ipso facto loss of equivalency") (citations omitted).

Refrigerator v. Winters, 280 U.S. 30 (1929).[4] The Federal Circuit affirmed that error by sidestepping *Sanitary Refrigerator* based on the All-Elements Rule.[5] By doing so, it has now elevated that error into a broad new rule of law.

Because SRC does not dispute that its accused forms have elements that are known to be interchangeable with the elements of claim 9 of the '464 patent, or that its accused elements perform substantially the same function in substantially the same way to achieve substantially the same result as the claimed elements, controlling Supreme Court law – notably, *Sanitary Refrigerator* – would require a finding of infringement under the doctrine of equivalents. However, the Federal Circuit looked to its own case law, *i.e.*, *Sage*, and held otherwise.[6] That holding flies in the face of this Court's precedent and threatens to destroy the entire purpose of the doctrine, namely to "temper unsparing logic and prevent an infringer from stealing the benefit of the invention." *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950) (quoting *Sanitary Refrigerator*, 280 U.S. at 42).

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[4] Pet. App. at 65a ("Although plaintiff points to a 1929 Supreme Court opinion [*Sanitary Refrigerator*] that has to some extent condoned the rearrangement of elements in a patent claim, the Federal Circuit's language [in *Sage*] is unequivocal in rejecting such rearrangement, and this court at this stage is bound by the Federal Circuit's clear language.").

[5] SRC's assertion that the Federal Circuit "expressly adopted Moore's arguments concerning *Sanitary Refrigerator* . . .," Opp. at 4, ignores that court's express holding that, "contrary to Moore's belief," "*Sanitary Refrigerator* cannot properly be viewed as a case sanctioning the rearrangement of claim limitations." Pet. App. at 32a.

[6] To rationalize the Federal Circuit's holding, SRC cites the reference in *Sanitary Refrigerator* regarding "the essence of the invention." Opp. at 8-9. However, nothing in that decision suggests that the mere recitation of structure in a patent claim transforms that structure into "the essence of the invention."

III. The Court Should Grant *Certiorari* of Moore's Third Question Presented.

The Federal Circuit's ruling as a matter of law that, regardless of function, claim 1 of the '464 patent could never cover a business form with adhesive strips extending less than a "majority" of the form length evidences a clear disregard for this Court's mandate in *Warner-Jenkinson* that function, not semantics, controls the analysis. SRC argues, without citation, that the Federal Circuit "implicitly accepted" that the claimed and accused adhesive strips perform the same function. Opp. at 10. The truth is that the Federal Circuit looked no farther than what it considered to be the "inherent narrowness" of the term "majority" and refused *as a matter of law* to even consider the function of the claimed strips. Pet. App. at 26a-27a.[7] The Federal Circuit's use of its newly created but unexplained "inherent narrowness" doctrine reduces the doctrine of equivalents to an arbitrary, linguistic analysis, effectively eliminates equivalency as a viable infringement theory, and undermines this Court's long-standing endorsement of the doctrine of equivalents.

Moreover, the Federal Circuit's ruling is not limited to this case. In addition to the court's citation to the ruling below in *DeMarini Sports, Inc.*, 2001 U.S. App. LEXIS 2093, with respect to rearranged claim elements, it also relied upon this case to limit patent claims to the preferred embodiment disclosed in the specification, despite broad *literal* claim language covering the accused product in *Scimed Life Systems, Inc.*, 2001 U.S. App. LEXIS 3864, at

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[7] Despite SRC's suggestion, Opp. at 3-4, the Federal Circuit explicitly stated that its decision of non-infringement of claim 1 of the '464 patent was not based upon element [e] of that claim. Pet. App. A at 28a n.1. Moreover, the panel's dicta regarding that element suffers from the same failure to consider function that permeates the court's actual holding with respect to the '464 patent. *See* Pet. at 13 n.11.

** 23-24 (Reply App. A at 14a-15a). Furthermore, at least three commentators have already written on the impact of the decision. *See* Reply Apps. B, C, E (discussed *supra*). A recent patent bar seminar even cited the decision below as illustrating "[t]he Federal Circuit's various panels' lack of coherent doctrinal stability." Reply App. D at 44a-45a. These citations demonstrate the compelling need for review of the broad new rules established by the decision below.

IV. The Court Should Grant *Certiorari* of Moore's Fourth Question Presented.

The Federal Circuit's "dedication estoppel" theory also threatens to destroy the doctrine of equivalents as defined by this Court in its landmark *Graver Tank* decision. Even though the Federal Circuit has acknowledged the conflict between its "dedication estoppel" theory and the law of this Court, *see YBM Magnex, Inc. v. International Trade Comm'n*, 145 F.3d 1317, 1320-21 (Fed. Cir. 1998), the lower court continues to use that theory to restrict the doctrine of equivalents to the literal claim language.

SRC's portrayal of this new limitation on the doctrine of equivalents as established precedent is not compelling. For example, in *Environmental Instruments, Inc.*, 877 F.2d at 1564-66, the Federal Circuit limited its "dedication" theory to the asserted claim's *literal* scope and actually found no infringement under the doctrine of equivalents as a result of prosecution history estoppel. More significantly, this Court long ago rejected the dedication approach of *Miller v. Bridgeport Brass Co.*, 104 U.S. 350 (1881), as a limitation on the doctrine of equivalents in *Graver Tank*, 339 U.S. at 612, 614-15.[8]

If this Court nevertheless agrees with SRC that *Miller* sanctions the exclusion of disclosed but unclaimed

[8] Nor does the dicta in *Graham v. John Deere Co.*, 384 U.S. 1, 31 n.17 (1966), regarding patent *validity* add anything to the equivalency issue.

embodiments from the scope of equivalence, then a clear conflict exists not only in Federal Circuit precedent,[9] but in this Court's precedent, as well.[10] Accordingly, the Court's clear guidance regarding dedication estoppel is not only necessary in this case, but urgently needed by the Federal Circuit for its upcoming *en banc* review of that theory in *Johnson & Johnston Associates, Inc. v. R.E. Service Co., Inc.* (Nos. 99-1076, -1179, -1180).

SRC also completely fails to address the larger policy problems that the Federal Circuit's dedication estoppel theory creates. For example, dedication estoppel discourages full disclosure in patent specifications and chills patentees' rights to file continuation applications, which rely on material that was disclosed but not claimed in a predecessor patent application. In addition, 35 U.S.C. § 112 requires a patentee to provide sufficient detail to enable those of ordinary skill in the art to practice the claimed invention. Yet, under the Federal Circuit's dedication estoppel, patentees will be punished for providing any disclosure that may not be literally covered by the claims. Thus, patentees will opt to provide only the most limited "bare bones" disclosures to avoid the draconian impact of the Federal Circuit's "dedication estoppel" rule of law. That result cannot be consistent with the policy underlying Section 112 or the basic purpose of the patent system to "promote the Progress of Science and useful Arts"[11] by disclosing all embodiments of an invention known at the time the application is filed.

"Dedication estoppel" further conflicts with the basic premise of the doctrine of equivalents: to provide a fair and equitable scope to an invention that necessarily goes beyond

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[9] *Compare YBM Magnex, Inc. v.*, 145 F.3d at 1320-22, *with Maxwell v. J. Baker*, 86 F.3d 1098 (Fed. Cir. 1996).

[10] *Compare Graver Tank*, 339 U.S. at 612-18.

[11] U.S. Const., art. I, § 8, cl. 8.

the strict, literal language of the claims, but is consistent with the patent's teaching as a whole.

This Court charged the Federal Circuit with the task of filling in the details of the doctrine of equivalents. *See Warner-Jenkinson*, 520 U.S. at 40. However, the Federal Circuit's response has been to take every opportunity to limit the doctrine of equivalents to the literal scope of the patent claims. The Court must take this opportunity to reaffirm at least one immutable rule: In the absence of prosecution history estoppel or limiting prior art, the factfinder must compare the *functions* of the claimed and accused elements.

V. The Court Should Grant *Certiorari* of Moore's Fifth Question Presented

SRC attempts to mislead the Court with respect to Moore's non-receipt of documents relevant to the summary judgment on U.S. Patent No. 5,253,798 ("the *'798* patent"). SRC states: "What Moore fails to tell the Court is that it specifically asked SRC to **not** supply it with those documents as a cost-saving measure . . . before the district court granted summary judgment on the *'464* patent on April 17, 1998." Opp. at 2 n.2 (bold in original, italics added). SRC's factual cite further reveals its sleight of hand, *i.e.*, Moore's *March 25, 1998* letter, Opp. App. A at 1a-3a, was written 5 days *after* the district had granted summary judgment on the *'798* patent on *March 20, 1998*! Pet. at 4-8, 24; Pet. App. E at 70a-79a; Pet. App. L at 98a. Space does not permit a rebuttal of SRC's various other factual misstatements, but the Court's attention is drawn to the telling lack of citations for virtually all of SRC's allegedly "factual" assertions. *See, e.g.*, Opp. at 13 n.16.

SRC's argument that procedural decisions in patent cases should be immune from review simply because the court below applies the law of various regional circuits, Opp. at 13-14 & n.17, is untenable in view of *Exxon Corp. v. United States*, 931 F.2d 874, 877 n.4 (1991), and the due process

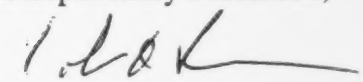
considerations inherent in Fed. R. Civ. P. 56(f), which cannot be made to turn on the subject matter of the suit in question.

CONCLUSION

Despite SRC's best efforts to change the fundamental nature of the dispute as to the '464 patent, that dispute is not fact-intensive. Rather, this case, which never moved beyond summary judgment, is about the lower court's distortion of controlling Supreme Court precedent. Distilled to its essence, the dispute is whether the Federal Circuit is free to disregard this Court's clear instructions by resolving equivalency issues in a discretionary manner without undertaking the functional analysis required by this Court. The Federal Circuit's repeated citation to *Warner-Jenkinson* does nothing to remedy the fact that the court below plainly rejected this Court's earlier instruction and again chose to set its own course on the doctrine of equivalents.

While the Rule 56(f) issue involving the '798 patent is slightly more fact-intensive, those facts are fully documented by record citations in Moore's Petition and are not meaningfully contravened by the unsupported and explicitly misleading assertions in SRC's Opposition. Moreover, the Rule 56(f) decisions below present issues of law as compelling as any addressed in this Court's 1986 summary judgment trilogy.

Respectfully submitted,



Robert A. Rowan
James D. Berquist
NIXON & VANDERHYE P.C.
1100 N. Glebe Road, 8th Floor
Arlington, Virginia 22201
(703) 816-4000

APPENDIX

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

99-1499

SCIMED LIFE SYSTEMS, INC.,
Plaintiff-Appellant,
v.
ADVANCED CARDIOVASCULAR SYSTEMS, INC.,
Defendant-Appellee.

DECIDED: March 14, 2001

Appealed from: United States District Court for the Northern District of California
Judge Martin J. Jenkins

Before BRYSON, *Circuit Judge*, PLAGER, *Senior Circuit Judge*, and DYK, *Circuit Judge*.

Opinion for the court filed by *Circuit Judge* BRYSON. Concurring opinion filed by *Circuit Judge* DYK.

BRYSON, *Circuit Judge*.

SciMed Life Systems, Inc., (SciMed) owns three U.S. patents drawn to features of balloon dilatation catheters: U.S. Patent Nos. 5,156,594 (the '594 patent), 5,217,482 (the '482 patent), and 5,395,334 (the '334 patent). SciMed filed suit against Advanced Cardiovascular Systems, Inc., (ACS)

in the United States District Court for the Northern District of California, charging ACS with infringement of each of the three patents. On ACS's motion for summary judgment, the district court ruled that ACS had not infringed the disputed patents. The district court's ruling was based on the court's conclusion that the asserted claims were limited to a structure not found in ACS's accused devices and on the court's conclusion that ACS's devices did not infringe SciMed's patents under the doctrine of equivalents. We agree with the district court's claim construction and its ruling on the equivalents issue. We therefore affirm the summary judgment of non-infringement.

I

Balloon dilatation catheters are used in coronary angioplasty procedures to remove restrictions in coronary arteries. The SciMed patents describe catheters having three sections: a first shaft section, a second shaft section, and a transition section between the two. The first shaft section is long, relatively stiff, and generally tubular. The second shaft section is relatively flexible and contains a balloon at the end, which is inflated to relieve the arterial restriction. The transition section connects the first and second shaft sections and provides a gradual transition in stiffness between the two shaft sections.

The catheters claimed in the SciMed patents contain two passageways, or lumens. The first lumen, the guide-wire lumen, is used to guide the catheter through a patient's arteries to the site of the arterial restriction. A guide wire is first inserted into one of the patient's arteries. The guide-wire lumen is then threaded over the guide wire to guide the catheter through the patient's arteries until the catheter reaches the coronary restriction. In the invention recited in the SciMed patents, the guide wire does not enter the catheter at the proximal end of the catheter, i.e., the end closer to the surgeon, but at a point nearer to the distal end of

the catheter, i.e., the leading end of the catheter as it is inserted into the patient. The guide-wire lumen is present only in the distal portion of the catheter and does not extend the entire length of the catheter. The second lumen is the inflation lumen. It extends through all sections of the catheter and terminates in a connection with the balloon. The balloon is inflated by forcing fluid into the inflation lumen. The balloon then compresses the material restricting the artery, thereby relieving the restriction.

The parties agree that only two arrangements of the two lumens are known and practiced in the art. In the dual (or adjacent) lumen configuration, the two lumens are positioned side-by-side within the catheter. In the coaxial lumen configuration, the guide wire lumen runs inside the inflation lumen; in that configuration the inflation lumen, viewed in cross-section, is annular in shape. The parties also agree that the accused ACS devices employ only the dual lumen configuration and that the preferred embodiment described in the SciMed patents employs the coaxial lumen configuration.

Based on language in the common written description portion of the three SciMed patents, the district court construed the asserted claims of the patents to be limited to catheters with coaxial lumens, and not to read on catheters with a dual lumen configuration. The court noted that "the language contained in SciMed's specifications expressly limits all embodiments of the claimed invention to a coaxial structure." The court focused in particular on language from the common specification describing the coaxial lumen structure as the "basic sleeve structure for all embodiments of the present invention contemplated and disclosed herein." That language, the court concluded, "leaves no doubt that a person skilled in the art would conclude that the inventor envisioned only one design for the catheters taught in SciMed's patents--an intermediate sleeve section containing two . . . lumens arranged coaxially."

In light of the district court's construction of the asserted claims, SciMed conceded that ACS's accused catheters did not literally infringe any of the asserted claims. In addition, the court held on summary judgment that the two lumen arrangements were sufficiently different that no reasonable jury could find the accused catheters to infringe the SciMed patents under the doctrine of equivalents. SciMed appeals the claim construction and the summary judgment based on that construction.

II

The principal question in this case is a narrow one: whether the common specification of the three patents limits the scope of the asserted claims to catheters with coaxial lumens. There is nothing pertinent to this issue in the prosecution history of the three patents; the case turns entirely on an interpretation of the asserted claims in light of the specification, which is essentially identical for each of the three patents. Like the district court, we interpret the specification to disclaim the dual lumen configuration and to limit the scope of the asserted claims to catheters with coaxial lumen structures having annular inflation lumens. We therefore construe the asserted claims to read only on catheters with coaxial lumens, and not on catheters with dual or side-by-side lumens.

Claim 19 of the '594 patent is representative of the asserted claims of the three patents in suit. It claims the following:

> In an elongate dilatation catheter of the type that can be slidably moved along a guide wire that can extend past a distal end of the catheter, wherein the guide wire is received in a guide wire lumen of the catheter, the guide wire extending from a distal guide wire lumen opening to a proximal guide wire lumen opening disposed in a portion of the catheter that is spaced distally from a proximal end of the

> catheter, the dilatation catheter including an inflatable balloon and an inflation lumen extending through the catheter separate from the guide wire lumen, an improvement comprising:
>
> a first proximal shaft section of the catheter defined by a relatively rigid metallic tube;
>
> a second shaft section disposed distally of the first shaft section, the second shaft section being relatively more flexible than the first shaft section; and
>
> a transition section disposed between the first shaft section and the second shaft section, the transition section including a transition member comprising a metallic element of gradually diminished dimension, the transition member extending adjacent to the proximal guide wire lumen opening, and the transition member having gradually decreasing rigidity in the distal direction to provide a relatively smooth transition between the first shaft section and the second shaft section.

SciMed argues at length that in construing the claims based on the written description, the district court has committed one of the cardinal sins of patent law--reading a limitation from the written description into the claims. *See Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998). But that is not an accurate characterization of what the district court did. Instead, the district court properly followed the invocation that "[c]laims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments*, 52 F.3d 967, 979-980, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996); *see also United States v. Adams*, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966) ("[C]laims are to be construed in light of the specifications and both are to be read with a view to

ascertaining the invention."); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) ("Claims are not interpreted in a vacuum, but are part of and are read in light of the specification.").

As this court has recently explained, "[o]ne purpose for examining the specification is to determine if the patentee has limited the scope of the claims." *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882, 56 USPQ2d 1836, 1839 (Fed. Cir. 2000). Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question. Thus, in the *Watts* case, the claim in dispute recited pipe joints that could be "sealingly connected." The court noted that the specification described only one method to achieve the sealing connection, that is, to misalign the taper angles of the respective threads of the joined pipes. The court pointed out that the specification "actually limits the invention to structures that utilize misaligned taper angles, stating that 'the present invention utilizes [the varying taper angle] feature.'" 232 F.3d at 883, 56 USPQ2d at 1840. In light of that statement, the court construed the claim language as limited to connections effected by misaligned taper angles.

Another case in which the claims were given a narrow construction in light of the written description is *Wang Labs, Inc. v. America Online, Inc.*, 197 F.3d 1377, 53 USPQ2d 1161 (Fed. Cir. 1999). In that case, the parties agreed that in general usage the claim term "frame" could be applied both to "bit-mapped display systems" and to "character-based systems." The court, however, construed the claims as limited to character-based systems. The court noted that the "only system that is described and enabled" in the patent specification "uses a character-based protocol," and that

references to bit-mapped protocols did "not describe them as included in the applicant's invention, and that the specification would not be so understood by a person skilled in the field of the invention." *Id.* at 1382, 53 USPQ2d at 1164. Citing *Modine Manufacturing Co. v. United States International Trade Commission*, 75 F.3d 1545, 1551, 37 USPQ2d 1609, 1612 (Fed. Cir. 1996), the court explained that "when the 'preferred embodiment' is described as the invention itself, the claims are not entitled to a broader scope than that embodiment." 197 F.3d at 1383, 53 USPQ2d at 1165.

The court in *Cultor Corp. v. A.E. Staley Manufacturing Co.*, 224 F.3d 1328, 56 USPQ2d 1208 (Fed. Cir. 2000), followed a similar analytical path. Although the claim language referred broadly to dissolving polydextrose in water, the written description made clear that the water-soluble polydextrose referred to in the claims was polydextrose prepared using a citric acid catalyst. Because the written description explicitly limited the subject matter of the patent to a polydextrose purification process using a citric acid catalyst, the court declined to hold that the asserted claims read on a process using a catalyst other than citric acid, even though the claims themselves did not refer to citric acid. The explicit reference in the specification to the invention as a process limited to one prepared with the citric acid catalyst, the court held, "effected a disclaimer of the other prior art acids. Claims are not correctly construed to cover what was expressly disclaimed." 224 F.3d at 1331, 56 USPQ2d at 1210.

In another similar case, *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581, 42 USPQ2d 1777, 1781 (Fed. Cir. 1997), the patentee argued that the claim term "passage" should be given its ordinary and accustomed meaning, and that the district court had erred by limiting the scope of the patent to the kind of "passage" employed in the preferred

embodiment. The court rejected that argument on two grounds. First, it noted that "all of the 'passage' structures contemplated by the written description [were] either non-smooth or conical." In addition, the written description "expressly distinguishe[d] over prior art passages by stating that those passages are generally smooth-walled." *Id.*, 42 USPQ2d at 1781. The court therefore concluded that "one skilled in the art reading the claims, description, and prosecution history would conclude that the term 'passage' ... does not encompass a smooth-walled, completely cylindrical structure." *Id.*

Finally, we find instructive the analysis in *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 53 USPQ2d 1065 (Fed. Cir. 1999). The patent at issue described and claimed a hand-held convertible vacuum-blower for vacuuming and blowing leaves and yard debris. In the claimed device, the cover was fitted with a ring that restricted the size of the air inlet when the device was being used in blower mode. One of the questions before the court was whether the cover, which the claim characterized as "including" a restriction ring, had to be permanently attached to the restriction ring. To answer that question the court looked to the specification. The court observed that the specification and drawings showed the ring as part of and permanently attached to the cover, and did not illustrate or describe any other structure. Indeed, the court pointed out, the specification described the advantages of the unitary structure as important to the invention. Based on the specification, the court construed the term "including" in the asserted claims as requiring that the restriction ring be attached to the cover. 199 F.3d at 1302, 53 USPQ2d 1069-70.

The analysis in these cases is directly applicable to the claim construction issue presented here. At various points, the common specification of the three patents indicates that

the claimed invention uses coaxial, rather than side-by-side lumens, i.e., that the guide wire lumen is contained within the inflation lumen and that the inflation lumen is annular. Read together, these portions of the common specification lead to the inescapable conclusion that the references in the asserted claims to an inflation lumen "separate from" the guide wire lumen must be understood as referring to coaxial lumens, and thus that the asserted claims read only on catheters having coaxial lumens.

First, the abstract of each of the patents refers to the intermediate sleeve section of the invention as including "an inner core tube which defines a guide wire lumen." The abstract adds that the inflation lumen is "continued as an annular inflation lumen" through the sleeve section of the catheter. Thus, from the outset the specification identifies the inflation lumen, as that term is used in the SciMed patents, as annular, i.e. coaxial rather than dual in structure.

Second, in discussing the disadvantages of certain prior art structures, the written description of each of the patents explains that the prior art catheters with shortened guide wire lumens "suffer from several disadvantages." The first cited disadvantage is that "[s]uch catheters have been one piece polyethylene catheters having dual lumen configurations adjacent their distal regions. Typically, such catheters have larger than necessary shaft sizes and are stiffer in their distal regions than would be desired...." '594 patent, col. 3, ll. 3-8; '482 patent, col. 3, ll. 5-10; '334 patent, col. 3, ll. 10-15. Thus, the SciMed patents distinguish the prior art on the basis of the use of dual lumens and point out the advantages of the coaxial lumens used in the catheters that are the subjects of the SciMed patents. That discussion in the written description supports the district court's conclusion that the claims should not be read so broadly as to encompass the distinguished prior art structure. *See, e.g., Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159. 47 USPQ2d

1829, 1833 (Fed. Cir. 1998) (specification distinguished prior art as inferior and touted advantages of a conical shaped cup for use in an artificial hip device; "[s]uch statements make clear that the '589 patent discloses *only* conical shaped cups and nothing further"); *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1304, 41 USPQ2d 1364, 1368 (Fed. Cir. 1997) ("[S]ince, by distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover, he is by implication surrendering such protection.").

Third, the "Summary of the Invention" portion of the patents describes "the present invention" as having a sleeve section with an inner core tube having a guide wire lumen extending through it and an outer sleeve defining "a longitudinally extending annular inflation lumen." '594 patent, col. 3, ll. 33-45; '482 patent, col. 3, ll. 34-46; '334 patent, col. 3, ll. 40-52. The characterization of the "present invention" includes several more references to the "annular inflation lumen" as well, *see* '594 patent, col. 3, ll. 58-59, 61, col. 4, ll. 43-44; '482 patent, col. 3, ll. 59-60, 62, col. 4, ll. 45-46; '334 patent, col. 3, ll. 65, 68, col. 4, ll. 51-52, and the "Conclusion" section of the written description again refers to the "guide wire lumen and annular inflation lumen" in the distal portions of the catheter. '594 patent, col. 14, ll. 26-28; '482 patent, col. 14, ll. 31-33; '334 patent, col. 3, ll. 41-44. As in the *Wang Labs* and *Modine* cases cited above, the characterization of the coaxial configuration as part of the "present invention" is strong evidence that the claims should not be read to encompass the opposite structure.

The most compelling portion of the specification, and the portion on which the district court principally focused, is the passage in the section entitled "Catheter Intermediate Sleeve Section" in which the inflation lumen is described as annular in structure, being formed from an outer sleeve or tube (the inflation lumen) and an inner core tube (the guide wire

lumen). *See* '594 patent, col. 7, ll. 26-28, 63-65; '482 patent, col. 7, ll. 29-31, 66-68; '334 patent, col. 7, ll. 41-43, col. 8, ll. 10-12. The patents then recite:

> The intermediate sleeve structure defined above is the basic sleeve structure for *all embodiments of the present invention contemplated and disclosed herein*--namely, an inner core tube bonded to a distal portion of the main catheter shaft, with an outer sleeve forming an annular continuation of the inflation lumen through the main shaft between the core tube and outer sleeve. As discussed below and illustrated herein, various configurations of the connections and components relative to the formation of the distal guide wire lumen, including the coupling of the main shaft to the intermediate sleeve section, are contemplated.

'594 patent, col. 8, ll. 3-14; '482 patent, col. 8, ll. 6-17; '334 patent, col. 8, ll. 18-29 (emphasis added).

This language defines SciMed's invention in a way that excludes the dual, or side-by-side, lumen arrangement. SciMed argues that the references to the annular inflation lumen are meant only to refer to the preferred embodiment of the invention, and not to indicate that the claims should be construed as limited to a structure employing coaxial lumens. That argument, however, flies in the face of the many statements in the written description that define "the invention" as employing a coaxial lumen structure and distinguish the prior art in part on the ground that it used a dual lumen structure, which had the disadvantage of making the shaft sizes of the catheters larger than necessary and making the catheters "stiffer in their distal regions than would be desired." '594 patent, col. 3, ll. 3-9; '482 patent, col. 3, ll. 5-11; '334 patent, col. 3, ll. 10-16. SciMed's argument is particularly unconvincing in the face of its own statement in the written description that the structure

containing coaxial lumens ("namely, an inner core tube bonded to a distal portion of the main catheter shaft, with an outer sleeve forming an annular continuation of the inflation lumen through the main shaft between the core tube and the outer sleeve") is "the basic sleeve structure for all embodiments of the present invention contemplated and disclosed herein." '594 patent, col. 8, ll. 4-9; '482 patent, col. 8, ll. 7-12; '334 patent, col. 8, ll. 19-24. That characterization of the invention cannot reasonably be interpreted as limited to the preferred embodiment, as SciMed argues, but is expressly made applicable to "all embodiments of the present invention."

The words "all embodiments of the present invention" are broad and unequivocal. It is difficult to imagine how the patents could have been clearer in making the point that the coaxial lumen configuration was a necessary element of every variant of the claimed invention. Moreover, there is no suggestion that the patentee made that statement unaware of the alternative dual lumen configuration, because earlier in the patent the patentee had distinguished the dual lumen configuration used in prior art devices as having disadvantages that the coaxial lumens used in the patented invention had overcome. *See* '594 patent, col. 3, ll. 1-22; '482 patent, col. 3, ll. 3-24; '334 patent, col. 3, ll. 8-29. (describing the dual lumen configuration). This is therefore a clear case of disclaimer of subject matter that, absent the disclaimer, could have been considered to fall within the scope of the claim language.

Citing *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998), and *Johnson Worldwide Assocs. v. Zebco Corp.* , 175 F.3d 985, 989-90, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999), SciMed argues that the only way in which statements in the written description can restrict the scope of a claim is by setting forth a specific, narrowing definition for a particular

claim term. As indicated by the cases discussed above, such as *Watts*, *Wang Labs*, *Cultor*, and *Tekmar*, SciMed's characterization of the role of the written description is too narrow. While it is true, of course, that "the claims define the scope of the right to exclude" and that "the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim," *Renishaw PLC*, 158 F.3d at 1248, 48 USPQ2d at 1121, the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format. *See, e. g., Phonometrics, Inc. v. Northern Telecom Inc.*, 133 F.3d 1459, 1466, 45 USPQ2d 1421, 1426-27 (Fed. Cir. 1998); *Gen. Am. Transp. Corp. v. Cryo-Trans, Inc.*, 93 F.3d 766, 769-70, 39 USPQ2d 1801, 1803-04 (Fed. Cir. 1996); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1577-78, 27 U.S.P.Q.2d 1837, 1840-41 (Fed. Cir. 1993); *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1566, 1567 (Fed. Cir. 1992). In this case, the written description makes clear that when the asserted claims refer to the respective locations of the guide wire and inflation lumens, and in particular when the claims refer to the inflation lumen as "extending through the catheter separate from" the guide wire lumen, the claim language refers to coaxial lumens.

Because the three SciMed patents make clear that the lumens referred to in the claims are all coaxial in structure, the district court was correct to construe the patents as disclaiming the dual lumen configuration. Under such a construction, SciMed concedes that no literal infringement can be found. The district court therefore properly entered summary judgment in favor of ACS on the issue of literal infringement.

III

In a separate opinion, the district court rejected SciMed's argument that ACS's accused devices infringed the three asserted patents under the doctrine of equivalents. We agree with the court that the doctrine of equivalents is inapplicable in this case and that the district court properly granted summary judgment to ACS on that issue.

As noted above, the common specification of SciMed's patents referred to prior art catheters, identified them as using the dual lumen configuration, and criticized them as suffering from the disadvantages of having "larger than necessary shaft sizes" and being "stiffer in their distal regions than would be desired." '594 patent, col. 3, ll. 6-8; '482 patent, col. 3, ll. 8-10; '334 patent, col. 3, ll. 13-15. That criticism of the dual lumen configuration was consistent with the evidence from SciMed witnesses and documents, which noted the advantages of the coaxial lumen configuration in increasing the flexibility of catheters and their ability to track through the coronary arterial system. The disclaimer of dual lumens was made even more explicit in the portion of the written description in which the patentee identified coaxial lumens as the configuration used in "all embodiments of the present invention."

Having specifically identified, criticized, and disclaimed the dual lumen configuration, the patentee cannot now invoke the doctrine of equivalents to "embrace a structure that was specifically excluded from the claims." *Dolly, Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 400, 29 USPQ2d 1767, 1771 (Fed. Cir. 1994). A particular structure can be deemed outside the reach of the doctrine of equivalents because that structure is clearly excluded from the claims whether the exclusion is express or implied. In *Moore, U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 56 USPQ2d 1225 (Fed. Cir. 2000), for example, the court considered a claim to a mailer-type business form in which

the longitudinal strips of adhesive extend "the majority of the lengths" of the longitudinal margins of the form. The patentee argued that the accused form, in which the longitudinal strips of adhesive extended a minority of the length of the longitudinal margin of the form, infringed under the doctrine of equivalents. The court rejected the argument, holding that "it would defy logic to conclude that a minority--the very antithesis of a majority--could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise." 229 F.3d at 1106, 56 USPQ2d at 1236. Similarly, in *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 42 USPQ2d 1737 (Fed. Cir. 1997), the patent claimed a process that included crystallizing a particular substance at high temperature "under an inert gas atmosphere." The patentee argued that certain of the accused processes, which used "heated air" rather than "an inert gas atmosphere" infringed under the doctrine of equivalents. The court rejected that argument, explaining that "the claim language specifically excludes reactive gases--such as 'heated air'--from the scope of the claims" and in light of that specific exclusion, the accused processes could not infringe under the doctrine of equivalents. 114 F.3d at 1561, 42 USPQ2d at 1747. In each of these cases, by defining the claim in a way that clearly excluded certain subject matter, the patent implicitly disclaimed the subject matter that was excluded and thereby barred the patentee from asserting infringement under the doctrine of equivalents.

The court did effectively the same thing in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 44 USPQ2d 1103 (Fed. Cir. 1997). In that case, the claim was to a syringe disposal container having an elongated slot at the top of the container body and a "first constriction extending over said slot." Although those limitations did not literally read on the accused device, the patentee argued that

the device infringed under the doctrine of equivalents. The court rejected that argument, noting that the claim

> defines a relatively simple structural device. No subtlety of language or complexity of the technology, nor any subsequent change in the state of the art, such as later-developed technology, obfuscated the significance of this limitation at the time of its incorporation into the claim. . . . If Sage desired broad patent protection for any container that performed a function similar to its claimed container, it could have sought claims with fewer structural encumbrances. . . . [A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.

126 F.3d at 1425, 44 USPQ2d at 1107. Thus, the court determined that because the scope of the claim was limited in a way that plainly and necessarily excluded a structural feature that was the opposite of the one recited in the claim, that different structure could not be brought within the scope of patent protection through the doctrine of equivalents. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1317, 47 USPQ2d 1272, 1277 (Fed. Cir. 1998) (subject matter is "specifically excluded" from coverage under the doctrine of equivalents if its inclusion is "inconsistent with the language of the claim").

Finally, in *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996), the court addressed a claim directed to a system for stringing tennis rackets with splayed strings. The court construed the claim to require that the stringing system produce rackets with at least three different splay-creating offset distances for the strings. Having construed the claim

in that manner, the court held that, for purposes of the doctrine of equivalents, "the properly construed claim *cannot* have an equivalent in a racket with only two offset distances," i.e., the two-distance splayed string system was "specifically excluded from the scope of the claims." 73 F.3d at 1582, 37 USPQ2d at 1373 (quoting *Dolly*, 16 F.3d at 400, 29 USPQ2d at 1771). *See also Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc.*, 206 F.3d 1408, 1416, 54 USPQ2d 1141, 1147 (Fed. Cir. 2000) ("[N]o reasonable jury could find that a stop which extends to the peripheral edge of a disk is equivalent to one that is 'substantially inward' of the very same disk."); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 541, 41 USPQ2d 1023, 1029 (Fed. Cir. 1996) (doctrine of equivalents does not extend to an accused device in which "the required structure is specifically excluded" by the patent).

The principle articulated in these cases is akin to the familiar rule that the doctrine of equivalents cannot be employed in a manner that wholly vitiates a claim limitation. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29-30, (1997); *Athletic Alternatives*, 73 F.3d at 1582, 29 USPQ2d at 1771 ("specific exclusion" principle is "a corollary to the 'all limitations' rule"). Thus, if a patent states that the claimed device must be "non-metallic," the patentee cannot assert the patent against a metallic device on the ground that a metallic device is equivalent to a non-metallic device. The unavailability of the doctrine of equivalents could be explained either as the product of an impermissible vitiation of the "non-metallic" claim limitation, or as the product of a clear and binding statement to the public that metallic structures are excluded from the protection of the patent. As the court made clear in *Sage*, the foreclosure of reliance on the doctrine of equivalents in such a case depends on whether the patent clearly excludes the asserted equivalent structure, either implicitly or explicitly.

In that respect, this case is an even stronger one for not applying the doctrine of equivalents than cases such as *Dolly*, *Sage*, *Eastman Kodak*, *Moore*, and *Athletic Alternatives*. Each of the SciMed patents specifically recognized and disclaimed the dual lumen structure, making clear that the patentee regarded the dual lumen configuration as significantly inferior to the coaxial lumen configuration used in the invention. Where such an explicit disclaimer is present, the principles of those cases apply *a fortiori*, and the patentee cannot be allowed to recapture the excluded subject matter under the doctrine of equivalents without undermining the notice function of the patent. As the court observed in *Sage*, the patentee had an opportunity to draft the patent in a way that would make clear that dual lumens as well as coaxial lumens were within the scope of the invention, but the patentee did just the opposite, leaving competitors and the public to draw the reasonable conclusion that the patentee was not seeking patent protection for catheters that used a dual lumen configuration. Under these circumstances, the district court was justified in concluding that a reasonable jury could not find that the accused devices infringe the SciMed patents under the doctrine of equivalents.

AFFIRMED.

DYK, *Circuit Judge*, concurring.

On the facts of this particular case, I agree with the result reached by the majority, and I join the opinion. I also agree with the majority that "the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format." The problem is that our decisions provide inadequate guidance as to when it is appropriate to look to the specification to narrow the claim by interpretation and when

it is not appropriate to do so. Until we provide better guidance, I fear that the lower courts and litigants will remain confused.

APPENDIX B

INTELLECTUAL PROPERTY TODAY

NARROW CLAIMING AND THE SCOPE OF EQUIVALENTS[1]

BY CORWIN P. UMBACH, PH.D., OF OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

March 2001

"I meant what I said And I said what I meant....".[2]

Corwin P. Umbach, Ph.D. is a patent attorney and an associate in the chemical practice group of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. of Arlington, Virginia. The opinions expressed herein are solely those of the author and do not represent those of Oblon, Spivak, McClelland, Maier & Neustadt, P.C.. Contact: CUMBACH@OBLON.COM.

Federal Circuit decisions over the past five years have shown that what is meant in a patent as the scope of the invention can in some circumstances actually be found in the claims. A court can find, even in the absence of limiting prosecution history or prior art, a limited scope of equivalents for narrowly drawn claims. A stark demonstration of the limiting effect of narrow claim language is found in the recent decision in *Moore U.S.A., Inc. v. Standard Register Co.*[3], where the Federal Circuit held that 47.8% is not an equivalent of a claimed "majority" (i.e., 50.001%+).

Under the doctrine of equivalents, a product or process

that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is "equivalence" between the elements of the accused product or process and the claimed elements of the patented invention.[4] Equivalence is a question of fact[5] based on insubstantial differences between the accused product or process and the claimed elements.[6] The essential inquiry is whether the accused product or process contains elements identical or equivalent to each claimed element of the patented invention.[7] The doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole.[8] The doctrine of equivalents cannot effectively eliminate an element in its entirety.[9] The prosecution history[10] of a patent and the prior art[11] both serve as legal limits to the scope of equivalents.

The doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.[12] There is an inherent conflict between the role of the doctrine of equivalents in preventing a fraud on the patent' and the primacy of the claims in defining the scope of a patentee's exclusive rights.[13]

Over the past five years the Federal Circuit has issued a series of decisions developing a framework for restricting the scope of equivalents based on narrow claim language. In one approach, the Federal Circuit has focused on whether embodiments disclosed, but not claimed, were "distinct" enough from claimed embodiments to exclude the unclaimed embodiments as equivalents. In a second approach, the Federal Circuit has relied on the "foreseeability" of the limiting potential of "clear structural limitations" to limit equivalents. In a third approach, the Federal Circuit in an unpublished opinion relied on "clear definite numerical limitations". The Federal Circuit used all three approaches, either explicitly or implicitly, in reaching the *Moore*

decision.

EMBODIMENTS THAT ARE "DISTINCT", BUT NOT CLAIMED

The 1996 Federal Circuit decision in *Maxwell v. J. Baker, Inc.*[14] (Lourie, Skelton and Schall) signaled that "subject matter disclosed by not claimed in a patent application is dedicated to the public".[15] The Maxwell patent concerns fastening tabs in shoes. A plastic filament passing through the fastening tabs keeps a pair of shoes together for display in stores. The patent disclosed and claimed a first embodiment in which a portion of a fastening tab was positioned between the inner and outer soles on the bottom of the shoe. In addition, the patent disclosed, but did not claim, an alternative embodiment in which the fastening tab was stitched into a lining seam of the shoes at the sides or back of the shoes. Because the patent did not claim the alternative embodiment, the Federal Circuit found that Maxwell dedicated the alternative embodiment to the public.

In 1998 the *Federal Circuit in YBM Magnex Inc. v. International Trade Commission*[16] (Rich, Smith and **Newman**) clarified the *Maxwell* decision and indicated that a patent disclosing two ***distinct*** embodiments, while claiming only one, could not enforce the unclaimed embodiment as an equivalent of the embodiment that was claimed.[17] Thus, the *YBM Magnex* court reasoned that in *Maxwell* a fastening tab attached to the bottom of a shoe and a fastening tab attached to the side of a shoe were distinct embodiments. Because only one of these distinct embodiments was claimed, the other was dedicated to the public.

In *YBM Magnex*, in contrast to *Maxwell*, the Federal Circuit declined to find distinct embodiments. YBM was the owner of a patent with claims directed to "[a] permanent magnet alloy consisting essentially of, in weight percent, ... 6,000 to 35,000 ppm oxygen ... ." The patent disclosed, but did not claim, oxygen contents in the range between 5,450

and 6,000 ppm. The Federal Circuit found that *Maxwell* did not foreclose, as a matter of law, application of the doctrine of equivalents to encompass oxygen contents of 5,450 to 6,000 ppm.

The utility of the "distinct, but not claimed, embodiment" approach to limiting the scope of equivalents of narrow claims is questionable at present. What makes one embodiment "distinct" and another not? Until the Federal Circuit defines a "distinct embodiment", instead of simply concluding the existence of more than one, the approach provides little guidance to the public. Interestingly, while Judge Newman authored the *YBM Magnex* opinion advancing the "distinct, but not claimed, embodiment" approach, in the *Moore* decision (discussed below) Judge Newman dissented against the panel majority's finding of a distinct, unclaimed embodiment dedicated to the public.[18] It would appear that what now passes as a "distinct embodiment" is in the eye of the beholder.

"FORESEEABLE" LIMITING POTENTIAL OF "CLEAR STRUCTURAL LIMITATIONS"

The second approach to limiting the scope of equivalents of narrow claims is found in the 1997 Federal Circuit decision in *Sage Products Inc. v. Devon Industries Inc.*[19] (Mayer, **Rader** and Schall). This approach focuses on the "foreseeable" limiting potential of "clear structural limitations". In *Sage Products*, the Federal Circuit affirmed a summary judgment that an accused medical waste disposal container with two interior constrictions and a slot between the two interior constrictions is not an equivalent of a disposal container with "an elongated slot at the *top* of the container body" and "a barrier means comprising a first constriction extending *over* said slot". After finding that the limitation "top" meant "highest point" and the limitation "over" meant "above", the Federal Circuit concluded that each of the patentee's theories of infringement by

equivalents would improperly eliminate at least one limitation from the claims.

The Federal Circuit emphasized that:

> "Because this issued patent contains clear structural limitations, the public has a right to rely on those limits in conducting its business activities. This court will not remove such a limitation under a doctrine designed to prevent fraud on a patent'".[20] (emphasis added)

> "...[A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of his failure to seek protection for this foreseeable alteration of its claimed structure."[21] (emphasis added)

> "For a patentee who has claimed an invention narrowly, there may not be infringement under the doctrine of equivalents in many cases, even though the patentee might have been able to claim more broadly. If it were otherwise, then claims would be reduced to functional abstracts, devoid of meaningful structural limitations on which the publish could rely."[22] (emphasis added)

Thus, in *Sage Products*, the Federal Circuit found that "clear structural limitations" with foreseeably narrow meanings could restrict the scope of equivalents. However, the Federal Circuit provided little guidance to the public regarding what is, and is not, clearly structural and "foreseeable".

In *Tanabe Seiyaku Co. v. International Trade Commission*[23] (**Plager**, Schall and Bryson), the Federal Circuit affirmed a decision by the ITC that an accused process did not infringe a claim directed to a method of preparing a benzothiazeprine derivative. The Federal Circuit

concluded that in *Tanabe Seiyaku* the accused process using butanone (CH_3-CH_2-CO-CH_3) was not an equivalent of the claimed process using acetone (CH_3-CO-CH_3). The relevant limitation recited "acetone", which is a species of the genus "lower alkyl ketone". Because "lower alkyl acetate" was disclosed in the specification, the Federal Circuit reasoned that the skilled artisan would know that the patentee could have used the term "lower alkyl ketone" to describe a class of ketone solvents including butanone and acetone, if the patentee had so intended. Because the patentee did not due so, but instead sharply restricted the claims, the scope of equivalents was correspondingly narrow.[24] Thus, in *Tanabe Seiyaku* the Federal Circuit indicated that reciting a narrow chemical species in a claim, when use of a broader chemical genus including the species is foreseeable, will exclude compounds falling within the genus other than the species from the scope of equivalents of the species.

In *Overhead Door Corp. v. Chamberlain Group Inc.*[25] (Michel, **Rader** and Schall) the Federal Circuit did ***not*** find "clear structural limitations" that would limit equivalents. In *Overhead Door*, the Federal Circuit overruled a summary judgment that a software-driven memory selection system was outside the scope of equivalents of a hardware memory selection switch as a matter of law. The Federal Circuit found that the district court's reliance on *Sage Products* was inappropriate because the patent at issue did not contain any clear structural limitations that would preclude a reasonable jury from finding a software system to be equivalent to the claimed hardware. In contrast to the situation in *Sage*, application of the doctrine of equivalents to cover the accused software did not vitiate the "memory selection switch" element.[26]

In *Zodiac Pool Care Inc. v. Hoffinger Industries Inc.*[27] (Bryson, Skelton and **Gajarsa**), the Federal Circuit affirmed a judgment as a matter of law that an accused pool cleaning

system did not include an equivalent of a stop, for preventing upward flexing of a peripheral edge of a flexible disc surrounding a water inlet, that was "*substantially inward* of the peripheral edge". The Federal Circuit refused to consider function/way/result issues in view of "clear structural limitations" present in the claims and absent in the accused system. Relying heavily on *Sage Products*, the Federal Circuit found that no reasonable jury could find that an accused stop which extends to the peripheral edge of a disk is equivalent to one that is "substantially inward" of the very same disk.[28] To the Federal Circuit, the two stops were "not even close".[29] Thus, in *Zodiac Pool Care* the Federal Circuit reiterated its decision in *Sage Products* that clear structural limitations alone can limit the scope of equivalents.

In *Vehicular Technologies Corp. v. Titan Wheel International Inc.*,[30] (Plager, Clevenger and Rader, **per curiam**) the Federal Circuit affirmed a summary judgment that, as a matter of law, an accused spring assembly including a single spring and a plug fitted into the spring and bearing against a pin is not the equivalent of a "spring assembly consisting of two concentric springs bearing against one end of [a] pin". The Federal Circuit found that the claimed two spring assembly performed a key backup function that was not performed by the accused device. However, rather than considering differences in this function on the scope of equivalents, the court focused on the requirement in the claim that two springs be present. While acknowledging that the recitation "consisting of" did not foreclose infringement by equivalents, the court felt that this recitation emphasized that, to infringe by equivalents, an infringing structure had to include two springs. In a concurring opinion, Judge Rader likened *Vehicular Technologies Corp. to Sage Products, Inc.*, finding that a skilled patent drafter would have readily seen the limiting potential of the "consisting of two concentric springs" limitation as excluding from equivalents structures with

fewer than two springs. Judge Rader had little sympathy for the patentee, who had learned of the accused infringement during the two year period allowed for reissuing, but failed to amend the claims to cover the accused single spring device.

CLEAR, DEFINITE NUMERICAL LIMITATIONS

A third approach limiting the scope of equivalents of narrow claims is found in the March 31, 1998, Federal Circuit decision in *Brunswick Corp. v. U.S.*[31] (Mayer, Newman and **Clevenger**)(unpublished), prior to the *YBM Magnex* decision on May 27, 1998, discussed above. The *Brunswick* court assertedly followed the holding in *Maxwell* that "subject matter that is disclosed in the specification, but not claimed, is dedicated to the public". The *Brunswick* majority affirmed a finding by the U.S. Court of Federal Claims that certain unmodified polyester/steel cloth screens did not infringe a patent directed to radar camouflage screens under the doctrine of equivalents.

In *Brunswick*, the claimed camouflage included an electrically resistive layer having, at radio frequencies exceeding 2000 MHz, "a surface resistivity falling between a **lower limit** of 100 ohms and an **upper limit** of 1,000 but considerably different from 377 ohms".

However, in following *Maxwell*, the *Brunswick* majority focused on the limiting nature of the claims. Without being explicit, the panel majority appeared to be focusing on differences in how numerical ranges are claimed to decide whether or not the numerical limitations limit the scope of equivalents.

> "Nor do we understand the rule of *Maxwell*, supported by the broad concept of dedication to the public of disclosed but unclaimed matter, to be any less applicable to a case in which a **clear, definite numerical limitation** is placed on a claimed range

> than to a case in which an alternative configuration of an article is disclosed but not claimed. In any event, this case certainly does not mean that all subject matter outside the literal claims, of whatever nature, is dedicated to the public in all situations."[32] (emphasis added).

Thus, while ostensibly following *Maxwell*, the panel majority appeared to find that a "clear, definite numerical limitation" can, by itself, limit the scope of equivalents of a numerical limitation, much the same as *Sage Products* found that a "clear structural limitation" can, by itself, limit the scope of equivalents of a structural limitation. Although the scope of equivalents sought by *Brunswick* included surface resistivities disclosed in the specification, because the accused product was outside the definite limits recited in the claim, the panel majority found no infringement by equivalents. Thus, in *Brunswick* the recitation of "lower **limit**" and "upper **limit**" limited numerical equivalents to the recited range. The majority contrasted "lower limit" and "upper limit" with less definite limitations such as "relatively small", "about" and "approximately", which presumably do not limit numerical equivalents.[33]

THE MOORE DECISION

The three approaches discussed above came together in the September 22, 2000, decision *Moore U.S.A., Inc. v. Standard Register Company*[34] (Newman, **Michel** and Clevenger). In *Moore*, the Federal Circuit affirmed a summary judgment that an accused mailer type business form, with adhesive running 47.8% of the length of margin, did not, as a matter of law, infringe by equivalents a claim in which the adhesive extended a "majority" of the length of the margin.

In emphasizing the second approach ("foreseeable" limiting potential of "clear structural limitations" from *Sage*) to limiting the scope of equivalents of narrow claims, the

court focused on the foreseeable narrowness of the claimed "majority".

> "If our case law on the doctrine of equivalents makes anything clear, it is that all claim limitations are not entitled to an equal scope of equivalents. Whether the result of the All Limitations Rule [citation omitted], prosecution history estoppel [citation omitted], or the **inherent narrowness of the claim language** [citation omitted], many limitations warrant little, if any, range of equivalents.
>
> In this case, we hold that the applicant's use of **the term "majority" is not entitled to a scope of equivalents covering a minority** for at least two reasons. First, to allow what is undisputedly a minority (i.e. 47.8%) to be equivalent to a majority would vitiate the requirement that the "first and second longitudinal strips of adhesive ... extend the majority of the length of said longitudinal marginal portions." [citation to 464 patent omitted]. If a minority could be equivalent to a majority, this limitation would hardly be necessary, since the immediately preceding requirement of a "first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face" would suffice. Second, it would defy logic to conclude that a minority — the very antithesis of a majority — could be insubstantially different from a claim limitation requiring a majority, and **no reasonable juror could find otherwise**."[35] (emphasis added)

The court also applied the first approach ("distinct, but unclaimed, embodiments" from *Maxwell* (as clarified in *YBM Magnex*)) to limiting the scope of equivalents of narrow claims:

> "[W]hile Moore argues that the written description's teaching that the length of the first and second strips may be about "half of the length" of the longitudinal marginal portions gives rise to a scope of equivalents that would cover a "minority," our case law reveals that Moore is mistaken. In *Maxwell v. J. Baker, Inc.* [citation omitted], we explained the contrary principle the "subject matter disclosed in the specification, but not claimed, is dedicated to the public" in determining infringement under the doctrine of equivalents. Id. at [citation omitted]. Having fully disclosed two **distinct** embodiments, one in which the first and second longitudinal strips extend a majority of the length of the longitudinal marginal portions, and one in which they do not, Moore is not entitled to "enforce the unclaimed embodiment as an equivalents of the one that was claimed." *YBM Magnex, Inc. v. International Trade Comm'n* [citation omitted].[36] (emphasis added)

The third approach ("clear, definite numerical limitations" from *Brunswick*) to limiting equivalents is also implicit in *Moore*, because the structure at issue in the accused product was no different than the structure featured in the claim. Both structures were strips of adhesive. Only the numbers associated with the lengths of the strips were different.

Thus, the *Moore* decision marked the coming together of the three approaches used in recent years by the Federal Circuit to limit equivalents of narrow claims. Particularly remarkable in *Moore* is the majority's willingness, despite the disclosure of adhesive strips running less than a majority of the margin, to draw a clear distinction between 47.8% and 50+%, and to exclude 47.8% from the Moore invention,

based on Moore's choice of "majority" as an explicit claim limitation.

WHAT WILL BE HATCHED IN THE FUTURE?

The recent decisions culminating in *Moore* show that the Federal Circuit is willing to find legal limits on the scope of equivalents based solely on the narrowness of claim limitations. The narrow limitations can be structural or numerical.

What the Federal Circuit will, and will not, consider to be a "clear structural limitation" with "foreseeable" limiting potential remains to be seen.

On the other hand, the cases provide some guidance regarding what the Federal Circuit will consider to be a "clear, definite numerical limitation" that limits the scope of equivalents.

It appears that the Federal Circuit will restrict equivalents of claim limitations asserting, for whatever reason, an abrupt boundary to a range of numbers defining an invention. The assertion of an abrupt boundary can be found in the explicit or implicit use of imperative claim language.

For example, in *Moore* the limitation "majority", which cannot encompass a minority, implicitly means "*no less than* greater than 50%". The imperative "no less than" means that anything "less than" is outside the invention.

Similarly, in *Brunswick* the recitation of lower and upper "limits" expresses a imperative that anything outside the bounds set by the limits is outside the invention.

In light of *Brunswick* and *Moore*, it appears that the Federal Circuit will probably find that imperative claim language (explicit or implicit) such as "no less (greater) than", "not less (greater) than" and "at least (most)" (which is similar in tone and meaning to "not less (greater) than")

will sharply limit equivalents, much like *Moore's* "majority". To find an equivalent outside the range defined by one of these imperative limitations would impermissibly eliminate from a claim the imperative feature of the limitation.

What numerical language will not limit equivalents? *Brunswicks* comparison of a lower "limit" and an upper "limit" with inexact terms such as "relatively small", "about" and "approximately" indicates that inexact limitations such as "from about A to about B" do not limit numerical equivalents. *YBM Magnex*, e.g., confirms that an explicit recitation of a numerical range such as "from A to B" also does not limit equivalents. Because claim language such as "less (greater) than A" replaces "less(greater) than" for the B end of a range "from A to B", without asserting anything about the A end of the range, claim language such as "less (greater) than A" should not limit equivalents of the A endpoint. Thus, the recitation of a numerical range without expressing an imperative should not limit the scope of numerical equivalents.

Thus, it appears that substitution of "greater than 50%" for the "majority" limitation in *Moore* would have avoided the sharply restricted scope of equivalents accorded the Moore claims.

Following *Moore*, it becomes even more important that the claim drafter say in the claim what the drafter means, and mean what the drafter says, so that the drafter remains "faithful one hundred per cent" to whatever has been invented.

ENDNOTES

[1] © Corwin P. Umbach 2000.

[2] "I meant what I said
And I said what I meant....
An elephant's faithful
One hundred per cent!"
Geisel, Theodor Seuss, *Horton Hatches The Egg*,

Random House, New York (c. 1968)

[3] *Moore U.S.A. Inc. v. Standard Register Co.*, 56 USPQ2d 1225 (Fed. Cir. 2000).

[4] *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 USPQ2d 1865, 1868 (1997), *citing Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 85 USPQ 328, 330-331 (1950).

[5] *Hilton Davis Chemical co. v. Warner-Jenkinson Co. Inc.*, 36 USPQ2d 1641, 1647 (Fed. Cir. 1995).

[6] *Id.*, at 1645.

[7] *Warner-Jenkinson*, at 1875.

[8] *Id.*, at 1871.

[9] *Id.*.

[10] *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865 (Fed. Cir. 2000). In this en banc decision the Federal Circuit rejects its previous "flexible bar approach" and adopts a "strict rule of complete surrender" of equivalents when a claim element is narrowed by amendment during prosecution. In stressing the need for certainty as to the scope of patent protection, the *Festo* court emphasizes the public-notice function of patent claims as being paramount. While *Festo* does not address the narrow claiming issues discussed in this article, the *Festo* theme of public-notice is apparent in the Federal Circuit's recent approach to the scope of equivalents of narrow claims.

[11] *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 14 USPQ2d 1942 (1990).

[12] *Warner-Jenkinson*, at 1871.

[13] *Sage Products Inc. v. Devon Industries Inc.*, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997), *citing Charles Geiner & Co. v. Mari-Med Mfg., Inc.*, 22 USPQ2d 1526, 1529 (Fed. Cir. 1992).

[14] *Maxwell v. J. Baker, Inc.*, 39 USPQ2d 1001 (Fed.Cir. 1996)

[15] *Id.*, at 1006.

[16] *YBM Magnex Inc. v. International Trade Commission*, 46 USPQ2d 1843 (Fed. Cir. 1998).

[17] *Id.*, at 1846.

[18] *Moore*, at 1246.

[19] *Sage Products Inc. v. Devon Industries Inc.*, 44 USPQ2d 1103 (Fed. Cir. 1997).

[20] *Sage Products*, at 1108.

[21] *Id.*, at 1107.

[22] *Id.*

[23] *Tanabe Seiyaku Co. v. International Trade Commission*, 41 USPQ2d 1976 (Fed. Cir. 1997).

[24] *Id.*, at 1982.

[25] *Overhead Door Corp. v. Chamberlain Group Inc.*, 52 USPQ2d 1321 (Fed. Cir. 1999).

[26] *Id.*, at 1327.
[27] *Zodiac Pool Care Inc. v. Hoffinger Industries Inc.*, 54 USPQ2d 1141 (Fed. Cir. 2000)
[28] *Id.*, at 1147.
[29] *Id.*
[30] *Vehicular Technologies Corp. v. Titan Wheel International Inc.*, 54 USPQ2d 1841 (Fed. Cir. 2000).
[31] *Brunswick Corp. v. U.S.*, 46 USPQ2d 1446 (Fed. Cir. 1998)(unpublished).
[32] *Id.*, at 1450.
[33] *Id.*
[34] *Moore, supra.*
[35] *Id.*, at 1235-1236.
[36] *Id.*, at 1236.

APPENDIX C

AMERICAN LAWYER MEDIA
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What's Left of the Doctrine of Equivalents?

By Steven E. Koffs

January 4, 2001

The U.S. Court of Appeals for the Federal Circuit altered the face of patent litigation with its sweeping en banc decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 2000 U.S. App. LEXIS 29979, 56 U.S.P.Q.2d (BNA) 1865* (Fed. Cir. Nov. 29, 2000). The Festo decision marks a swing of the pendulum away from broad expansion of patent rights under the judicially created doctrine of equivalents and towards greater certainty in the scope of patents.

The patent statutes require a patent applicant to particularly point out and distinctly claim the subject matter regarded as the invention. The scope of any patent that issues is then limited by the claims. The courts have long recognized that an infringer should not be able to avoid liability for infringement by changing only minor or insubstantial details of a claimed invention. The doctrine of equivalents was created to strike a balance between ensuring that the patentee enjoys the full benefit of her patent and ensuring that the claims of the issued patent give the public fair notice of what subject matter is protected by the patent. Under the doctrine of equivalents, an infringer who makes a minor, insubstantial change to one of the claimed features but literally practices all the remaining elements of the claimed invention is still liable. Prosecution history estoppel

provides a limit to the expansion of patent scope under the doctrine of equivalents. Upon issuance of a patent, the full written record before the patent office is opened to the public. If the applicant had amended his or her application or argued a position before the patent examiner in order to obtain a patent, the patent owner is subsequently prevented from expanding the patent under the doctrine of equivalents to cover the subject matter that was surrendered before the patent office. Prosecution history estoppel protects the public-notice function of the claims. In spite of these seemingly simple rules, application of the doctrine of equivalents has long remained one of the most difficult and contentious tasks in patent litigation. The answers to two broad questions remained elusive: Under what circumstances is subject matter surrendered? How much is surrendered? Prior to the Festo decision, it was generally assumed that subject matter was only surrendered if the applicant amended the claims to distinguish the invention from the prior art or argued the importance of a distinguishing feature of the invention to overcome a prior-art rejection. Amendments that were made to clarify or render the claims more definite did not prevent the invocation of the doctrine of equivalents. Similarly, amendments to make the invention conform to one of the four statutory subject matter classes (process, machine, article of manufacture or composition of matter) did not preclude application of the doctrine of equivalents. It became common (some would say, automatic) for patentees to argue during litigation that the reason for an amendment was not to distinguish the invention from the prior art, but to make the claims more definite. Festo closed this door to patentees by holding that any amendment or argument made by the patentee related to any statutory requirement for patentability creates prosecution history estoppel. Estoppel is now created by amendments or arguments relating to any of the following additional criteria: membership of the

invention in one of the four statutory classes; the presence of an adequate written description of the invention in the original application; adequacy of the application to enable one skilled in the field to practice the claimed invention; and disclosure of the best mode of practicing the invention, definiteness of the claims or claiming the subject matter the applicant regards as the invention. The Festo decision also holds that voluntary amendments not made in response to any rejection by the examiner that narrow the claims create prosecution history estoppel in the same manner as involuntary amendments required by the patent examiner. The most controversial holding in the Festo case is that when a claim amendment creates prosecution history estoppel with regard to a claim element, there is no range of equivalents available for the amended claim element. Prosecution history estoppel creates a complete bar to the doctrine of equivalents. Previously, the Federal Circuit had frequently applied a flexible-bar approach, allowing application of the doctrine of equivalents where the accused device was not similar to the prior art that provoked the amendments. In rejecting this approach, the court explained that the paramount function of the claims is the notice function; the discarded flexible-bar approach did not produce consistent results or provide guidance to the marketplace. The Federal Circuit reaffirmed a previous holding that, when no explanation for a claim amendment is established, no range of equivalents is available for the amended claim element. In applying this rule in the Festo case, the Federal Circuit further required that, "In order to give due deference to public notice considerations . . . a patent holder seeking to establish the reason for an amendment must base his arguments solely upon the public record of the patent's prosecution, i.e., the patent's prosecution history. "If there is no reason stated in the prosecution history, a patentee can no longer introduce extrinsic evidence in court to prove that the reason for the amendment was unrelated to patentability.

The Federal Circuit demonstrated these new rules by applying them to the facts of Festo. The court compared the canceled original claims to the later-added claims and determined that the differences constituted surrendered subject matter, even though the later-added claims were not "amended." The court also held that an amendment replacing a "means-plus-function" element defined by its function, instead of its structure with the corresponding structure was a narrowing amendment and precludes any range of equivalence for that element. In the past three years, the Federal Circuit has whittled away at the availability of the doctrine of equivalents in several different contexts. During this period, the Federal Circuit has repeatedly held that "inherently narrow" claim language can in some cases preclude any application of the doctrine of equivalents, regardless of the absence of prosecution history estoppel. For example, the court held that a claim requirement for a "majority" inherently could not be met under the doctrine of equivalents by 47.8 percent (stating that "a majority" cannot be insubstantially different from a minority) in *Moore U.S.A., Inc. v. Standard Register Co., 229 F.3d 1091, 56 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2000).* Further, the court has held that the doctrine of equivalents is generally not available for "means-plus-function" elements if there is no literal infringement, unless the accused device relies on later-developed technology to circumvent the claim limitation. See *Chiuminatta Concrete Concepts, Inc., v. Cardinal Industries Inc., 145 F. 3d 1303 (Fed. Cir. 1998).* Seen in the context of these other cases, the Festo decision appears to be just one more step on the road towards a patent system in which the literal claim language is almost always determinative, and the doctrine of equivalents is only available in a minimal number of cases unavoidably required by U.S. Supreme Court precedents. Although the rare patent application is allowed on its first examination, amended applications are the rule, not the exception. On the basis of

the estoppel rules applied in the courts up until 1996, it was very common for applicants to make voluntary amendments with little or no explanation on the written record. In the case of these previously issued patents still in effect, there is little that a patentee can now do to overcome the burden created by Festo and avoid any finding of prosecution history estoppel. In many cases where patentees previously might have disputed whether prosecution history estoppel applied, the existence of estoppel is now a foregone conclusion, and the battleground issue is, "What is the boundary of the element that is subject to the estoppel, for which equivalence is barred? "The court did not explain whether the amended element refers only to the specific words added to a claim or to the whole clause in which the word is added. It appears that patentees still have room to argue that the subject matter surrendered consists only of the specific words added to the claim. For example, if a clause of an original claim requires "a microcomputer having a display and a keyboard," and the amended clause requires "a microcomputer having a display, a keyboard, and a pointing device," the patentee can argue that the element surrendered is a system without a pointing device. In other words, the patentee can argue that equivalents may be substituted for the microcomputer, the display or the keyboard, so long as the pointing device is literally present. (Of course, the accused infringer will most certainly argue that the doctrine is completely barred with respect to the microcomputer, the display, the keyboard and the pointing device and that the patent does not cover a system in which an equivalent is substituted for any of these devices.) Another remaining battleground issue is whether narrower original claims that were never amended or argued are eligible for the doctrine of equivalents after issuance, if broader original claims were rejected or canceled during prosecution. Festo does not give a clear indication on this question. A similar question remains unanswered with respect to narrower original claims that the examiner found

to contain allowable subject matter, and were only amended as to matters of form. It is not clear whether the existence of broader original claims that were rejected or canceled during prosecution would preclude doctrine of equivalents for the issued narrower claims. Until these issues are decided, patentees should argue for the continuing availability of the doctrine in these circumstances (and accused infringers should argue that estoppel is present, barring application of the doctrine). In view of the Festo decision, most patentees will probably be more reluctant than ever to enforce their patents, where infringement only lies under the doctrine of equivalents. If that occurs, the Federal Circuit's goal of increasing predictability and clearer guidance through the notice function of claims will have been achieved. The Festo decision will also change the way in which patent rights are procured. For any invention for which a patent may potentially be enforced in court, there is little alternative but to vigorously traverse any arguably improper rejection, and appeal any adverse decision of the examiner where there is a reasonable likelihood of reversal. Extra time spent studying the prior art before drafting the patent application is well spent, enabling the patent drafter to craft claims of the proper scope and minimizing the necessity for amendments that lead to prosecution history estoppel. Unfortunately, this will increase the initial costs of the patent application for inventors. Also, there is no guarantee that the examiner will recognize the distinguishing features of even the most carefully crafted claim. An improper rejection by the examiner will require the applicant to file explanatory arguments, creating the same prosecution history estoppel the drafter seeks to avoid. For any allowed (ready for issue) patent application that is potentially important enough to be enforced, the prosecuting attorney should ensure that a continuing application is filed before the allowed application issues as a patent. Until the activities of a potential infringer are precisely identified, it is impossible to know whether any

of the issued claims provide exactly the right coverage needed to succeed in an infringement action without relying on the doctrine of equivalents. By keeping a continuing application pending, the patentee is positioned to add or amend claims to obtain exactly the coverage required to make a showing of literal infringement, and avoid disputes over equivalence. The patent regulations allow the applicant to petition to advance the examination of the application when an infringer has already been identified, so the continuing application can be expedited. A concurring opinion in Festo suggests that patent drafters may now begin claiming inventions narrowly, to obtain immediate allowances (avoiding prosecution history estoppel), and actually rely more heavily on the doctrine of equivalents during litigation. Given the likelihood that the Federal Circuit will continue its antipathy towards finding infringement under the doctrine of equivalents, adoption of this strategy appears to be ill-advised.

steven e. koffs is a partner in the Philadelphia office of Duane Morris & Heckscher, where his practice emphasizes intellectual property law. Koffs can be reached at sekoffs * duanemorris.com.

APPENDIX D

Professor Kayton's April 2001 Program
The Westin Innisbrook Resort
TRIANGULATED BY TAMPA BAY, CLEARWATER BEACH,
AND TARPON SPRINGS, FLORIDA
FINAL REMINDER

April 22 – 24 Sunday, Monday & Tuesday
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COURSE DESCRIPTION

The patent bar, more than ever before, must be or become expert in the nuances, variations, inconsistencies, and virtually daily new developments of the U.S. Court of Appeals for the Federal Circuit. In no other way can a patent practitioner serve his or her clients effectively and practice with a modicum of peace of mind.

After many years of genuinely building a foundation of doctrinal stability in the law of §102 and §103, the Federal Circuit's law relative to invalidity under §112, para. 1, literal infringement, the doctrine of equivalents, and §112, para. 6 claim construction, has fallen into a state of disarray comparable to that which characterized the regional Circuit Courts of Appeals prior to 1982.

The Federal Circuit's various panels' lack of coherent doctrinal stability has permeated many regions of patent law seemingly randomly. Consider, below, some of the surprising and diverse 717 Madison Place, N.W., developments of the past two years.

- *Eli Lilly v. Barr Laboratories* held that a claim to a chemical species (Prozac®) is invalid for obviousness type double patenting over the previously patented generic claim, even though the panel refused to even consider the record-laden evidence that the Prozac® species would have been

unobvious to a person of ordinary skill relative to the dominant generic claim. According to Circuit Judge Gajarsa, it is "of no consequence" what such a person considers nonobvious; he thereby rendered invalid every commonly-owned *patentable* species invented and patented after a generic claim issues. Rehearing of this incredible, bombshell decision is being sought by *Eli Lilly* and five distinguished *amici*.

- Over a vigorous, compelling dissent by Circuit Judge Newman, *PerSeptive Biosystems v. Pharmacia Biotech* held that claims were inequitably procured for failure to name as inventors two people who where *not* coinventors of those claims, but who arguably may have contributed to claims that had been cancelled, thereby writing out of 37 CFR §1.56 the tenet that cancelled claims cannot be the basis for a holding of inequitable conduct.

- Can a 47.8% length in an accused structure be the equivalent of slightly more than 50% length when the claim calls for a "majority" length? No, according to *Moore U.S.A. v. Standard Register* as a matter of *claim construction* despite the dissents' cogent observation that "whether 47.8% is equivalent to a majority is a question of fact, and could not be decided adversely to the patentee as a matter of law."

- In a case of first impression, information was properly added to a patent's specification by way of a Certificate of Correction which resulted in a claim being properly supported by the specification. That claim, however, was held invalid during the period *prior* to the Certificate's issuance because 35 USC §254 was interpreted by the Federal Circuit to mean that the Certificate validated the patent only for "actions for causes arising *after* the PTO issues a certificate of correction."

- Troubling to many of the patent bar has been the

Federal Circuit's massive resort to issuing non-precedential opinions. Admittedly, the court's workload is daunting. But the consequence is that it is no longer possible to discern fully the trends of patent law change solely from the court's published opinions. **Approximately 60% of the court's patent decisions now come down in "unpublished," non-precedential slip opinions. But major, new directions in patent law have been charted in many of those non-precedential opinions of which the typical practitioner is unaware because the opinions are only occasionally published in the USPQ**. Those cases represent the firmly held views of many members of the court, and should be treated as the law in actual, daily practice. Yet, they must never be cited under Federal Circuit rules (which are rigidly enforced).

This course openly treats non-precedential opinions as of *de facto* importance in learning how properly and effectively to practice patent law on a daily basis (but our texts and lectures boldly flag them as non-precedential).

One important aspect of this course is the presentation and explanation of background cases by the faculty so that the many new, current Federal Circuit cases can be fully appreciated.

As part of your *ex parte* and *inter partes* empowerment process at this course, you will also learn about all the genuinely fascinating new, non-chaotic law that has emanated during the past three years from the Federal Circuit in the many areas set forth in the syllabus below.

COURSE SYLLABUS

Claim Construction
Doctrine of Equivalents
Substantive Interference Law
Design Patents

Prosecution History Estoppel
URAA Term Extension Provisions
Literal, Induced & Contributory Infringement
Novelty and §102
Obviousness/Nonobviousness
35 USC §112 Issues
35 USC §101 Issues
Removing Prior Art References
Correction of Patents Including Reissue and Reexamination
Double Patenting
Inventorship
Legal Ethics In Patent Law – Inequitable Conduct (*will be presented on the second day from 3:00 to 4:30 p.m.*)
License and Assignment Issues
Relief Available to the Prevailing Patent Litigant

COURSE MATERIALS

The full substance of the course is captured in the Year 2001 edition of the two-volume text which extends over 800 pages. The volumes will be sent to attendees in advance of the course.

* * *

APPENDIX E

PATENT, TRADEMARK & COPYRIGHT JOURNAL

September 29, 2000

Range of Equivalents for 'Majority' Does Not Encompass 'Minority'

A range of equivalents for the claim limitation "majority of the length" that encompasses "minority of the length" would improperly vitiate the claim limitation, the U.S. Court of Appeals for the Federal Circuit held Sept. 22 (*Moore U.S.A. Inc. v. Standard Register Co.*, Fed. Cir., No. 98-1386, 9/22/00).

Affirming a summary judgment that three patents on two-way mailers were not infringed, the court noted that all claim limitations are not entitled to an equal scope of equivalents. In addition, the court found no support for arguments that copying with knowledge of the patent creates a greater range of equivalents and that equivalents infringement may be established by the rearrangement of claim limitations. Judge Pauline Newman concurred in part and dissented in part, arguing that the majority decision resolved issues of fact.

Non-Infringement Ruling. Moore U.S.A. Inc. holds three patents (5,201,464, 5,253,798, and 5,314,110) on two-way mailers.

The '464 patent discloses a C-fold mailer-type business form with an integral return envelope that is created during the folding and sealing process. The '798 patent covers a mailer-type business form with a pressure seal adhesive pattern that avoids interference with the printer rollers during

printing. The '110 patent relates to another mailer-type business form that is double-folded to provide four panels for information to be printed on the mailer.

Moore sued Standard Register Co. (SRC), arguing that Moore's patents are infringed by SRC's Form 8120C04 C-fold mailer with an integral return envelope, its continuous web, Z-fold mailer with three panels separated by fold lines, and its form with ten widely-spaced circular patches of adhesive.

Senior Judge Albert V. Bryan Jr. of the U.S. District Court for the Eastern District of Virginia issued a summary judgment of non-infringement as to all three patents, and Moore appealed.

C-Fold Mailer. The '464 patent claims adhesive strips which extend a "majority" of the lengths of the longitudinal margins of the patented form. Moore contended that the district court improperly refused to construe the range of equivalents for this limitations to cover SRC's longitudinal adhesive strips extending along a "minority" of the lengths of the longitudinal margins.

The Federal Circuit disagreed, pointing out that the case law makes clear that all claim limitations are not entitled to an equal scope of equivalents. Judge Paul Michel pointed to the "all limitations rule" under *Pennwalt Corp. v. Durand-Wayland Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987) (35 PTCJ 23, 11/12/87), prosecution history estoppel under *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997) (53 PTCJ 369, 381, 3/6/97), and the inherent narrowness of the claim language under *Sage Products Inc. v. Devon Ind. Inc.*, 126 F.3d 1420, 44 USPQ2d 1103 (Fed. Cir. 1997) (54 PTCJ 434, 9/25/97).

Invoking the all limitations rule, Judge Michel observed

that allowing what is undisputedly a minority length to be equivalent to a majority length would vitiate the requirement that the adhesive strips "extend the majority of the lengths" of the margins. In addition, "it would defy logic to conclude that a minority—the very antithesis of a majority—could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise," he wrote.

The court also rejected Moore's contention that SRC's knowledge of the patents and its copying entitles the patent to a broader scope of equivalents. Although Moore's argument relied on *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 85 USPQ 328 (1950), the Federal Circuit found nothing in that opinion to support Moore's view. In fact, Judge Michel maintained, the Supreme Court's opinion in *Warner-Jenkinson* implies the exact opposite by rejecting the relevance of an accused infringer's intent upon the doctrine of equivalents.

Finally, the appellate court rejected Moore's argument that the written descriptions's teaching that the adhesive strips may be about "half of the length" of the margins supports a scope of equivalents covering a "minority." Judge Michel explained as follows:

> In *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996), we explained the contrary principle that "subject matter disclosed in the specification, but not claimed, is dedicated to the public" in determining infringement under the doctrine of equivalents. *Id.* at 1107, 39 USPQ2d at 1007. Having fully disclosed two distinct embodiments, one in which the first and second longitudinal strips extend a majority of the length of the longitudinal marginal portions, and one in which they do not, Moore is not entitled to "enforce the

> unclaimed embodiment as an equivalent of the one that was claimed." *YBM Magnex, Inc. v. International Trade Comm'n*, 145 F.3d 1317, 1320, 46 USPQ2d 1843, 1845 (Fed. Cir. 1998).

The appellate court accordingly upheld the district court's summary judgment of no infringement by equivalents for Claim 1 of the '464 patent.

Moore also argued that the SRC form is functionally identical to other claim elements of the '464 patent. The SRC form is merely a "rearrangement of claim limitations" which can be covered as an infringing equivalent, according to Moore, citing *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929).

The court rejected the argument. While the *Sanitary Refrigerator* clearly refers to reciprocal changes from the form of the patent structure, it nowhere authorizes the rearrangement of claim limitations, Judge Michel wrote. The case presents a typical doctrine of equivalents scenario, and does not conflict with the holding in *Sage* that the public has a right to rely on clear structural limitations contained in a patent, according to the court.

Printer Mailer. The '798 patent is entitled "Pressure Seal Adhesive Pattern for IBM 3800 Printers," and Claim 1 provides for the adhesive to be spaced from the transverse edge by "a distance sufficient" to avoid interfering with the printer rollers. Moore argued that the district court erroneously construed the "distance sufficient" term as constrained by the particular specifications of the IBM 3800 printer.

The Federal Circuit agreed, noting that the plain language of Claim 1 recites a "printer" generally, and nowhere mentions the IBM 3800 printer. While the written

description refers repeatedly to the IBM 3800 printer, Judge Michel conceded, it clarifies that a form for use on an IBM 3800 printer is only the preferred embodiment. That the title refers to an IBM 3800 printer does not change the analysis, he added, reasoning that the bar on importing limitations from the written description into the claims also applies to a title. This interpretation is also supported by the prosecution history, according to the court.

However, the court found this claim construction error "entirely harmless" and rejected Moore's contention that it requires that the summary judgment of noninfringement be vacated. Noting that the patentee must prove infringement, the court pointed out that Moore provided no evidence that SRC's use of any printer other than the IBM 3800 would have satisfied the "distance sufficient" limitation. Nor does Moore dispute that the adhesive on SRC products cannot avoid interference with printer rollers, Judge Michel added.

Double-Fold Mailer. Claims 1 and 11 of the '110 patent require that the sheet of paper be "devoid of adhesive extending along said end edges of said sheet between said longitudinal lines of weakness." Moore argued that the district court improperly construed the term "devoid of adhesive" in view of the prior art and prosecution history. It maintained that the term encompasses a form with "no adhesive extending *substantially completely* along *both the end edges* between the lines of weakness," as in the prior art Conti patent.

The appellate court disagreed, noting that the Conti patent discloses an intermittent strip of non-permanent adhesive along the transverse end edge of one face. Because the adhesive strip in Conti can be intermittent, the Federal Circuit explained, we are perplexed by Moore's reliance on the prior art as somehow supporting a construction of "adhesive" as limited to a substantially complete strip.

In view of its rejection of Moore's arguments with regard to "substantially completely" and "end edges" and "along," the Federal Circuit held that the SRC form cannot literally satisfy the "devoid of adhesive" limitation of Claims 1 and 11. The summary judgment of no literal or equivalents infringement of the '110 patent was affirmed.

Dissenting and Concurring Opinion. Judge Newman concurred in the non-infringement judgment for the '798 patent, the '110 patent, and Claim 1 of the '464 patent. However, she objected to the court's reasoning with respect to the '798 and '464 patents. For Claim 9 and related claims of the '464 patent, she would have reversed and remanded. (Ed. Note: Judge Newman filed a corrected version of her opinion on Sept. 27, 2000.)

As to the '798 patent, Judge Newman faulted the majority for rejecting the district court's claim construction, and then "mysteriously interpret[ing] the claims the identical way as did the district court, that is, limited to the IBM 3800 printer and the adhesive distances described in the specification." "Extensive precedent requires that claims be construed the same way for all purposes," she insisted, dissenting from the majority's "novel ruling."

Judge Newman also took issue with the majority's ruling that the adhesive strips in the accused SRC form were not an infringing equivalent of the "first and second longitudinal adhesive strips" claimed in the '464 patent. She pointed specifically to the court's holding that 47.8 percent cannot be equivalent to 50+ percent claimed as the "majority of lengths" of the form. "Whether 47.8% is equivalent to a majority is a question of fact, and could not be decided adversely to the patentee as a matter of law," Judge Newman wrote.

Finally, Judge Newman disagreed with the majority's

ruling that the doctrine of equivalents cannot be invoked to reach rearranged claim elements. "[P]recedent contravenes such an automatic bar," she insisted, citing *Warner-Jenkinson, Sanitary Refrigerator*, and *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989) (37 PTCJ 421, 3/2/89).

PTCJ COMMENT: This opinion provides another occasion for lawyers to complain about conflicting Federal Circuit case law. The problem is the statement "subject matter disclosed in the specification, but not claimed, is dedicated to the public," made by Judge Alan Lourie in *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996) (52 PTCJ 198, 6/13/96). In the non-precedential *Brunswick Corp. v. U.S.*, 46 USPQ2d 1446 (Fed. Cir. 1998) (55 PTCJ 562, 4/9/98), Judge Raymond Clevenger denied that the court's application of *Maxwell* was inconsistent with *Warner-Jenkinson*, and Judge Newman dissented. In *YBM Magnex, Inc. v. International Trade Comm'n*, 145 F.3d 1317, 1320, 46 USPQ2d 1843, 1845 (Fed. Cir. 1998) (56 PTCJ 134, 6/4/98), Judge Newman attempts to distinguish away the statement in *Maxwell* as limited to the facts of that case. Finally, this case repeats the *Maxwell* maxim. To make matters worse, Judge Michel surprisingly cites *YBM* as supporting authority and quotes a passage from that case which was intended to do no more than describe the *Maxwell* holding. In a recent speech, Judge Lourie tried to explain that this type of situation does not represent conflicting Federal Circuit law, but rather conflicting responses to appellants' arguments (60 PTCJ 138, 147, 6/16/00). He also critiqued appellants for careless citation of loose language from other opinions to support an argument. "Reckless citation of non-controlling language just suggests the weakness of your case," he stated.

Full text at http://pub.bna.com/ptcj/981386.htm